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TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1907.

No. [redacted]22.

ISAAC H. CALIGA, PLAINTIFF IN ERROR,

vs.

INTER OCEAN NEWSPAPER COMPANY.

IN ERROR TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

FILED NOVEMBER 6, 1907.

(20,898.)

STATE LIBRARY

(20,898.)

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1908.

No. 200.

ISAAC H. CALIGA, PLAINTIFF IN ERROR,

vs.

INTER OCEAN NEWSPAPER COMPANY.

IN ERROR TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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IN THE

UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE SEVENTH CIRCUIT.

OCTOBER TERM, A. D. 1906.

No. 1365

ISAAC H. CALIGA,

Plaintiff in Error,

vs.

INTER OCEAN NEWSPAPER COMPANY,

Defendant in Error.

MR. OTTO RAYMOND BARNETT,

Counsel for Plaintiff in Error.

MR. CLARENCE A. KNIGHT,

MR. MACLAY HOYNE,

Counsel for Defendant in Error.

Error to the Circuit Court of the United States for the Northern District of Illinois, Eastern Division.

2 Pleas in the Circuit Court of the United States, for the Northern District of Illinois—Eastern Division, begun and held at the United States Court room, in the City of Chicago, in said District and Division, before the Honorable Francis E. Baker, Circuit Judge of the United States for the Seventh Judicial Circuit, on Thursday, the twenty-second day of November, being one of the days of the regular July term of said Court, in the year of our Lord one thousand nine hundred and six and of our independence the one hundred and thirty-first year. Plaint

MARSHALL E. SAMPSELL,
Clerk.

filed 1905. 3 IN THE CIRCUIT COURT OF THE UNITED STATES,

For the Northern District of Illinois

Eastern Division.

Isaac H. Caliga,
vs.
Inter Ocean Newspaper Company, } 27,838.

Be it remembered that on this day to-wit: the twenty-fourth day of July, 1905, came the plaintiff in the above entitled cause by his attorney and filed in the clerk's office of said Court his certain Praecipe, praying for the issuance of a Summons. Which said Praecipe is in the words and figures following to-wit:

PRAECIPE.

United States of America,
Northern District of Illinois, } ss.
Northern Division,

CIRCUIT COURT,

October Term, A. D. 1905.

Isaac H. Caliga,
vs.
Inter Ocean Newspaper Company, } In Debt. Damages $10,000.00.

The clerk of said Court will issue a Summons in said cause to said defendants, in a plea of debt in the sum of $10,000.00 to the damage of said plaintiff in the sum of ten thousand ($10,000.) dollars, direct the same to the United States Marshal for said District to execute, and make it returnable to the October Term of said Court, 1905.

4 Dated this twenty-fourth day of July, A. D. 1905.

CLARENCE T. MORSE,
Plaintiff's Attorneys.

To Marshall E. Sampsell, Esq., Clerk.

(Endorsed) Filed July 24, 1905, Marshall E. Sampsell, Clerk.

(And on the same day to-wit: the twenty-fourth day of July come the plaintiff in said entitled cause by his attorney and filed in the clerk's office of said Court a certain Declaration which is not copied here.)

And afterwards to-wit: on the twenty-fifth day of July, 1905, there issued out of the clerk's office of said Court in said entitled cause a certain Summons, which Summons together with the Marshal's return thereon endorsed is in the words and figures following to-wit:

5 Circuit Court of the United States of America, } ss.
Northern District of Illinois. }

The United States of America, To the Marshal of the Northern District of Illinois—Greeting

We Command You To Summon Inter Ocean Newspaper Company, if found in your District, to be and appear before our Judges of our Circuit Court of the United States for the Northern District of Illinois, on the first day of the next term thereof, to be holden at Chicago, in the District aforesaid, on the first Monday of October next, to answer unto Isaac H. Caliga, of a plea of debt in the sum of $10,000.00 to his damage, as is alleged, of Ten thousand ($10,000.) Dollars, and have you then and there this Writ.

Witness, the Hon. Melville W. Fuller, Chief Justice of the Supreme Court of the United States of America, at Chicago, aforesaid, this 25th day of July, in the year of our Lord one thousand nine hundred and five and of our independence the 130th year.

MARSHALL E. SAMPSELL,
(Seal) *Clerk.*

6 MARSHAL'S RETURN.

I have served this writ within my district in the following manner to-wit:

Upon the within named Inter Ocean Newspaper Company, a corporation, etc. by reading the same to and within the presence and hearing of A. C. Phillips, business manager of the said Company and at the same time delivering to him

personally a true copy thereof on the 28th day of July, A. D. 1905.

I was unable to find the president of said company within my district.

JOHN C. AMES,
U. S. Marshal,
J. G. REND,
Deputy U. S. Marshal.

(Endorsed) Filed Aug. 2, 1905, Marshall E. Sampsell, Clerk.

filed
05.

And on to-wit: the second day of October, 1905, come the defendant in said entitled cause by its attorneys, Messrs. Knight & Brown and entered its apearance in words and figures following to-wit:

APPEARANCE.

United States of America,
Northern District of Illinois, } ss

IN THE CIRCUIT COURT OF THE UNITED STATES,

For the Northern District of Illinois.

Isaac H. Caliga,
vs.
Inter Ocean Newspaper Company, } No. 27,838.

We hereby enter the appearance of The Inter Ocean Newspaper Company, the defendant herein, and our appearance as attorneys for said defendant.

KNIGHT & BROWN,
Attorneys for Defendant.

(Endorsed) Filed Oct., 2, 1905, Marshall E. Sampsell, Clerk.

7 And on to-wit: the twenty-second day of June, 1906, being one of the days of the regular December term of said Court, 1905, in the record of proceedings thereof in said entitled cause before Hon. Kenesaw M. Landis, District Judge, appears the following entry to-wit:

PAGE CUT

ORDER OF JUNE 22, 1906.

Order 1906

Isaac H. Caliga,
vs.
Inter Ocean Newspaper Company } 27838

This cause coming on to be heard upon plaintiff's motion made in open Court for leave to file an amended declaration herein and the plaintiff and defendant both appearing in Court by their respective attorneys and consenting thereto, it is hereby,

Ordered that plaintiff have leave to file his amended declaration instanter, whereupon said declaration being filed, it is,

Further Ordered that the defendant's demurrer filed herein on the 23rd day of April, A. D. 1906, shall stand as a demurrer to the amended declaration filed this day, and thereupon said demurrer is overruled with an exception by defendant noted and allowed and the defendant is orered to plead to said amended declaration within ten days from this date

8 And on the same day to-wit: the twenty-second day of June, 1906, came the plaintiff in said entitled cause by his attorney and by leave of court first had and obtained filed in the clerk's office of said Court his certain Amended Declaration in words and figures following to-wit:

Amen a to 28

9 ## AMENDED DECLARATION

In the Circuit Court of the United States

For the Northern District of Illinois

Eastern Division.

Isaac H. Caliga
vs.
Inter Ocean Newspaper Company } No. 27,838

Isaac H. Caliga, plaintiff, a citizen of the United States and a resident of the city of Salem, in the State of Massachusetts, who sues for his own benefit and for the benefit of

Declaration June 5, the United States of America, by Clarence T. Morse and O. R. Barnett, his attorneys, complains of the Inter Ocean Newspaper Company, a corporation, having its principal place of business in the City of Chicago, County of Cook and State of Illinois, in said Eastern Division of the Northern District of Illinois, defendant, of a plea of debt that it render unto plaintiff the sum of Ten Thousand ($10,000) Dollars which it is indebted to and unjustly detains from him.

And thereupon the plaintiff, complaining, says:

I

That the plaintiff heretofore, to-wit, on or about the 5th day of November, A. D. 1901, was then a citizen of the United States and a resident therein, and was then the author designer and proprietor of a certain oil painting designed, originated and owned by him and described as follows:

"The Guardian Angel. Portrait of a young girl sitting hair arranged smoothly over the ears, hair parted in the middle. Her guardian angel stands behind her, one hand retsing on her left shoulder, the other on her right arm."

which painting had not been published in this or in any foreign country prior to said 5th day of November, A. D. 1901, or prior to the date when plaintiff took the steps hereinafter recited, in compliance with the Statutes of the United States, for the purpose of copyrighting said painting.

10 II

That plaintiff, being then the author, originator, designer and sole proprietor of said oil painting, and being then and there a citizen and resident of the United States, did, to-wit, on or about the 5th day of November, A. D. 1901, for the purpose of copyrighting said painting, deposit in the mail within the United States, addressed to the Librarian of Congress at Washington, District of Columbia, in a properly postpaid envelope so addressed, and in conformity with the provisions of the Revised Statutes of the United States, a description of said painting, together with a properly prepared application for the copyright of said painting, duly signed by plaintiff and also, before the publication of said painting in the United States or in any foreign country, the plaintiff did, to-wit, on or about the 5th day of November,

A. D. 1901, deposit in the mail in the United States, in a properly postpaid envelope addressed to the Librarian of Congress at Washington, District of Columbia, a photograph of said painting and the sum of fifty (50c) cents for recording the description of said painting for copyright. Amendation 22.

III

That, plaintiff having so in all respects complied with the requirements of the Revised Statutes of the United States in the premises, as above set forth, said Librarian of Congress did thereupon record the description of said painting in a book kept for that purpose, as required by Section 4957 of the Revised Statutes of the United States, to-wit, on or about the 7th day of November, A. D. 1901, as by said record, or a duly certified copy thereof in Court to be produced, will more fully appear.

IV

And, plaintiff having in all things complied with the conditions and requirements of the Revised Statutes in such cases made and provided, as aforesaid, the said painting became and was duly copyrighted in due form of law, whereby there was granted and secured to plaintiff the sole lib-
11 erty of painting, re-painting, publishing, completing, copying, executing, finishing and vending the said painting for the term of twenty-eight (28) years from and after the recording of the title thereof by the Librarian of Congress, to-wit, on November 7, 1901, as above set forth.

V

That plaintiff has continued to be and now is the sole owner and proprietor of said copyright and of said copyrighted painting.

VI

That prior to the publication of said painting in the United States or in any foreign country, plaintiff gave notice of his aforesaid copyright of said painting by plainly printing and inscribing upon some visible portion of the face or front of said painting the following words:

"Copyrighted 1901 by I. H. Caliga."

clara-
June

VII

That the defendant, the Inter Ocean Newspaper Company, prints and publishes a newspaper called The Inter Ocean, at, to-wit, said City of Chicago, in said Eastern Division of the Northern District of Illinois, and was so engaged in printing and publishing said newspaper in said City of Chicago at the time of the acts hereinafter complained of.

VIII

That heretofore, to-wit, on or about the 25th day of October, 1903, the said defendant, without the consent of plaintiff proprietor of said copyright first obtained in writing, signed in the presence of two or more witnesses, and without any other consent or acquiescence of plaintiff, but in derogation and in infringement of plaintiff's rights in the premises, did print and publish in the aforesaid newspaper, copies of said painting, described as aforesaid, and did knowingly sell great numbers of said newspaper, to-wit, upwards of one thousand (1000) copies thereof, each copy of which newspaper contained an infringing print or reproduction of
12 said copyrighted painting, as aforesaid, whereby and by force of Section 4965 of the Revised Statutes of the United States, an action has accrued to the plaintiff to have and recover from the defendant, the sum of Ten ($10) Dollars for each of said one thousand (1000) copies of said newspaper containing said reproduction of said painting so sold by defendant, amounting together to the sum of Ten Thousand ($10,000) Dollars, for which sum the defendant is indebted to the plaintiff; yet the defendant has not paid to the plaintiff the last-mentioned sum of money, or any part thereof, but refuses so to do, to the damage of the plaintiff of Ten Thousand ($10,000) Dollars, and therefore, he brings his suit.

CLARENCE T. MORSE,
OTTO R. BARNETT,
Attorneys for plaintiff

(Endorsed) Filed June 22, 1906, Marshall E. Sampsell, Clerk.

PAGE CUT

13 And afterwards to-wit: on the twenty-ninth day of June, 1906, come the defendant in said entitled cause by its attorneys and filed in the clerk's office of said Court its certain Plea of General Issue in words and figures following to-wit: Plea of issue, 29, 1906

14 PLEA OF GENERAL ISSUE.

United States of America
State of Illinois } ss.
Northern District of Illinois

IN THE UNITED STATES CIRCUIT COURT.

For the Northern District of Illinois,

Eastern Division.

Isaac H. Caliga,
vs. } No. 27,838.
Inter Ocean Newspaper Company.

Defendant's Plea.

And the said defendant, by Knight & Brown, its attorneys, comes and defends the wrong and injury, when, etc., and says that it does not owe the said sum of money above demanded, or any part thereof, in manner and form as the said plaintiff hath above thereof complained against it, and of this the said defendant puts itself upon the country, etc.

15 KNIGHT & BROWN
Attorneys for Defendant.

(Endorsed) Filed June 29, 1906, Marshall E. Sampsell, Clerk.

16 And on to-wit: the third day of July, 1906, come the plaintiff in said entitled cause by his attorneys and filed in the clerk's office of said Court his certain Similiter in words and figures following to-wit:

filed 1906.

17 In the Circuit Court of the United States

For the Northern District of Illinois

Eastern Division.

Isaac H. Caliga
vs.
Inter Ocean Newspaper Company } No. 27,838

And the plaintiff, as to the plea of the defendant by him first above pleaded and which the defendant has prayed may be inquired of by the country, does the like.

Clarence T. Morse,
Otto R. Barnett,
Attorneys for plaintiff

July 3, 06.

(Endorsed) Filed July 3, 1906, Marshall E. Sampsell, Clerk.

. 21,

18 And on to-wit: the twenty-first day of November, being one of the days of the regular July term of said Court, 1906, in the record of proceedings thereof in said entitled cause before the Hon. Francis E. Baker, Circuit Judge, appears the following entry to-wit:

ORDER OF NOVEMBER 21, 1906,

Called for Trial and Jury Sworn.

Isaac H. Caliga,
vs.
Inter-Ocean Newspaper Company, } 27838

This cause being called for trial now come the parties by their attorneys, and thereupon the plaintiff has leave to further amend the declaration herein, the plea to the original declaration to stand to said declaration as amended; and thereupon come the following jury to-wit: H. N. Stoddard, Wm. F. Smith, C. H. Beach, James E. Sinclair, J. Kopald, W. W. Wall, A. L. Palmer, Elery Spangle, J. P. Gatiss, R. E. Garfield, C. D. Taylor, O. E. Mason, who were all duly elected, tried and sworn to well and truly try said issue, and

a true verdict render according to the law and the evidence, and the opening statements of counsel being heard and the evidence in chief for the plaintiff being heard and concluded the defendant enters its motion to have said jury instructed to return a verdict for said defendant, and the Court having heard arguments in part on said motion, when the hour for adjournment arrived, the further hearing is postponed until tomorrow morning.

19 And on the same day to-wit: the twenty-first day of November, being one of the days of the regular July term of said Court, 1906, came the plaintiff in said entitled cause by his attorneys and by leave of court first had and obtained filed in the clerk's office of said court his certain Amendment to the Amended Declaration in words and figures following to-wit: Amendment amendment Nov. 2

20 AMENDMENT TO AMENDED DECLARATION.

IN THE CIRCUIT COURT OF THE UNITED STATES

For the Northern District of Illinois

Eastern Division

Isaac H. Caliga
vs.
Inter Ocean Newspaper Company } No. 27,838.

And now comes the plaintiff and, by leave of Court first had and obtained, hereby amends his amended declaration herein by inserting the word visible before the word "portion" in line 4 of Paragraph VI of said declaration.

OTTO R. BARNETT
CLARENCE T. MORSE,
Attorneys for Plaintiff

Chicago, Ills.,
.....November, 1906.

(Endorsed) Filed Nov. 21, 08, by leave of Court, Marshall E. Sampsell, Clerk.

t, filed
2, 1906.

21 And afterwards to-wit: on the twenty-second day of November, being one of the days of the regular July term of said Court, 1906, in the record of proceedings thereof in said entitled cause before the Hon. Francis E. Baker, Circuit Judge, appears the following entry to-wit:

JUDGMENT OF NOVEMBER 22, 1906.

Isaac H. Caliga,
vs.
Inter Ocean Newspaper Company, } 27838

Now again come the parties by their attorneys, and now comes on to be further heard the motion of said defendant to have said jury instructed to return a verdict for said defendant, and the arguments being concluded and the court being fully advised sustains said motion; and thereupon said jury, under the instructions of the Court return their verdict, finding the defendant not guilty, to the entry of which the plaintiff excepts and enters his motion for a new trial which is heard and overruled, to which the plaintiff excepts.

It is thereupon Considered and Adjudged by the Court that the plaintiff take nothing by his said declaration and that the defendant as to the allegations contained and alleged in said declaration be, and it is hereby forever discharged and go hence without day.

And the plaintiff entering his motion for a writ of error to the United States Circuit Court of Appeals, the court fixes the amount of bond on writ of error in the penalty of five hundred dollars ($500.00) to be approved by the clerk of this court; and sixty days are allowed to prepare and present the bill of exceptions herein.

22 And on to-wit: the fifteenth day of January, 1907, there was filed in the clerk's office of said Court in said entitled cause a certain Bill of Exceptions in words and figures following to-wit:

23 BILL OF EXCEPTIONS.

Bill of exceptions, filed 15, 1907

IN THE CIRCUIT COURT OF THE UNITED STATES

For the Northern District of Illinois

Eastern Division

Isaac H. Caliga
vs.
Inter Ocean Newspaper Company } No. 27,838.

Be It Remembered that, to-wit, on the 21st day of November 1906, at a stated term of said Court begun and holden in Chicago, in and for the Northern District of Illinois, Eastern Division, before his Honor Francis Baker, Circuit Judge, the issues joined in the above stated cause between the said parties came on to be tried before the said Judge and a jury; the plaintiff being represented by Mr. Otto R. Barnett, of Raymond & Barnett, and Mr. Clarence T. Morse, his attorneys, and the defendant by Mr. Clarence A. Knight, of Knight & Brown, its attorneys. And upon the trial of the issues, the said plaintiff, to maintain and prove the said issues on his part, adduced the following evidence:—

Thereupon plaintiff's attorneys offered in evidence an official receipt, signed by the Postmaster at Boston, Mass., for a package deposited for purposes of copyright.

Mr. Knight: This I object to on the ground that the copyright law provides that the party himself shall deposit in the United States mail the description of his copyright.

The Court: Objection overruled. I will let this go in. It may be supplemented by other testimony, of course.

To which ruling of the Court the defendant, by its counsel, then and there duly excepted.

Said document was thereupon introduced in evidence and marked "Plaintiff's Exhibit 1" and is in words and figures, as follows, to-wit:

Plaintiff's Exhibit 1 right receipt,

"Copyright Mailing Receipt
No. 17352
(Original)

Revised Statutes, Sect. 4956 (Amended March 3, 1891):—No person shall be entitled to a copyright unless he shall, on or before the day of publication in this or any foreign country,

's ex-
—Copy-
mailing
ge.

deliver at the office of the Librarian of Congress, or deposit in the mail within the United States, addressed to the Librarian of Congress, Washington, District of Columbia, a printed copy of the title of the book, map, chart, dramatic
24 or musical composition, engraving, cut, print, photograph or chromo, or a description of the painting, drawing, statue, statuary, or a model or design for a work of the fine arts for which he desires a copyright, nor unless he shall also, not later than the day of the publication thereof in this or any foreign country, deliver at the office of the Librarian of Congress, at Washington, District of Columbia, or deposit in the mail within the United States, addressed to the librarian of Congress, at Washington, District of Columbia, two copies of such copyright book, map, chart, dramatic or musical composition, engraving, cromo, cut, print, or photograph or in case of a painting, drawing, statue, statuary, model or design for a work of the fine arts, a photograph of same.

Revised Statutes, Sec. 4961:—The postmaster to whom such copyright book, title, or other article is delivered, shall, if requested, give a receipt therefor; and when so delivered he shall mail it to its destination.

Post Office, Boston, Mass., Nov. 5, 190

I have received this day, for despatch,.....
(Letter
.....a (Package addressed to the
(alleged to contain
Librarian of Congress, Washington, D. C., (containing Copyright Matter, as follows:—

One photograph of
The Guardian Angel
(8 x 10 photo)
Artist and Proprietor of Painting
I. H. Caliga, Boston.

(signed) GEO. A. HOWARD
Postmaster
By H. M. A."

Thereupon plaintiff's attorney introduced in evidence a certificate of the Librarian of Congress as to the receipt and registration of the photograph of a certain painting, which document was marked "Plaintiff's Exhibit 2" and is in words and figures as follows, to-wit:—

Plaintiff's exhibit 2 — certificate of librarian of congress.

"Class I XXc. No. 2429

Library of Congress, towit:

Be It Remembered,

That on the Seventh day of November, 1901, I. H. Caliga, of the United States, hath deposited in this office the description of a painting, the description of which is in the following words, to-wit:

The Guardian Angel. Portrait of a young girl sitting, hair arranged smoothly over the ears, hair parted in the middle. Her guardian angel stands behind her, one hand resting on her left shoulder, the other on her right arm, the right whereof he claims as author and proprietor in conformity with the laws of the United States respecting Copyrights.

Office of the Register of Copyrights,
Washington, D. C.

HERBERT PUTNAM
Librarian of Congress
By THORVALD SOLBERG,
Register of Copyrights.

(Photograph on file)

Written J. H. L. O.
Revised J. W. C.
Mailed W. J. P.

I hereby certify that the foregoing is a true copy of the original record of copyright. In Witness Whereof, the seal of the Librarian of Congress has been hereto affixed this 26th day of September, 1906.

HERBERT PUTNAM
Librarian of Congress
By THORVALD SOLBERG,
Register of Copyrights.

Office of the Register of Copyrights
Washington, D. C.

(Seal of)
(Librarian of Congress)
(Copyright Office)
(United States of America)"

Mr. Barnett: I offer in evidence a certificate of the Librarian of Congress that the photograph thereto attached is a true copy of the photograph which was received by him to complete said copyright registration, and which was deposited with him.

Mr. Knight: That is objected to This man does not cer-

tify that he took this photograph. He has judged for himself that this is a copy.

The Court: Objection overruled.

To which ruling of the Court the defendant, by its counsel, then and there duly excepted.

Said document was thereupon introduced in evidence and marked "Plaintiff's Exhibit 3", and is in words and figures, as follows, to-wit:

ex-
Certifi-
Libra-
Con-

"Library of Congress,
Copyright Office.

Washington, D. C.

I hereby certify that one photograph of the painting 25½ entitled: The Guardian Angel. Portrait of a young girl sitting, hair arranged smoothly over the ears, hair parted in the middle. Her guardian angel stands behind her, one hand resting on her left shoulder, the other on her right arm, was deposited in this office by I. H. Caliga, of the United States, on the seventh day of November, 1901 and was credited on entry XXc No. 2429 of Class I, 1901, to complete copyright, and that the photographic print hereto attached is a true copy thereof.

Written by J. H. L. O; Revised J. W. C; Mailed .....

In Witness Whereof, the seal of the Librarian of Congress has been hereto affixed, this fourth day of October, 1906.

HERBERT PUTNAM,
Librarian of Congress
By THORVALD SOLBERG,
Register of Copyrights.

Library of Congress,
Office of the Register of Copyrights,
Washington, D. C.

(Seal of)
(Librarian of Congress)
(Copyright Office)
(United States of America)"

PAGE CUT

26 Mr. Barnett: I now read into the record the following stipulation, made in open Court, for the purpose of excusing numerous witnesses who have been subpoenaed: Stipulation.

"It is admitted by defendant for use in evidence in the trial of this cause as follows:

First. That the defendant did publish the newspaper known as the Inter Ocean, at Chicago, Illinois, during the month of October 1903, and including October 25, 1903.

Second. That a copy of page 4 of the paper entitled 'The Inter Ocean' and dated October 25, 1903, and identified by the signatures of the attorneys for the parties hereto, is a true copy of page 4 of said Inter Ocean of October 25, 1903" that is this copy (producing same).

Third. That the defendant published and sold upwards of One Thousand copies of the Inter Ocean of October 25, 1903, on October 25, 1903, and further proof of any of these facts is hereby waived."

Thereupon plaintiff offered in evidence a certain newspaper cut of two pictures headed "Paintings Whose Similarity Has Aroused Comment", which cut it was admitted by defendant in open court is a part of said page 4 of said Inter Ocean of October 25, 1903, published by the defendant and referred to in the foregoing stipulation.

Mr. Barnett: Both pictures cannot go in. He must elect as to which picture he is suing on.

The Court: This offer correspondents with the declaration which says that in each copy of the newspaper you published copies of said painting.

Objection overruled. To which ruling of the court, the defendant, by its counsel, then and there duly excepted.

Thereupon said newspaper cut was introduced in evidence and was marked "Plaintiff's Exhibit 4" and is as follows:

"PLAINTIFF'S EXHIBIT 4."

troduced to the audience by Senator Len Small.

When the Governor arrived in Chicago from Kankakee he was met by a delegation from Elgin, consisting of Dr. E. S. Whitman, William Grote, Postmaster H. D. Hemmens, F. H. Wellington, Mayor A. H. Hubbard

The children of Mr. Dailey attribute his long life to the fact that he never chewed, smoked, or drank intoxicating liquors, nor did he drink coffee or eat pastry. He slept much in the open air, a part of the time using a block of wood for a pillow.

ist, with Thayer's work as his model?

These are the latest questions in the controversy resulting from the exhibiting at the salon of the American Society of Artists, at the Chicago Art Institute, of the painting.

PAGE CUT OFF

28 Thereupon the plaintiff's attorney read in evidence the depositions of Thorvald Solberg and J. Bright Handy, taken on behalf of plaintiff on October 4, 1906, before J. Arthur Lynham, a notary public in and for the District of Columbia, as follows:

THORALD SOLBERG testified that— Deposition of Thorald Solberg.

I am Register of Copyrights in the Library of Congress of the United States and under the Act of February 19, 1897, have charge of all copyright material. I produce a certain photograph which was deposited in the Copyright Office of the Library of Congress on the 7th day of November 1901, as a photograph of a painting by Isaac H. Caliga. This photograph is a part of the permanent files of my office My office received a request from Raymond & Barnett, attorneys for Caliga, for a copy of said photograph in September 1906, and in reply I answered that it was not customary for my office to undertake to make such photographs but I permitted J. Bright Handy, a photographer of this city, to make a photographic copy. The photographic print, which you now hand me, is a true copy of the photograph deposited in this office and credited on registration Class I, No. 2429 of Nov. 7, 1901, for the painting entitled "The Guardian Angel".

The application for registration of the description of said painting, dated Nov. 5, 1901, was received as No. 56 on Nov. 7, 1901, and was accompanied by said photograph which is attached to the jacket enclosing said application. That application is a part of the permanent files of my office and reads as follows:

"APPLICATION FOR COPYRIGHT OF PAINTING.

Boston, Mass. Nov. 5, 1901.

Librarian of Congress,
Washington, D. C.

Enclosed find $1 check on Central National Bank, fee for registration of copyright and certificate thereof upon a painting, the description of which is as follows:

29 The Guardian Angel. Portrait of a young girl sitting, hair arranged smoothly over the ears. Hair parted in

the middle. Guardian Angel Stands behind her; one hand resting on her left shoulder, the other on her right arm. Also a photograph of said painting. This is the production of I. H. Caliga who is a citizen of the United States, and copyright protection is claimed by him as author.

Mail Certificate to Curtis & Cameron, Pierce Building, Boston, Mass."

The check enclosed with said application was paid and the fee passed into the Treasury. The following identifying marks were placed on this application by my office, to-wit: A stamp "Class I, Fine Arts," the date of the receipt of the application "Nov. 7, 1901, No. 2429" and also the abbreviation "XXC" indicating No. 2429 of Class I of the 20th Century.

The negative made by J. Bright Handy to supply the photographic print of said photograph was, as is customary returned to this office and is in the possession of the Register of Copyrights.

The certificates shown to the witness were introduced in evidence as exhibits to said deposition, copyright certificate A being the same as "Plaintiff's Exhibit 2" hereinabove noted and plaintiff's exhibit copyright certificate B being the same as "Plaintiff's Exhibit 3" hereinabove noted, and the photograph identified by the witness as a replica, is the said original photograph on file with him and was introduced in evidence as an exhibit to said deposition as plaintiff's exhibit, copy of deposited photograph, "Exhibit C" and is the same as the photograph forming a part of the said plaintiff's "Exhibit 3".

J. BRIGHT HANDY testified—

I reside at Washington, D. C., am thirty seven (37) years old, am a professional photographer, and have been such for fifteen (15) years. The photograph "Exhibit C", (being the same as the photograph forming a part of said "Plaintiff's Exhibit 3"), was made by me from the original deposited photograph identified by the witness Solberg in connection with the Caliga copyright No. 2429. Mr. Solberg's assistant, Mr. Ashley, in charge of the Copyright Office, produced said original print on file, designated a Mr. Miller to go with me to the photographic skylight in the attic of the Library of Congress, (they would not allow me to handle

this by myself). There, on September 19, 1906, I made the negative from which this print was made and I then returned the negative to the Register of Copyrights' Office and the print which I made from that negative is a true copy of that original deposited photograph which was so furnished by the Office of the Register of Copyrights. (Here follows the certificate of the notary before whom these depositions were taken). Testimony of J. B. Handy

ISAAC H. CALIGA, the plaintiff herein, having been first duly sworn, testified in his own behalf as follows: Testimony of Isaac H. Caliga

Direct Examination by Mr. Barnett.

My name is Isaac Henry Caliga; I will be fifty years old the 24th of next month; my residence is Salem, Massachusetts; I am an artist and am the plaintiff in this case.

I lived in Salem, Massachusetts during all of the month of November, 1901, and am the painter of the painting referred to in the declaration of this suit, I was residing in Salem, Massachusetts, at the time I completed that painting.

As I was about to send that painting off to an exhibition, I found it necessary to have it copyrighted, and so I took such steps. I went to Curtis & Cameron and asked them if they would be willing to publish the picture and he said he would be very glad to. The picture was given into his hands and I told them that I wanted first class negatives or would not want them published. Of course, he understood that, and so the agreement was made then and there, a verbal agreement that he was to publish the picture. I authorized Curtis & Cameron to obtain a copyright for me on the painting.

Prior to and including November 5, 1901, this painting was was kept in my studio in Boston. I could not say the exact date prior to November 5, 1901, when the painting was completed, because I was waiting for it to varnish, and I usually varnished my pictures shortly before I sent them away
31 to the exhibition. It was a short time, before November 5, 1901. There had been no public exhibition of the painting in my studio or anywhere prior to that date, and there was no public exhibition of that painting between November 5, 1901, and November 8, 1901. This painting was first placed on exhibition in the year 1901 at the Carnegie

of Exhibit in Pittsburgh, and, as near as I can remember, the date of the opening of the exhibition was about November 9 of that year; I am not sure, but it was about the 9th of November, 1901. I am able to state with certainty that there had not been any exhibition of the painting prior to this exhibit at the Carnegie Exhibition. There had not been any exhibition of the picture prior to that date. There have been slight alterations in that painting since November 7, 1901.

The photograph marked "Complainant's Exhibit, Copy of Deposited Photograph, Exhibit C", forming a part of the deposition of Thorvald Solberg, represents the picture as I sent it to the Pittsburg Exhibition shortly after I copyrighted it—I beg your pardon, but there is a mistake there, the picture was sent before it was copyrighted; that is, it was in transit. I had the copyright taken out at the time it was in transit going to Pittsburgh.

Before exhibiting the picture, I placed a notice of copyright on the painting, which notice still appears on it and has always been there and has never been changed in any way. I here produce the original painting with such notice on the lower right hand corner of the face of the picture, which notice reads "Copyright 1901 by I. H. Caliga". That painting has never been exhibited without that copyright notice upon it.

The changes which have been made in the painting as it now appears, as compared with the painting as it was at the time it was copyrighted, are more in outline of the wings. The wings instead of going up as in the original, come down now, as you see, on both sides and there is a slight change
32 in the pillar back of the angel. The figures are the same.

I never authorized the issue of any copy of that painting without the copyright notice on it, which I have read.

I first had my attention called to the publication by the defendant which is complained of in this suit when I came here to Chicago to find out where the trouble in this matter originated. That was about the seventh of November 1903. I am sure I was here on the 7th of the month of its publication. When I came here I purchased a copy of the publication of October 25, 1903, at the office of the Inter Ocean here in Chicago. Plaintiff's Exhibit 4 is a portion of the copy purchased by me.

Mr. Barnett: In view of the limited offer under the stipulation, and the identification by this witness of this page as a part of the paper purchased by him, and the allegation of

the declaration that the defendant published the paper, and that each copy of that paper of that date contained the publication complained of, I wish to offer in evidence this section of the Inter Ocean, page 4 is all I want, The allegation in the declaration is that the defendant published a newspaper and that that newspaper of that date contained certain publications. Testimony Isaac H. Caliga.

Mr. Knight: We admit that publication of that date.

Mr. Barnett: The allegation is not merely that the defendant published reproductions of the painting, but that it has published this paper containing reproductions, and I want to introduce that part of the paper.

The Court: No, the fact is admitted that they published a newspaper; that on page 4 of an issue of a certain date picture appear; the pictures follow as published on that page of the paper. I do not think it is necessary to encumber the record and further.

To which ruling of the court, the plaintiff by his attorney, then and there duly excepted.

The Court: I want it understood that the newspaper itself may be exhibited to the jury, this particular copy simply
33 showing the portrait. For the purposes of the trial here so much of that page is in as exhibits the print, and the fact that the physical thing is the issue of the defendant newspaper Company is in, so that the bill of exceptions shall show that it was stipulated between the parties so and so, and that the pictures as they appear upon page 4 of such an edition are as follows.

The witness Caliga continuing, testified:

There has been no license from me to the defendant to reproduce this painting. I was the owner of this painting at the time I obtained the copyright of November 7, 1901. I am still the owner and have been the owner of it continuously from then until now.

Cross-Examination by Mr. Knight.

I was born in Auburn, Indiana. My name when I was born was Isaac Stieffel.

I had a studio at Salem also at the same time I had one in Boston. My studio in Salem was in the City of Salem and was, I should say, about twenty-four feet square. I could not tell you how many pictures I had at that studio. Pictures

of I do not sell, why they are tucked away, they are not necessarily hung on the walls but are left around the studio in different places, not where people could see them, but where they could be easily had and shown. My Boston studio was about thirty-five or forty-five feet long and twenty-five feet wide, and I was the sole occupant of that studio.

I was at this picture I should say a little over two years in painting it. I have had it in my mind longer. I first began to work at it in the winter of 1899-1900. It was practically completed in the year 1901. After I had completed it in 1901 I sent it to the Carnegie Exhibition in Pittsburgh.

I finished this picture in the fall of 1901, that is, the autumn, just prior to my sending it away. I worked up to the last, almost; I worked upon the picture at my studio in Boston at that time. The picture was submitted to Curtis & Cameron in the autumn of 1901 before I sent it away. Before the copyright was taken out by them, I went to Mr. Curtis and
34 made arrangements to have the picture published by them and they said they would have to take photographs and have the picture copyrighted. Neither Mr. Curtis nor Mr. Cameron had seen the picture until they had it photographed, about September 1901. The photograph was taken in my studio in Boston by Curtis & Cameron's principal operator.

"Q And then after that photograph was taken, they, as I understand it, had the right to publish the photographs. What was your arrangement with them about publishing the photographs?

A My arrangement was a verbal one."

He stated he would have to take a copyright out at once and I authorized him to do that. I have stated all the arrangement with Curtis & Cameron. I was to receive so much royalty on the publication of the photographs. That arrangement continues up to to-day. I never revoked that authority. I authorized them to send to Washington a copy of the photograph that they took in my studio: they could not get out a copyright unless they did that. I certainly authorized them to do all that was necessary to take out a copyright. They took photographs of the picture of several sizes. I had the price-list of different sizes and the prices, and such.

"Q Then after obtaining the copyright on October 7, 1901, did you see those pictures on the market?

A I have never seen one sold on the market."

The negatives were not satisfactory for some time and they

were taking negatives at different times to try and get a proper negative. There was something about the picture they could not solve in the way of getting the values and giving the quality they were looking for in that work and they tried
35 and tried and tried. I was not wholly satisfied with it and neither were they and they were the whole month working at that, so that they took them at different times in order to get good results.

"Q Now you afterwards, after October 7, 1901, took out this second copyright of November?

A Yes, sir, about a month later.

Q And the photographs that you filed with the second copyright, were they the same photographs that Curtis & Cameron had taken of the first?

A They were precisely the same thing." * * "I got it from them."

The arrangement with Curtis & Cameron was made at the time that the first copyright was taken out, about September of that year, somewhere in September. I know that a copyright was taken out on October 7, 1901. He sent me a bill for it.

My arrangement with Curtis & Cameron when they took these photographs was at least a day or two before October 7, 1901, and the photographs were taken at least a day or two before October 7, 1901, I should say it was more than three days before.

Curtis & Cameron took the photographs after I made the arrangement with them. I could not exactly say how long prior to October 7, 1901 it was when they came to my studio and took the photographs. It may have been five days. I alone was present at the studio at the time, with the operator who took the photographs, and he was a regular employe of the firm of Curtis & Cameron.

There were no changes made in the picture from October 7, 1901 until I exhibited the picture at Pittsburg. The changes were made after I had received the picture from several exhibits and just prior to my sending it here to the exhibition in Chicago, which was, I think, in 1903. After I had made the changes, within a few months prior to that time, the picture was in my studio in Salem, but was not exhibited there.
36 As to the changes in the picture, I made no changes in the figures, the changes were only made in the wings and the pilaster, the wings, instead of going up that way,

of partially came down, a little more in the outline than anything else. Over the head of the angel there is a round column now, and in the original picture there was a flat column with a shell, and in the original picture more of the window at the right of the figure is shown than is shown in the picture now, because the wings of the angel now come down further. The wings in the photograph are above the elbow of the angel, so as to show more of the window ledge. The wings come down lower now. I wanted to cover up the light spot which appears on the right hand side of the photograph in evidence, leaving just a little of that spot, so as not to make it so prominent, and on the left of the picture I wanted to cover up more of the light spot on that side, and at the right hand side of the column I show a more sky light than in the original picture, a little more.

I could not approximately say how many square inches of the picture I have covered over by reason of throwing out the wings. I think I have stated all the changes in the picture. The figures were not disturbed, they were there and always have been there just as they are, I did put a few light touches there (indicating the angel's drapery), not in the drawing, but just light effect of color. The wings in the original picture of the angel were darker, but not much darker than they are now. The photograph shows it off much darker than it was. In repainting them I may have got it a little lighter.

After repainting the picture the way I have described, I did not send any photograph to the office of the Librarian of Congress showing the changes in the picture.

The picture was first copyrighted October 7, 1901, un-
37 der the name "Maidenhood", I adopted that name, that was this painting which I now exhibit here in court and the one shown in the photograph. I certainly gave Curtis & Cameron the authority to take out copyrights in their own name. I do not know whether Curtis & Cameron took out a copyright on October 17, 1901, in their name on the photograph of this picture called "Maidenhood", the photograph, their negative. I do not know what Curtis & Cameron did in regard to taking out copyrights on their photograph. That is their business. I gave them authority. They had authority to publish the picture and I gave them authority to copyright their negatives and I suppose every negative they get out is copyrighted. I know that a copyright was taken out on November 1st, 1901 on the photograph of the picture under the

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title of the "Guardian Angel" and by Curtis & Cameron. I suggested the title the "Guardian Angel".

I can't say when the exhibition opened at Pittsburg. I should say it was about November 9, of that year. The painting was in transit about the time that I applied for the second copyright. I put the words "Copyright 1901 I. H. Caliga" on the painting before October 7, 1901. They were put on before the first copyright and have never been taken off since. After the second copyright nothing was done to these words, they were left upon there just the same as they were before. They were never changed.

I stopped the sale of the photographs somewhere in 1903, before the picture came on here. I told them that the negatives were not satisfactory. They could not make satisfactory prints and I asked them to drop it and try again. I could not say what pictures were sold from 1901 to
38 1903. I know they sold very few. I was not present when they made the sales and do not know what they sold. I do not know where the pictures were sold or where they went to. They were not all sold in Boston. My name was always on the negatives. I know they can't photograph my picture without my name going on. They could photograph the photograph. My name is there, with the copyright inscription; it is on the picture and must come on the negative.

Re-direct Examination by Mr. Barnett.

All my arrangements with Curtis & Cameron have been verbal. I have never given any written permission to do any of the things I have testified about. The verbal arrangements are simply that they attend to the publishing and I get the royalties on the amount that is sold. There was no copy of this painting sold prior to the copyright of November 7, 1901, because the negatives were not developed, were not finished.

Thereupon plaintiff introduced in evidence the original oil painting produced and identified by the witness, and the same is marked "Plaintiff's Exhibit 5", a copy of which painting is as follows:—

39 *Re-cross Examination by Mr. Knight.* Testimony of Isaac H. Caliga.

Between the first copyright and the second copyright there was nothing done in the sale of the photographs. I do not know how many of those were sold. I was not satisfied to have them go on the market.

They have their salesroom on the top floor of Copley Square. They make a business of publishing these photographs of different artists.

None of these photographs were exhibited between October 5 and November 7, 1901.

Thereupon it was stipulated in open court that on October 7, 1901, the plaintiff had duly filed with the Librarian of Congress a photograph of the painting in question, with the following description:

"Maidenhood; a young girl seated beside a window; an angel stands behind her."

which was all the testimony and all of the evidence filed or received on the trial of the above cause.

Whereupon the plaintiff, by his attorneys, moved the Court to instruct the jury, which motion was a written motion which had been previously filed in said cause and presented to the Court before beginning the examination of the witness Caliga, and reads in words and figures as follows:

Motion for instruction jury.

"In the Circuit Court of the United States

For the Northern District of Illinois

Eastern Division

Isaac H. Caliga
vs.
Inter Ocean Newspaper Company } No. 27,838.

And now comes the plaintiff and moves the Court to embody in its charge to the jury in this cause, each of the several instructions hereinafter set forth as follows, to-wit:

40 1. The Court instructs the jury that if it finds from all the evidence that the plaintiff has proven all the matters alleged in his declaration herein, the verdict of the jury must be in favor of the plaintiff.

2. The Jury is instructed that if it finds from all evi-

dence that the plaintiff has proven all the matters alleged in his declaration herein, then the verdict must be for the plaintiff, and the amount of the debt and damages to be named in such verdict is arbitrarily fixed by Statute at the sum of $10 for each copy of the Inter Ocean of October 25, 1903, sold by the defendant, but the Statute further provides that, in any event, the aggregate amount shall not be less than $250 nor more than $10,000.

6. The jury is instructed that if it finds from all the evidence that the plaintiff acquired a valid copyright upon his painting entitled "The Guardian Angel" as alleged in the declaration herein, then such copyright protects the plaintiff against the reproduction of said painting, or of any substantial part thereof, in any manner, and a reproduction of said painting, or of any substantial part thereof, by a cut in a newspaper, without a license from the owner of said copyright, constitutes an infringement of said copyright.

10. The Court instructs the jury that if it finds from all the evidence that the plaintiff was the author of the painting entitled "The Guardian Angel", and that he, or any person acting for him, caused a description of said painting and a photograph of said painting to be deposited with the Librarian of Congress for purposes of copyright on or about November 7, 1901, and prior to any publication of said painting by public exhibition or otherwise, all as alleged in the declaration herein, then the plaintiff thereby became and was the owner of a valid copyright upon said painting.

13. The jury is instructed that the plaintiff has alleged in his declaration the matters under which he claims the right to recover a judgment against the defendant; that if those matters so alleged are all true, the plaintiff is entitled to a verdict against the defendant for the sum of Ten Thousand Dollars ($10,000).

To obtain such a verdict the plaintiff must have had a valid copyright upon his painting, referred to in his declaration, at the time of the alleged acts of infringement set forth in the declaration. In order to obtain such copyright he must have caused a description of the painting and also a photograph of the painting to be delivered to the Librarian of Congress, or to be deposited in the mail in the United States addressed to the Librarian of Congress for the purpose of copyright registration, before there had been any publication or public exhibition of said painting, and he must thereupon have caused said painting to be marked with the words

"Copyrighted 1901, by I. H. Caliga" upon some visible part thereof. Motion for instruct jury.

It is for the jury to determine from the evidence whether plaintiff did all these things.

15. The jury is instructed that permission to photograph a copyrighted painting, bearing notice of the copyright as required by Statute, and to sell such photographs, does not carry with it the right to publish any such photographs
41 without such copyright notice appearing thereon and the publication of any such photograph without such notice appearing thereon, and without the knowledge of the owner of such copyright, will not invalidate such copyright.

Respectfully submitted,

(signed) Otto R. Barnett.
Clarence T. Morse.
Attorneys for Plaintiff."

Thereupon the defendant, by its attorney, moved the Court on behalf of the defendant to instruct the jury that on the entire evidence the plaintiff is not entitled to recover and that their verdict should be for the defendant.

And thereupon the jury was excused and retired.

And thereupon the Court listened to arguments to instruct the jury peremptorily in favor of defendant.

(The jury returned)

Thereupon the Court instructed the jury as follows:

Gentlemen of the Jury, it has appeared in the evidence before you that the suit on trial here is based on a copyright of November 7th, 1901. It also appeared from Mr. Caliga's testimony when he was on the stand that in October previous he had sent a description of the painting and a photograph of it to the Librarian at Washington. In other words, in October he had taken all of the steps to get a copyright. He repeated the same thing in November. So he brought his suit in my view, upon the wrong copyright. His right should be based upon his first proceedings, and the second proceedings are a nullity. I charge you, as a matter of law, that the plaintiff fails because he bases his suit upon the wrong copyright. One of your number will please sign a verdict finding the defendant not guilty. Charge t

Thereupon the plintiff, by his attorney, then and there excepted to so much of the Court's charge as stated that in October 1901, the plaintiff had taken all steps necessary to get a copyright, and to so much of the Court's charge as

ions, 5, stated that the plaintiff brought his suit upon the wrong copyright and that the second copyright, being the copyright of November 7, 1901, is a nullity.

42 Thereupon the plaintiff, by his attorney, then and there excepted to the following portion of the Court's charge: 'You will now go through the formality of signing the verdict, because I charge you, as a matter of law, that the plaintiff fails because he bases his suit upon the wrong copyright. One of your number will please sign the verdict, finding the defendant not guilty."

And also then and there excepted severally to the Court's failure and refusal to instruct the jury in accordance with the requested instructions numbered 1, 3, 6, 10, 13 and 15, respectively, as requested by plaintiff's written motion.

Thereupon the jury, without retiring, returned its verdict as follows:

"We, the jury, find the issues for the defendant."

To which the plaintiff by his attorneys, then and there duly excepted.

Thereupon the plaintiff moved in open court for a new trial.

Thereupon the Court overruled the motion for a new trial, to which action of the Court the plaintiff, by his attorneys, then and there duly excepted.

Whereupon the Court entered judgment in favor of the defendant, upon the verdict.

To the entry of which judgment plaintiff then and there duly excepted.

Thereupon the plaintiff moved the Court to enter an order granting plaintiff sixty (60) days time in which to prepare and present and settle the bill of exceptions, which motion the Court granted, and entered an order allowing the same.

And forasmuch as the matters above set forth do not fully appear of record, the plaintiff tenders this his bill of exceptions in this case, and prays that the same may be settled and allowed and signed; sealed and certified by the Judge as provided by law; which is now accordingly done this 15th day of January, A. D. 1907.

(Signed) FRANCIS E. BAKER (Seal)
Circuit Judge.

43 The foregoing bill of exceptions is correct and is hereby approved, allowed and settled, and made a part of the record herein.

Dated in open court at the December term, 1906, this 15th day of January, A. D. 1907.

(Signed) FRANCIS E. BAKER (Seal)
Judge.

(Endorsed) Filed January 15, 1907, Marshall E. Sampsell, Clerk.

44 And on the same day to-wit: the fifteenth day of January, 1907, come the plaintiff in said entitled cause by his attorneys and filed in the clerk's office of said Court his certain petition for a writ of error and supersedeas, in words and figures following to-wit: Petition for error, 15, 1

PETITION FOR WRIT OF ERROR, AND SUPERSEDEAS.

IN THE CIRCUIT COURT OF THE UNITED STATES,

For the Northern District of Illinois—

Eastern Division.

Isaac H. Caliga,
vs.
Inter Ocean Newspaper Company, } 27,838

Petition for Writ of Error and Supersedeas.

And now comes the plaintiff herein and says that on the 22nd day of November, A. D. 1906, at the July term, 1906, of said court, a judgment was rendered in the above entitled cause, on the verdict of a jury in said cause, in favor of the defendant and against the plaintiff, denying the right and cause of action alleged and maintained by the plaintiff, and against the plaintiff for the costs of said action, in the rendition of which judgment, and in the record and proceedings had prior thereto, certain manifest errors have intervened to the prejudice of the said plaintiff, which errors are specified in detail in the assignment of errors filed with this petition.

Wherefore the plaintiff, feeling himself aggrieved by the verdict of the jury, and the judgment of the court entered
45 thereon and entered herein, comes now, by Otto R. Barnett and Clarence T. Morse, his attorneys and petitions

writ filed 1907.

the Court for an order allowing said plaintiff to prosecute a writ of error to the United States Circuit Court of Appeals for the Seventh Circuit; and also that an order be made fixing the amount of security which the said plaintiff shall give and furnish upon said writ of error, and that upon the giving of such security all further proceedings in this court be suspended and stayed until the determination of said writ of error by the United States Circuit Court of Appeals for the Seventh Circuit.

And the said plaintiff herewith presents his assignment of errors and will ever pray, etc.

OTTO R. BARNETT,
CLARENCE T. MORSE,
Attorneys for Plaintiff in error.

(Endorsed) Filed Jan. 15, 1907, Marshall E. Sampsell, Clerk.

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And on the same day to-wit: the fifteenth day of January, 1907, come the plaintiff in said entitled cause by his attorneys and filed in the clerk's office of said Court his certain assignment of errors in words and figures following to-wit:

ASSIGNMENT OF ERRORS.

IN THE CIRCUIT COURT OF THE UNITED STATES,

For the Northern District of Illinois—

Eastern Division.

Isaac H. Caliga,
vs.
Inter Ocean Newspaper Company, } No. 27838.

Assignment of Errors.

46 And now comes the plaintiff Isaac H. Caliga, by his attorneys Otto R. Barnett and Clarence T. Morse, and says that in the record and proceedings, and in the said

judgment in the said Circuit Court in the said cause are manifest errors, in this, to-wit: Assig... err... Jan...

I.

The Court erred in entering judgment in favor of defendant.

II.

The Court erred in instructing the jury to find a verdict for defendant.

III.

The Court erred in instructing the jury that in October 1901, the plaintiff had taken all steps necessary to get a copyright.

IV.

The court erred in instructing the jury that the plaintiff brought his suit under the wrong copyright and that the second copyright, being the copyright of November 7, 1901, is a nullity.

V.

That the Court erred in instructing the jury as follows:
"You will now go through the formality of signing the verdict, because I charge you, as a matter of law, that the plaintiff fails because he bases his suit upon the wrong copyright. One of your number will please sign the verdict, finding the defendant not guilty."

VI.

The Court erred in not instructing the jury in accordance with instruction No. 1, as requested by the plaintiff, as set forth in full in the bill of exceptions herein.

VII.

The Court erred in not instructing the jury in accord-
47 ance with instruction No. 3 requested by plaintiff, as set forth in full in the bill of exceptions herein.

of
ed
1907.

VIII.

The Court erred in not instructing the jury in accordance with instruction No. 6, requested by plaintiff, as set forth in full in the bill of exceptions herein.

IX.

The Court erred in not instructing the jury in accordance with instruction No. 10, requested by plaintiff, as set forth in full in the bill of exceptions herein.

X.

The Court erred in not instructing the jury in accordance with instruction No. 13, requested by plaintiff, as set forth in full in the bill of exceptions herein.

XI.

The Court erred in not instructing the jury in accordance with instructions No. 15 requested by plaintiff, as set forth in full in the bill of exceptions herein.

XII.

The Court erred in refusing to submit said cause to the jury and determining questions of fact which should have been so submitted to the jury.

Wherefore, and for divers other errors appearing in the said record and proceedings, said plaintiff in error prays that the said judgment may be reversed, etc.

OTTO R. BARNETT,
CLARENCE T. MORSE,
Attorneys for Plaintiff in Error.

(Endorsed)

(Endorsed) Filed Jan., 15, 1907, Marshall E. Sampsell, Clerk.

48 And on the same day to-wit: the fifteenth day of January, 1907, being one of the days of the regular December term of said Court, 1906, in the record of proceedings thereof in said entitled cause before the Hon. Francis E. Baker, Circuit Judge, appears the following entry to-wit: Order of Jan. 1907.

ORDER OF JANUARY 15, 1907,

Allowing Writ of Error.

Isaac H. Caliga,
vs.
Inter Ocean Newspaper Company, } 27,838

And now on this day the said plaintiff having presented and filed its petition for a writ of error, together with an assignment of errors, in accordance with the rules of the United States Circuit Court of Appeals for the Seventh Circuit in that behalf and with the course and practice of this Court:—

It is Ordered that a writ of error be and hereby is allowed to have reviewed in the United States Circuit Court of Appeals for the Seventh Circuit the judgment heretofore entered herein, and that the amount of bond and security on said writ of error be and it is hereby fixed at the sum of five hundred ($500.) dollars, said writ to issue upon the filing and approval of the bond, and that said bond, when approved by the clerk shall serve as a supersedeas herein.

49 And on the same day to-wit: the fifteenth day of January, 1907, came the plaintiff in said entitled cause and filed in the clerk's office of said Court his certain Bond on Writ of error in words and figures following to-wit: Bond on error, Jan. 15, 1907.

50 Know all Men by these Presents, That we, Isaac H. Caliga of Salem Massachusetts, as principal, and Simon Becker, of Chicago, Illinois, as sureties, are held and firmly bound unto Inter Ocean Newspaper Company, a corporation, of Chicago, Illinois, in the full and just sum of five hundred dollars to be paid to the said Inter Ocean Newspaper Company certain attorney, executors, administrators, or assigns; to which payment, well and truly to be made, we bind ourselves,

Writ of filed Jan. 7.

our heirs, executors and administrators, jointly and severally, firmly by these presents. Sealed with our seals and dated this fifteenth day of January in the year of our Lord one thousand nine hundred and seven.

Whereas, lately at a session of the Circuit Court of the United States for the Northern District of Illinois, in a suit pending in said Court, between said Isaac H. Caliga plaintiff, and said Inter Ocean Newspaper Company, defendant, a judgment was rendered against the said Isaac H. Caliga and in favor of said Inter Ocean Newspaper Company for the costs of said suit to-wit: on the 1 day of November, 1906, and denying the right of said Isaac H. Caligo, to maintain said suit, and the said Isaac H. Caliga, having obtained from said Court a writ of error and filed a copy thereof in the Clerk's Office of the said Court to reverse the judgment in the aforesaid suit, and a citation to the said Inter Ocean Newspaper Company, citing and admonishing it to be and appear at the United States Circuit Court of Appeals for the Seventh Circuit, to be holden at Chicago within thirty days from the date hereof.

Now, the condition of the above obligation is such, That if the said Isaac H. Caliga, shall prosecute said writ to effect, and shall answer all damages and costs that may be awarded against him if he fail to make his plea good, then the above obligation to be void; otherwise to remain in full force and virtue.

ISAAC H. CALIGA, (Seal)
SIMON BECKER, (Seal)
H. S. S.
.....(Seal

Sealed and delivered in presence of—
ANDREW PUTNAM,
To I. H. C.
REBECCA PUTNAM,
Approved by—
MARSHALL E. SAMPSELL,
Clerk.

(Endorsed) Filed Jan.. 15, 1907, Marshall E. Sampsell, Clerk.

54 United States of America, } ss:

Writ of error filed Jan. 1907.

The President of the United States, To the Honorable the Judges of the Circuit Court of the United States for the Northern District of Illinois, Greeting:

Because in the record and proceedings, as also in the rendition of the judgment of a plea which is in the said Circuit Court before you, or some of you, between Isaac H. Caliga, Plaintiff vs. Inter Ocean Newspaper Company, defendant, a manifest error hath happened, to the great damage of the said Isaac H. Caliga, as by his complaint appears. We being willing that error, if any hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the United States Circuit Court of Appeals for the Seventh Circuit, together with this writ, so that you have the same in the said United States Circuit Court of Appeals for the Seventh Circuit at Chicago, within thirty days from the date hereof, that the record and proceedings aforesaid being inspected, the said United States Circuit Court of Appeals for the Seventh Circuit may cause further to be done therein to correct that error, what of right, and according to the laws and customs of the United States should be done.

Witness the Honorable Melville W. Fuller, Chief Justice of the United States, the Fifteenth day of January, in the year of our Lord one thousand nine hundred and seven.

MARSHALL E SAMFSELL

(Seal) *Clerk of the Circuit Court of the United States for the Northern Dist. of Illinois.*

Allowed by

FRANCIS E. BAKER

Judge.

writ.
15,

Northern District of Illinois, } ss:

In obedience to the within writ, I herewith transmit to the United States Circuit Court of Appeals for the Seventh Circuit, a true and complete transcript of the record and proceedings in the foregoing entitled cause this 13th day of February A. D. 1907.

MARSHALL E SAMPSELL
(Seal) *Clerk United States Circuit Court, Northern District of Illinois.*

(Endorsed) Writ of Error. Filed Jan 15, 1907 Marshall E Sampsell Clerk

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1907.

51 PRAECIPE FOR TRANSCRIPT OF RECORD.

IN THE CIRCUIT COURT OF THE UNITED STATES,

For the Northern District of Illinois—

Eastern Division.

Isaac H. Caliga,
vs.
Inter Ocean Newspaper Company, } No. 27838.

To the Clerk of said Court:—

You will please prepare a transcript of the record in this cause to be filed in the office of the United States Circuit Court of Appeals for the Seventh Circuit, under the writ of error heretofore allowed by said Court and include in the said transcript the following pleadings, proceedings and papers on file, to-wit:

Praecipe.
Amended Declaration, filed June 22, 1906.
Plea of General Issue, filed June 29, 1906.
Similiter, filed July, 1906.
Order of November 21, 1906, leave to amend Narr.
Amendment to Narr of November 21, 1906.
Order of November 21, 1906, called for trial, jury sworn, etc.
Order of November 21, 1906, evidence for plaintiff concluded, etc.

Judgment of November 22, 1906. Praecipe trans. Jan.
Order of November 22, 1906, setting time for filing bill of exceptions.
Bill of Exceptions.
Petition for Writ of error.
Assignment of Errors.
Order of January 15, 1907, allowing writ of error upon filing bond.
Bond on writ of error.

52 Said transcript to be prepared as required by law and the rules of this Court and the rules of the United States Circuit Court of Appeals for the Seventh Circuit and on file at the office of the said clerk of said Circuit Court of Appeals, at Chicago, Illinois, before February 14th, 1907, and will please attach the writ of error and citation therein to said transcript.

CLARENCE T. MORSE,
OTTO R. BARNETT,
Attorneys for Plaintiff in Error.

(Endorsed) Filed Jan. 21, 1907, Marshall E. Sampsell, Clerk.

53 Northern District of Illinois, Eastern Division. } ss.

I, Marshall E. Sampsell, Clerk of the Circuit Court of the United States for the Northern District of Illinois, do hereby certify the above and foregoing to be a true and complete transcript of the proceedings had of record in said court and made in accordance with Praecipe filed in the cause entitled Isaac H. Caliga, Plaintiff vs. Inter Ocean Newspaper Company, Defendant, General Number 27,838, as the same appear from the original records and files of said Court now remaining in my custody and control. Certificate clerk.

In Testimony Whereof, I have hereunto set my hand and affixed the seal of said Court, at my office in the City of Chicago, in said District, this 13th day of February 1907

MARSHALL E SAMPSELL
Clerk.

(Seal)

55 United States of America, } ss.

The President of the United States, To Inter Ocean Newspaper Company, Greeting:

You are hereby cited and admonished to be and appear at a United States Circuit Court of Appeals, for the Seventh Circuit, to be holden at Chicago, within thirty days from the date hereof, pursuant to a Writ of Error, filed in the Clerk's Office of the Circuit Court of the United States for the Northern District of Illinois, Eastern Division, wherein Isaac H. Caliga is the Plaintiff in Error and you are defendant in error, to show cause, if any there be, why the Judgment rendered against the said plaintiff in error as in the said Writ of Error mentioned, should not be corrected and why speedy justice should not be done to the parties in that behalf.

Witness the Honorable Francis E. Baker, Judge of the Circuit Court of the United States, for the Seventh Judicial Circuit this 15th day of January, in the year of our Lord one thousand nine hundred and seven.

FRANCIS E. BAKER,
Circuit Judge.

Service of the within citation accepted this 22nd day of January, A. D. 1907

KNIGHT & HOYNE,
Attys for defendant in error

(Endorsed) Citation. Filed Jan 23 1907 Marshall E. Sampsell, Clerk.

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United States Circuit Court of Appeals for the Seventh Circuit.

I, Edward M. Holloway, Clerk of the United States Circuit Court of Appeals for the Seventh Circuit, do hereby certify that the foregoing printed pages, numbered from 1 to 48, inclusive, contain a true copy of the printed record filed in this court on the fourth day of March, 1907, which was prepared for the printer, supervised, indexed and distributed by me in accordance with the rules of this court and upon which the cause was heard and determined by the United States Circuit Court of Appeals for the Seventh Circuit, in the case of Isaac H. Caliga, *vs.* Inter Ocean Newspaper Company, No. 1365, October Term, 1906, as the same remains upon the files and records of the United States Circuit Court of Appeals, for the Seventh Circuit.

In testimony whereof I hereunto subscribe my name and affix the seal of said United States Circuit Court of Appeals for the Seventh Circuit, at the City of Chicago, this fourth day of November A. D. 1907.

[Seal United States Circuit Court of Appeals, Seventh Circuit.]

EDWARD M. HOLLOWAY,
Clerk of the United States Circuit Court of Appeals for the Seventh Circuit.

UNITED STATES OF AMERICA, *ss:*

The President of the United States to the Honorable the Judges of the Circuit Court of Appeals for the Seventh Circuit, Greeting:

Because in the record and proceedings, as also in the rendition of the judgment of a plea which is in the said Circuit Court of Appeals before you, or some of you, between Isaac H. Caliga, of Salem, County of Essex, State of Massachusetts, plaintiff in error, and Inter Ocean Newspaper Company, a corporation, of Chicago, County of Cook, State of Illinois, defendant in error, a manifest error hath happened, to the great damage of the said Isaac H. Caliga, as by his complaint appears. We being willing that error, if any hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you have the same in the said Supreme Court at Washington, within 30 days from the date hereof, that the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done therein to correct that error, what of right, and according to the laws and customs of the United States should be done.

Witness the Honorable Melville W. Fuller, Chief Justice of the

United States, the 1st day of November, in the year of our Lord one thousand nine hundred and seven.

[Seal United States Circuit Court of Appeals, Seventh Circuit.]

EDWARD M. HOLLOWAY,
Clerk of the United States Circuit Court of Appeals for the Seventh Circuit.

Allowed by

PETER S. GROSSCUP,
WILLIAM H. SEAMAN,
United States Circuit Judges.

UNITED STATES OF AMERICA,
Seventh Judicial Circuit, ss:

In obedience to the within writ, I herewith transmit to the Supreme Court of the United States, a true and complete copy of the printed record filed in this court on the fourth day of March, A. D. 1907, which was prepared for the printer, supervised, indexed and distributed by me in accordance with the rules of this court and upon which the cause was heard and determined in the United States Circuit Court of Appeals for the Seventh Circuit; and also a true and complete copy of all the papers filed (except briefs of counsel—and proceedings had thereon in the United States Circuit Court of Appeals for the Seventh Circuit, in the foregoing entitled cause, this fourth day of November, A. D. 1907.

[Seal United States Circuit Court of Appeals, Seventh Circuit.]

EDWARD M. HOLLOWAY,
Clerk of the United States Circuit Court of Appeals for the Seventh Circuit.

At a regular term of the United States Circuit Court of Appeals for the Seventh Circuit, begun and held at the United States Court Rooms in the City of Chicago in the said Seventh Circuit on the second day of October, 1906, of the October Term in the year of our Lord one thousand nine hundred and six and of our Independence the one hundred and thirty-first.

And afterwards, to-wit: On the twenty-third day of February, 1907, in the October term last aforesaid, came Plaintiff-in-error, by his counsel Mr. Otto Raymond Barnett, and filed in the office of the clerk of this court his appearance, which appearance is in the words and figures following, to-wit:

United States Circuit Court of Appeals for the Seventh Circuit, October Term, 1906.

No. 1365.

ISAAC H. CALIGA, Plaintiff-in-Error,
vs.
INTER OCEAN NEWSPAPER COMPANY, Defendant-in-Error.

The Clerk will enter my appearance as counsel for the Plaintiff-in-Error.

OTTO RAYMOND BARNETT.

Endorsed: Filed Feb. 23, 1907. Edward M. Holloway, Clerk.

And afterwards, to-wit: On the same day, to-wit: On the twenty-third day of February, 1907, in the October term last aforesaid, came the Defendant-in-error, by its counsel Mr. Clarence A. Knight and Mr. Maclay Hoyne, and filed in the office of the clerk of this court their appearance, which appearance is in the words and figures following, to-wit:

United States Circuit Court of Appeals for the Seventh Circuit, October Term, 1906.

No. 1365.

ISAAC H. CALIGA, Plaintiff-in-Error,
vs.
INTER OCEAN NEWSPAPER COMPANY, Defendant-in-Error.

The Clerk will enter my appearance as Counsel for the Defendant-in Error.

CLARENCE A. KNIGHT.
MACLAY HOYNE.

Endorsed: Filed Feb. 23, 1907. Edward M. Holloway, Clerk.

And afterwards, to-wit: On the sixteenth day of April, 1907, in the October term last aforesaid, the following further proceedings were had and entered of record, to-wit:

TUESDAY, *April* 16, 1907.

Court met pursuant to adjournment and was opened by proclamation of Crier.

Present: Hon. Peter S. Grosscup, Circuit Judge, presiding; Hon. Francis E. Baker, Circuit Judge; Hon. William H. Seaman, Circuit Judge; Edward M. Holloway, Clerk; Luman T. Hoy, Marshal.

And afterwards, to-wit: On the sixteenth day of April, 1907, in the October term last aforesaid, the following further proceedings were had and entered of record, to-wit:

TUESDAY, *April* 16, 1907.

Court met pursuant to adjournment and was opened by proclamation of crier.

Present: Hon. Peter S. Grosscup, Circuit Judge, presiding; Hon. Francis E. Baker, Circuit Judge; Hon. William H. Seaman, Circuit Judge; Hon. Christian C. Kohlsaat, Circuit Judge; Edward M. Holloway, Clerk; Luman T. Hoy, Marshal.

Before Hon. Francis E. Baker, Circuit Judge; Hon. William H. Seaman, Circuit Judge.

1365.

ISAAC H. CALIGA
vs.
INTER OCEAN NEWSPAPER COMPANY.

Error to the Circuit Court of the United States for the Northern District of Illinois, Eastern Division.

It is ordered by the court that this cause, be, and the same is hereby set down for hearing April 19, 1907.

And afterwards, to-wit: On the nineteenth day of April, 1907, in the October term last aforesaid, the following further proceedings were had and entered of record, to-wit:

FRIDAY, *April* 19, 1907.

Court met pursuant to adjournment and was opened by proclamation of crier.

Present: Hon. Peter S. Grosscup, Circuit Judge, presiding; Hon. Francis E. Baker, Circuit Judge; Hon. William H. Seaman, Circuit Judge; Hon. Christian C. Kohlsaat, Circuit Judge; Edward M. Holloway, Clerk; Luman T. Hoy, Marshal.

Before Hon. Peter S. Grosscup, Circuit Judge; Hon. William H. Seaman, Circuit Judge; Hon. Christian C. Kohlsaat, Circuit Judge.

1365.

ISAAC H. CALIGA
vs.
INTER OCEAN NEWSPAPER COMPANY.

Error to the Circuit Court of the United States for the Northern District of Illinois, Eastern Division.

Now this day come the parties by their counsel and this cause now comes on to be heard on the printed record and briefs of counsel

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and on oral argument by Mr. Otto R. Barnett, counsel for plaintiff-in-error, and by Mr. Clarence A. Knight, counsel for defendant-in-error, and the court having heard the same takes this matter under advisement.

At a regular term of the United States Circuit Court of Appeals for the Seventh Circuit, begun and held at the United States Court rooms in the City of Chicago in said Seventh Circuit on the first day of October, A. D. nineteen hundred and seven, of the October term in the year of our Lord One thousand nine hundred and seven and of our Independence the one hundred and thirty second.

And afterwards, to-wit: On the first day of October, 1907, in the October term last aforesaid, there was filed in the office of the clerk of this court the opinion of the court in the above entitled cause, which opinion is in the words and figures following, to-wit:

In the United States Circuit Court of Appeals for the Seventh Circuit.

No. 1365.

October Term, A. D. 1906, April Session, A. D. 1907.

ISAAC H. CALIGA, Plaintiff-in-Error,
vs.
INTER OCEAN NEWSPAPER COMPANY.

Error to the Circuit Court of the United States for the Northern District of Illinois, Eastern Division.

Before Grosscup, Seaman and Kohlsaat, Circuit Judges.

The plaintiff in error was plaintiff below in an action of debt, under sec. 4965 U. S. R. S., against Inter Ocean Newspaper Company, for violation of copyright of the plaintiff's painting, and the writ of error is brought from a judgment therein in favor of such defendant, upon trial and directed verdict.

The declaration avers, in substance, that the plaintiff was the author, designer and proprietor of an oil painting thus described: "The Guardian Angel. Portrait of a young girl sitting, hair arranged smoothly over the ears, hair parted in the middle. Her guardian angel stands behind her, one hand resting on her left shoulder, the other on her right arm;" that it had not been theretofore published; that he did, "towit, on or about the 5th day of November A. D. 1901" take steps (as recited) to obtain a copyright; that such description of the painting was duly recorded by the Librarian of Congress "towit: on or about the 7th day of November, A. D. 1901;" that the painting was thereupon duly copyrighted; that notice of such copyright was inscribed upon the painting; and that the plaintiff is sole owner and proprietor of such copyright and painting. Infringement by the defendant is averred, in printing and publishing copies of the painting in its newspaper, "towit; upwards of one thousand copies thereof," on or about October 25, 1903.

Under plea of general issue, the trial proceeded before a jury, with proof on behalf of the plaintiff primarily, supporting the declaration in a copyright of the date and description alleged, and publication by the defendant without consent. In the testimony of the plaintiff, however, it further appeared, and was conceded to be the fact, that the plaintiff had procured a copyright of the identical painting, on October 7, 1901, under the description: "Maidenhood; A Young Girl seated beside a Window; An Angel stands behind her;" also, that the painting was submitted to Curtis & Cameron, publishers, prior to October, "to have the picture published by them," and was photographed for that object.

Thereupon the court instructed the jury to find the defendant not guilty, and verdict was rendered accordingly. Error is assigned in various forms, both upon the direction so given and refusal of several instructions requested on behalf of the plaintiff, but the reviewable questions arise under the direction of verdict.

SEAMAN, *Circuit Judge*, delivered the opinion of the Court:

This suit is for recovery of the penalties imposed by statute (§4965 U. S. R. S., 3 U. S. Comp. St. p. 3414) for violation of an alleged copyright of a painting produced and owned by the plaintiff in error. With recovery so sought, under the special right conferred by statute and not existing at common law, the rule is elementary which requires strict construction and proof for enforcement of such right. *Wheaton v. Peters*, 8 Pet. 591, 663; 3 Notes U. S. Rep. 485; *Mifflin v. R. H. White Co.*, 190 U. S., 260, 264; *Bobbs-Merrill Co. v. Straus*, 147 Fed. 15, 21, 23, CCA ; *White-Smith Music Pub. Co. v. Apollo Co.*, 147 Fed. 226, 227, CCA . The trial court directed a verdict of not guilty, upon the view that no valid copyright appeared under the registration of November 7, 1901, not only averred in the declaration, but proven and relied upon on the trial. Such ruling was predicated upon the fact—disclosed in cross examination of the plaintiff in error and subsequently admitted of record—that the author had procured a prior registration, on October 7, 1901, by filing "a photograph of the painting in question," with this description: "Maidenhood; a young girl seated beside a window; an angel stands behind her." In the registration of November 7, the name was changed to "The Guardian Angel," with description amplified; and the only question for review, in our understanding of the issues and conceded facts—including the transactions with and of Curtis & Cameron—is whether the statutory copyright was acquired by this registration in suit.

While the bill of exceptions shows no claim or offer made on behalf of the plaintiff in error, under the registration of October 7, either in the course of the testimony, or in the instructions requested and referred to in the assignments of error, reversal is sought upon the contention, that recovery was authorized under one or the other registration and the direction was erroneous in either view. The propositions are, in substance, that the date of the copyright was "pleaded under a *vide licet*," and the (assumed) variance in proof was not fatal, because the particular date in such allegations is to

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be treated as forming no material part of the issue of fact tendered by the declaration, when the defendant is not misled or surprised. Were it true, that such variance appeared between the averment and proof, and in date alone, it may be that the authorities cited would then be applicable to disregard the mere difference in date, where a single registration was proven. In this instance, however, the averments and proof are identical, both in date and subject matter, so that no question of variance arises. The sole issue tendered and heard was upon this November registration as creating the alleged copyright, with no reference to the prior registration or intimation thereof, until that fact was brought out by the defense, by way of impeaching the claim in suit; and without proof applicable at least to the October registration, meeting the strict requirements for penal recovery, submission to the jury was not authorized in any view of the issue joined. The question whether a valid copyright was acquired under the prior registration is not, therefore, open for review, although the effect of that procedure must be considered in testing the validity of the right set up under the November registration for penal recovery.

With the controversy thus narrowed, as we believe, the various other propositions which are discussed by counsel, together with the numerous authorities cited and reviewed thereupon, are not within the issue. Recent authorities have so clearly settled the rule as to the bearing and status of the common law copyright, when the statutory benefits are invoked, that these deductions are deemed sufficient to answer the contentions thereunder: The property rights of the author in his production, intellectual or artistic, are two-fold—absolute ownership of the corporeal production, alike with other property ownership, and an independent right to make duplications, which is equally his own so long as he withholds from publication to the world. The first mentioned right is unaffected by either class of copyright; and one or both are subject to his disposition, absolute or qualified, in common with other property rights. While publication is withheld, his right of first publication is exclusive. When he voluntarily releases to the public, by general publication, this common law right of exclusive publication is surrendered. Unless he obtains on or before publication, the protection of the statutory copyright, the public is unrestrained in duplications; with the copyright obtained his right to publish and sell all copies becomes exclusive thereunder for the statutory term. Thus the benefits of the statute are substituted for the imperfect benefits of the common law ownership, by his surrender of the perpetual right to withhold from publication. These rights are separate and not coexistent—the common law right ends when the statutory rights begins. *Holmes v. Hurst*, 174 U. S. 82, 85; *Bobbs-Merrill Co. v. Straus*, 147 Fed. 15, 18— CCA ; Drone on Copyright 100.

The validity of the copyright in question is challenged upon two grounds: (1) Disclosure of a prior (*prima facie*) copyright of the same subject matter, under the October registration; (2) Prior publication, either under the transactions of Curtis & Cameron, or through the October registration. If one or the other of these ob-

jections is supported by the evidence referred to, no escape appears from the conclusion that the objection is fatal.

1. Whether the registration of October resulted in a valid copyright, is not (as before mentioned) involved in the issue. Nevertheless, the conceded fact of such registration by the plaintiff in error must be considered in testing the validity of the alleged copyright under the subsequent filing. The contention in support of the copyright is substantially this: that the established rule of the patent law against duplication of patents for the same invention, (*Miller v. Eagle Manuf. Co.*, 151 U. S. 186, 197; 12 Notes U. S. Rep. 485) is not applicable to copyrights, because no express grant of monopoly issues as in the case of patents; and that duplications of registry for the same subject matter are allowable, and so recognized in *Black v. Allen*, 56 Fed. 764, 769. Neither of these contentions impresses us as tenable. The grant of monopoly is conferred alike by statute in both instances, upon due application, although in respect of patents the methods differ in the needful discrimination for patentability and in the form of issue. The applicant for a copyright (sec. 4956, R. S., 3 U. S. Comp. Stat. p. 3407) deposits in the office of the Librarian the required matter, and record is there made. Upon compliance on the part of an author with this requirement, the grant ensues, as of course, under sec. 4952 R. S., 3 U. S. Comp. Stat. p. 3406. So the copyright is equally a grant, however simple the method of acquiring, and when once conferred, there is neither authority nor occasion for a second grant to the author for the same production. Duplication is necessarily inoperative, as in the case of the patent for invention, and the authorities are harmonious in this view. *Mifflin v. Dalton*, 112 Fed. 1004, 1005,.....CCA....., affirmed 190 U. S. 265; *Lawrence v. Dana*, 4 Cliff. 1, No. 8136 Fed. Cas. For new matter only in new editions can another copyright be obtained. *Ibid;* Drone on Copyright, 146. In the case of *Black v. Allen*, 56 Fed. 764, 769, cited *contra*, which arose in equity and involved equitable considerations, the present inquiry and strict view of the proceedings for copyright were not passed upon, nor do we understand the opinion or ruling to rest the rights of the complainant upon duplication of copyright. It goes without saying that the author is bound only by such filing for copyright as he authorizes or adopts.

As the statutory copyright is acquired through the simple act of the author in making the deposit, the admission that he made such deposit in October—even referring to it in his testimony as his "first copyright"—clearly impeaches the alleged copyright of November, unless accompanied by proof that the prior deposit was inoperative. No such proof appears and none was offered. The mere fanciful change in naming the painting, "The Guardian Angel" on the second filing, instead of "Maidenhood," as previously designated, cannot be accepted for a new grant of copyright; nor the further details in the description, when those first given were plainly sufficient for identity. Whatever the rights may be for filing notice of change of name adopted for the author's work, no

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sanction appears for this independent filing of the matter, unexplained, as another copyright. We are of opinion that such course was confusing and unauthorized by way of copyright, and that the transaction cannot be upheld in the face of the conceded facts.

2. The question whether publication does not appear, prior to the November registry—either in the transactions of Curtis & Cameron, under their arrangement with the author, or in the fact of registration of the photograph and description in October—does not require solution under the foregoing view. The authorities cited for the contention that such registration amounts to publication, are the well considered cases of *Bobbs-Merrill Co. v. Straus, supra* (p. 21), and *Jewelers' Mer. Agency v. Jewelers' Pub. Co.*, 155 N. Y. 240, 254, and in view of the purpose and publicity of the registration, this objection, to say the least, could not be set aside without careful consideration—the statute providing (§ 4956 *supra*) that the matter must be filed "on or before the day of publication." We refrain from decision thereupon, content to rest affirmance of the judgment upon the first mentioned ground.

The judgment of the Circuit Court is affirmed.

And afterwards, on the same day, to-wit: On the first day of October, 1907, in the October term last aforesaid, the following further proceedings were had and entered of record, to-wit:

TUESDAY, *October* 1, 1907.

Court met pursuant to adjournment and was opened by proclamation of crier.

Present: Hon. Peter S. Grosscup, Circuit Judge presiding; Hon. Francis E. Baker, Circuit Judge; Hon. William H. Seaman, Circuit Judge; Hon. Christian C. Kohlsaat, Circuit Judge; Edward M. Holloway, Clerk; Luman T. Hoy, Marshal.

Before Hon. Peter S. Grosscup, Circuit Judge; Hon. William H. Seaman, Circuit Judge; Hon. Christian C. Kohlsaat, Circuit Judge.

ISAAC H. CALIGA
vs.
INTER OCEAN NEWSPAPER COMPANY.

Error to the Circuit Court of the United States for the Northern District of Illinois, Eastern Division.

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Northern District of Illinois, and was argued by counsel.

On consideration whereof, It is now here ordered and adjudged by this court that the judgment of the said circuit court in this cause, be, and the same is hereby affirmed with costs.

And afterwards, to-wit: On the twenty-ninth day of October, 1907, in the October term last aforesaid, the following further proceedings were had and entered of record, to-wit:

TUESDAY, *October* 29, 1907.

Court met pursuant to adjournment and was opened by proclamation of crier.

Present: Hon. Peter S. Grosscup, Circuit Judge, presiding; Hon. Francis E. Baker, Circuit Judge; Hon. William H. Seaman, Circuit Judge; Edward M. Holloway, Clerk; Luman T. Hoy, Marshal.

Before Hon. Peter S. Grosscup, Circuit Judge; Hon. William H. Seaman, Circuit Judge.

ISAAC H. CALIGA
vs.
INTER OCEAN NEWSPAPER COMPANY.

Error to the Circuit Court of the United States for the Northern District of Illinois, Eastern Division.

On motion of Mr. Clarence T. Morse, counsel for plaintiff-in-error, it is ordered that the mandate in this cause, be, and the same is hereby stayed twenty days from the time allowed by the rules of this court.

And afterwards, to-wit: On the first day of November, 1907, in the October term last aforesaid, came the Plaintiff in error by his counsel Mr. Otto R. Barnett and Mr. Clarence T. Morse, and filed in the office of the clerk of this court his petition for writ of error and supersedeas, which petition is in the words and figures following, to-wit:

UNITED STATES OF AMERICA:

In the United States Circuit Court of Appeals for the Seventh Circuit.

ISAAC H. CALIGA, Plaintiff-in-Error,
vs.
INTER OCEAN NEWSPAPER COMPANY, Defendant-in-Error.

Petition for Writ of Error and Supersedeas.

And now comes the plaintiff herein and says that on the first day of October, 1907, at the October Term 1907, of the said Court, a judgment was rendered in the above entitled cause upon writ of error affirming a judgment of the Circuit Court of the United States for the Northern District of Illinois, Eastern Division, in favor of the defendant, against the plaintiff, and denying the right and cause of action alleged and maintained by the plaintiff awarding said defendant in error costs upon said writ of error, in the rendition of which judgment of affirmance, and in the records and proceedings had prior thereto, certain manifest errors have intervened to the prejudice of this plaintiff, which errors are specified in detail in the assignment of errors filed with this petition.

Wherefore, this plaintiff, feeling himself aggrieved by said judg-

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ment of said Circuit Court of Appeals, comes now, by Otto R. Barnett and Clarence T. Morse, his attorneys, and petitions this Honorable Court for an order allowing said plaintiff a writ of error to the Supreme Court of the United States; and also that an order be made fixing the amount of security which said plaintiff shall give and furnish upon said writ of error, and that, upon the giving of such security, all further proceedings in the Circuit Court of Appeals and said Circuit Court, may be suspended and stayed until the determination of said writ of error by this court.

And said plaintiff herewith presents his assignment of errors, and will ever pray, etc.

OTTO R. BARNETT.
CLARENCE T. MORSE.

Nov. 1st, 1907.

Endorsed: Filed Nov. 1, 1907. Edward M. Holloway, Clerk.

And afterwards, on the same day, to-wit: On the first day of November, 1907, in the October term last aforesaid, came the plaintiff in error by his counsel, Mr. Otto R. Barnett and Mr. Clarence T. Morse, and filed in the office of the clerk of this court his assignment of errors, in the words and figures following, to-wit:

UNITED STATES OF AMERICA, *ss:*

In the Supreme Court of the United States.

ISAAC H. CALIGA, Plaintiff-in-Error,
v.
INTER OCEAN NEWSPAPER COMPANY, Defendant-in-Error.

Assignment of Errors.

And now comes the plaintiff in error, Isaac H. Caliga, by his attorneys Otto R. Barnett and Clarence D. Morse, and says that in the record and proceedings and in the said judgment in said Circuit Court of Appeals for the Seventh Circuit, in said cause, are manifest errors in this, to-wit:

I.

The Circuit Court of Appeals erred in affirming the judgment of the Circuit Court.

II.

The Circuit Court of Appeals erred in overruling the assignment of error numbered I made by the plaintiff in error against the decision of the Circuit Court, which said assignment is as follows, to-wit:

I. The Court erred in entering judgment in favor of defendant.

III.

The Circuit Court of Appeals erred in overruling the assignment of error numbered II, which the plaintiff in error made against the

decision of the Circuit Court, which said assignment is as follows, to-wit:

II. The Court erred in instructing the jury to find a verdict for the defendant.

IV.

The Circuit Court of Appeals erred in overruling the assignment of error numbered III, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

III. The Court erred in instructing the jury that in October 1901, the plaintiff had taken all steps necessary to get a copyright.

V.

The Circuit Court of Appeals erred in overruling the assignment of error numbered IV, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

IV. The Court erred in instructing the jury that the plaintiff brought his suit under the wrong copyright and that the second copyright, being the copyright of November 7, 1901, is a nullity.

VI.

The Circuit Court of Appeals erred in overruling the assignment of error numbered V, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

V. The *the* Court erred in instructing the jury as follows: "You will now go through the formality of signing the verdict, because I charge you as a matter of law, that the plaintiff fails because he bases his suit upon the wrong copyright. One of your number will please sign the verdict, finding the defendant not guilty."

VII.

The Circuit Court of Appeals erred in overruling the assignment of error numbered VI, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

"VI. The Court erred in not instructing the jury in accordance with instruction No. 1, as requested by the plaintiff, as set forth in full in the bill of exceptions herein.

VIII.

The Circuit Court of Appeals erred in overruling the assignment of errors numbered VII, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

VII. The Court erred in not instructing the jury in accordance with instruction No. 3 requested by plaintiff, as set forth in full in the bill of exceptions herein.

IX.

The Circuit Court of Appeals erred in overruling the assignment of error numbered VIII, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

VIII. The Court erred in not instructing the jury in accordance with instruction No. 6 requested by plaintiff, as set forth in full in the bill of exceptions herein.

X.

The Circuit Court of Appeals erred in overruling the assignment of error numbered IX, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

IX. The Court erred in not instructing the jury in accordance with instruction No. 10, requested by plaintiff, as set forth in full in the bill of exceptions herein.

XI.

The Circuit Court of Appeals erred in overruling the assignment of error numbered X, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

X. The Court erred in not instructing the jury in accordance with instruction No. 13, requested by plaintiff, as set forth in full in the bill of exceptions herein.

XII.

The Circuit Court of Appeals erred in overruling the assignment of error numbered XI, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

XI. The Court erred in not instructing the jury in accordance with instruction No. 15, requested by the plaintiff, as set forth in full in the bill of exceptions herein.

XIII.

The Circuit Court of Appeals erred in overruling the assignment of error numbered XII, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

XII. The Court erred in refusing to submit said cause to the jury and determining questions of fact which should have been so submitted to the jury.

Wherefor, and for divers other errors appearing in the said record and proceedings, said plaintiff in error prays that said judgment may be reversed.

OTTO BARNETT.
CLARENCE T. MORSE.

Nov. 1st, 1907.

Endorsed: Filed Nov. 1, 1907. Edward M. Holloway, Clerk.

And afterwards, on the same day, to-wit: On the first day of November, 1907, in the October term last aforesaid, the following further proceedings were had and entered of record, to-wit:

FRIDAY, *November* 1, 1907.

Court met pursuant to adjournment and was opened by proclamation of crier.

Present: Hon. Peter S. Grosscup, Circuit Judge, presiding; Hon. Francis E. Baker, Circuit Judge; Hon. William H. Seaman, Circuit Judge; Edward M. Holloway, Clerk; Luman T. Hoy, Marshal.

Before Hon. Peter S. Grosscup, Circuit Judge; Hon. William H. Seaman, Circuit Judge.

1365.

ISAAC H. CALIGA
vs.
INTER OCEAN NEWSPAPER COMPANY.

Error to the Circuit Court of the United States for the Northern District of Illinois, Eastern Division.

And now on this date the said plaintiff having presented and filed his petition for a writ of error, together with an assignment of errors, in accordance with the rules of the Supreme Court of the United States,

It is ordered that a writ of error be, and hereby is allowed, to have reviewed in the Supreme Court of the United States the judgment of affirmance heretofore entered in said Circuit Court of Appeals and that the amount of the bond and security on said writ of error be, and it is hereby, fixed at the sum of Five Hundred ($500) Dollars, said writ to issue upon the filing and approval of the bond and said bond, when approved, to serve as a supersedeas herein.

And afterwards, on the same day, to-wit: On the first day of November, 1907, in the October term last aforesaid, there was filed in the office of the clerk of this court the bond on writ of error, which bond is in the words and figures following, to-wit:

Know all men by these presents, That we, Isaac H. Caliga, of the City of Salem, County of Essex, State of Massachusetts, as principal, and Simon Becker of Chicago, County of Cook and State of Illinois, as surety, are held and firmly bound unto Inter Ocean Newspaper Company, a corporation of said Chicago, in the full and just sum of Five Hundred (500) dollars, to be paid to the said Inter Ocean Newspaper Company its certain attorney, executors, administrators, or assigns: to which payment well and truly to be made, we bind ourselves, our heirs, executors and administrators, jointly and severally, by these presents. Sealed with our seals and dated this first day of November in the year of our Lord one thousand nine hundred and seven.

Whereas lately, at a term of the United States Circuit Court of Appeals for the Seventh Circuit, in a suit depending in said Court, between Isaac H. Caliga, plaintiff in error, and Inter Ocean Newspaper Company, defendant in error, a judgment was rendered against the said Isaac H. Caliga, affirming the judgment of the Circuit Court of the United States for the Northern District of Illinois, Eastern Division, and the said Isaac H. Caliga having obtained a writ of error and filed a copy thereof in the Clerk's Office of the said Court to reverse the judgment in the aforesaid suit, and a citation directed to the said Inter Ocean Newspaper Company, citing and admonishing it to be and appear at a Supreme Court of the United States, at Washington, within 30 days from the date thereof.

Now, the condition of the above obligation is such, That if the said Isaac H. Caliga shall prosecute to effect, and answer all damages and costs if he fail to make his plea good, then the above obligation to be void; else to remain in full force and virtue.

ISAAC H. CALIGA. [SEAL.]
SIMON BECKER. [SEAL.]

Sealed and delivered in presence of:
ALFRED W. PUTNAM,
To I. H. C.
REBECCA C. PUTNAM,
To I. H. C.

Approved by—
WM. H. SEAMAN,
Circuit Judge.

Endorsed: Filed Nov. 1, 1907. Edward M. Holloway, Clerk.

United States Circuit Court of Appeals for the Seventh Circuit.

I, Edward M. Holloway, Clerk of the United States Circuit Court of Appeals for the Seventh Circuit, do hereby certify that the foregoing typewritten and printed pages, numbered from 1 to 20, inclusive, contain a true copy of the papers filed (except briefs of counsel) and proceedings had thereon in the United States Circuit Court of Appeals for the Seventh Circuit, in the case of Isaac H. Caliga, *vs.* Inter Ocean Newspaper Company, No. 1365, October Term, 1906, as the same remains upon the files and records of the United States Circuit Court of Appeals, for the Seventh Circuit.

In testimony whereof I hereunto subscribe my name and affix the seal of said United States Circuit Court of Appeals for the Seventh Circuit, at the City of Chicago, this fourth day of November, A. D. 1907.

[Seal United States Circuit Court of Appeals, Seventh Circuit.]

EDWARD M. HOLLOWAY,
Clerk of the United States Circuit Court of Appeals for the Seventh Circuit.

UNITED STATES OF AMERICA, *ss.*:

To Inter Ocean Newspaper Company, a Corporation of Chicago, County of Cook, State of Illinois, Greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, at Washington, within thirty days from the date hereof, pursuant to a writ of error, filed in the Clerk's Office of the Circuit Court of Appeals of the United States for the Seventh Circuit, wherein Isaac H. Caliga, of Salem, County of Essex, State of Massachusetts, is plaintiff in error and you are defendant in error, to show cause, if any there be, why the judgment rendered against the said plaintiff in error as in the said writ of error mentioned, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness, the Honorable Wm. H. Seaman, United States Circuit Judge and one of the judges of the United States Circuit Court of Appeals for the 7th Circuit, the 1st day of November, in the year of our Lord one thousand nine hundred and seven.

WM. H. SEAMAN,
Circuit Judge of the United States.

Filed Nov. 1, 1907.
EDWARD M. HOLLOWAY, *Clerk.*

On this 1st day of November, in the year of our Lord one thousand nine hundred and seven, personally appeared John F. Finerty, Jr., before me, the subscriber, Minnie L. Burton, a notary public in and for Cook County, Illinois, and makes oath that he delivered a true copy of the within citation to Knight & Hoyne, attorneys for the defendant in error.

JOHN F. FINERTY, JR.

Sworn to and subscribed the 1st day of November, A. D. 1907.

[Seal Minnie L. Burton, Notary Public, Cook County, Ill.]

MINNIE L. BURTON,
Notary Public.

Endorsed on cover: File No. 20,898. U. S. circuit court appeals, 7th circuit. Term No. 200. Isaac H. Caliga, plaintiff in error, *vs.* Inter Ocean Newspaper Company. Filed November 6th, 1907. File No. 20,898.

IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1908.

ISAAC H. CALIGA, *Plaintiff in Error,*
vs.
INTER OCEAN NEWSPAPER COMPANY. } No. 200.

Brief for The Tribune Company as Amicus Curiae.

STATEMENT.

May it please the Court:

This brief is filed on behalf of "The Tribune Company" by leave of court first obtained; this Company is interested in the decision in this suit because a similar suit for recovery of the penalties imposed by Section 4965 of the Revised Statutes for violation of plaintiff's alleged copyright is pending against it in the Circuit Court of the United States for the Northern District of Illinois, in which suit there is a stipulation staying proceedings and providing *inter alia*

> "that if the ultimate determination of said cause of *Caliga* v. *The Inter Ocean Newspaper Company* (meaning this case) on writ of error to the highest court to which said case shall be carried shall be adverse to plaintiff's right of

action therein, the above entitled cause of *Isaac H. Caliga* v. *The Tribune Company* shall be dismissed at plaintiff's cost."

* * * * * * * *

The plaintiff in error, Isaac H. Caliga, filed a declaration in an action of debt to recover the money penalty of $10 per sheet under Section 4965 of the Revised Statutes for alleged infringement of his copyrighted painting.

The declaration contains no allegation that any plates or copy or copies of the infringing picture was or were ever "found in defendant's possession" but merely alleges that defendant "did print and publish in the aforesaid newspaper copies of said painting and did knowingly sell great numbers of said newspaper, to-wit: upwards of 1,000 copies thereof, each copy of which newspaper contained an infringing print or reproduction of said copyrighted painting whereby" he claims recovery of the sum of $10,000, "for which sum defendant is indebted to the plaintiff."

The case went to hearing on this declaration and a plea of *nil debet*.

Plaintiff in error finished the painting in question in the fall of 1901, and October 7th, 1901, secured a copyright upon it with the following description:

> "Maidenhood; a young girl seated beside a window; an angel stands behind her."

This is the *first* copyright of the painting.

November 1st, 1901, a copyright was secured in the name of Curtis & Cameron upon a *photograph* of the painting and under the title "Guardian

Angel" suggested by Caliga, under an agreement whereby the former were to sell the photographs upon a royalty to Caliga.

Thereafter a *second* copyright on the *same painting* was secured by Caliga November 7th, 1901, and is the copyright upon which this suit is based.

The painting covered by the second or November copyright is the same painting covered by the first or October copyright, but the title is different and the description is amplified in the November copyright as follows:

> "The Guardian Angel; the picture of a young girl sitting, hair arranged smoothly over the shoulders, hair parted in the middle. Her Guardian Angel stands behind her, one hand resting upon her left shoulder and the other upon her right arm."

The main divide in the court below was upon the question whether the second or November copyright is void in view of the first or October copyright of the same painting. The trial court directed a verdict of not guilty upon the ground that no valid copyright appeared under the registration of November 7th, 1901, in view of Caliga's prior registration of October 7th, 1901. Miscellaneous points were assigned as error in the Court of Appeals but the court rested its affirmance of the judgment of the trial court upon the ground that but a single valid copyright can be obtained upon the same subject matter and that therefore Caliga's November or second copyright is void.

The assignment of errors (Rec., pages 59-61) in this court raises the various points presented below.

BRIEF.

POINT I.

PLAINTIFF'S RIGHT AND REMEDY ARE WHOLLY STATUTORY AND SUBJECT TO STRICT CONSTRUCTION.

(a) Copyright in the United States is the statutory monopoly to multiply copies of a copyrighted work for the benefit of the owner, and the means for securing a copyright as well as any right of action thereupon are only those created under acts of Congress.

Wheaton v. *Peters*, 8 Peters, 591.

Perris v. *Hexamer*, 99 U. S., 675.

Thompson v. *Hubbard*, 131 U. S., 123.

Bobbs-Merrill Co. v. *Straus*, 210 U. S., 339.

Globe Newspaper Co. v. *Walker*, 210 U. S., 356.

White-Smith Co. v. *Apollo Co.*, 209 U. S., 1.

(b) Strict construction and proof are required on all points in an action under Revised Statutes, Section 4965, to enforce the forfeiture and recover the money penalty thereby provided for infringement of plaintiff's copyright.

Bolles v. *Outing Company*, 175 U. S., 262.

Banks v. *Manchester*, 128 U. S., 244.

Werckmeister v. *American Tobacco Co.*, 207 U. S., 375.

Thompson v. *Hubbard*, 131 U. S., 123.

Point II.

PLAINTIFF IN ERROR HAS MISTAKEN HIS REMEDY.

(a) The declaration states an action of debt to recover a *money* penalty under Rev. Stat., Sec. 4965; it contains no allegation that any plate or copy or copies of the infringing picture was or were ever found in defendant's possession.

(b) Section 4965 contemplates only a single action in the nature of replevin for the forfeiture of plates and copies infringing a copyrighted painting and the money penalty for the copies found in defendant's possession or sold by him.

(c) Plaintiff cannot maintain this separate action to recover the money penalty, and cannot recover it in an action for debt.

Werckmeister v. *American Tobacco Co.*, 207 U. S., 375.

Bolles v. *Outing Co.*, 175 U. S., 262.

Backus v. *Gould*, 7 How., 798.

Thornton v. *Schrieber*, 124 U. S., 612.

Falk v. *Curtis*, 107 Fed. Rep., 126.

Thompson v. *Hubbard*, 131 U. S., 123.

Point III.

PLAINTIFF'S ACTION IS PREMATURE.

(a) The remedy for forfeiture under Section 4965 is appropriate only where the property can be seized upon process; and here when it can be so seized in defendant's hands.

Bolles v. *Outing Co.*, 77 Fed. Rep., 966.

Werckmeister v. *American Tobacco Co.*, 207 U. S., at p. 383.

(b) "Before any penalty can be recovered it is necessary that copies be actually found in defendant's possession."

Werckmeister v. *American Tobacco Co.*, 207 U. S., at p. 383.

(c) In the present case the declaration contains no allegation and there is no proof that any plate or copy or copies of the infringing picture was or were ever "found" in defendant's possession, and so there can be no recovery in this case of the statutory money penalty.

Werckmeister v. *American Tobacco Co.*, 207 U. S., 375.

Bolles v. *Outing Co.*, 175 U. S., 262.

Backus v. *Gould*, 7 How., 798.

Thornton v. *Schreiber*, 124 U. S., 612.

Falk v. *Curtis*, 107 Fed. Rep., 126.

Point IV.

THE COPYRIGHT SUED UPON IS VOID.

(a) But a single valid copyright can be obtained upon the same painting; Caliga's second copyright, dated November 7, 1901, upon which this suit is based, is void in view of his first copyright of October 7, 1901, on the same painting.

Rev. Stat., Sections 4952 and 4956.

Mifflin v. *Dutton*, 112 Fed. Rep., 1004; affirmed, 190 U. S., 265.

(b) Section 4952 creates the right of copyright; Section 4953 provides a statutory term of 28 years for which the right shall be granted; and Section 4954 provides that "the *same* exclusive right" may

be "*continued* for the further term of 14 years" upon complying with certain conditions; there is no provision for re-creating, re-registering, re-issuing or otherwise affecting "the *same* exclusive right" or otherwise extending its term.

(c) Subsequent copyrights are valid only when granted for additions to, emendations of, or improvements in the originally copyrighted work.

Lawrence v. *Dana*, 15 Fed. Cases, at page 52.

Drone on Copyright, page 146.

Point V.

THE PAINTING WAS PUBLISHED BEFORE THE NOVEMBER COPYRIGHT WAS REGISTERED.

(a) The October copyright was a publication of the painting so far as the subsequent November copyright is concerned.

Merrill v. *Tice*, 104 U. S., 561.

Downton v. *Yaeger*, 108 U. S., 471.

Jewelers Agency v. *Jewelers Publ. Co.*, 155 N. Y., 241.

(b) The evidence fails to show that there was no publication by Curtis & Cameron's sales of their authorized photographs prior to November 7th, 1901.

Rev. Stat., Sec. 4956.

Werckmeister v. *American Tobacco Co.*, 207 U. S., 375.

(c) The evidence fails to show that the copies sold by Curtis & Cameron were marked in the statutory manner.

Rev. Stat., Sec. 4962.

Werckmeister v. *American Tobacco Co.*, 207 U. S., 375.

Mifflin v. *Dutton*, 190 U. S., 265.

Point VI.

The Circuit Court of the United States for the Northern District of Illinois had no jurisdiction over this suit for penalties and forfeiture under Section 4965 of the Revised Statutes, and the court was right in directing a verdict for defendant.

Rev. Stat., Sec. 563.

Lees v. *U. S.*, 150 U. S., 479.

U. S. v. *Mooney*, 116 U. S., 104.

ARGUMENT.

Point I.

PLAINTIFF'S RIGHT AND REMEDY ARE WHOLLY STATUTORY AND SUBJECT TO STRICT CONSTRUCTION.

(a) Copyright in the United States is the statutory monopoly to multiply copies of a copyrighted work for the benefit of the owner, and the means for securing a copyright as well as any right of action thereupon are only those created under acts of Congress.

Copyright is strictly statutory in the United States. If a common law right ever existed it was taken away by the statute of Anne, and that statute and those amendatory of it are now in England the only source of an author's right. There never existed any common law right of *copyright* in the United States; copyright in this country is the creature of statute pure and simple. This rule stated in *Wheaton* v. *Peters* (8 Pet., 591, at page 663, and 11 U. S., at page 234) is followed in all subsequent cases as appears from the authorities above cited.

The common law right of an author or artist was the right of first publication; but this was not the right of copyright; copyright is the exclusive right to multiply copies after publication. This distinction is stated in *Bobbs-Merrill* v. *Straus*, 210 U. S., at pp. 346-7, and in *Drone on Copyright*, at page 100, there cited and approved. When this common law right is asserted in this country we must look to the law of the state in which the controversy originated, not to the federal law, because there is no

common law of the United States. (*Wheaton* v. *Peters*, 8 Peters, at page 658; 11 U. S., at page 229.)

That an author has at common law property in his manuscript or painting, and may obtain redress in the proper forum against any one who deprives him of it, or by improperly obtaining a copy endeavors to realize a profit by its publication, is established doctrine, but this is a very different right from that which asserts a perpetual and exclusive property in the future publication of the work, after the author shall have published it to the world. (*Wheaton* v. *Peters*, 8 Peters, at page 657; 11 U. S., at page 228; *Bobbs-Merrill Co.* v. *Straus*, 210 U. S., at page 346.)

The common law rights of authors and painters run only to publication; thereafter their sole protection is under the copyright statute, and all their common law rights are superseded by the copyright statute after copyright. The right of an author or painter in the United States to multiply copies of his works after publication is the creation of a *new* right by Federal statute under constitutional authority and *not a continuation of a common law right* (*Globe Newspaper Company* v. *Walker*, 210 U. S., at page 362, following *Wheaton* v. *Peters*), and "the protection given to copyrights in this country is wholly statutory." (*White* v. *Apollo Co.*, 209 U. S., at page 15.)

It is established that Congress in passing the copyright statutes did not legislate in reference to the existing common law right of first publication and did not merely continue such right, but created the new right of multiplying copies after publication (*Wheaton* v. *Peters*, 8 Peters, at pages 661-2; 11

U. S., at page 232), "its main purpose (being) to secure the right of multiplying copies of the work, a right which is the special creation of the statute." (*Bobbs-Merrill Case*, 210 U. S., at page 351.)

This rule has prevailed of course in the circuit where this case was tried (*Boucicault* v. *Wood*, Fed. Case No. 1693, 2 Biss., 34, Drummond, Judge.)

* * * * * * * * *

(b) Strict construction and proof are required on all points in an action under Revised Statutes, Section 4965, to enforce the forfeiture and recover the money penalty thereby provided for infringement of plaintiff's copyright.

Existing by virtue of statute only, the limitations of copyright are those which the statute fixes, or, more accurately speaking, its extent is only that which the statute gives. (*Ewer* v. *Coxe*, Fed. Case No. 4,584, 4 Wash. C. C., 487; *Holmes* v. *Hurst*, 174 U. S., 82; *Banks* v. *Manchester, supra; Werckmeister* v. *American Tobacco Co., supra.*)

The statutes creating and protecting copyright must be strictly construed in all respects, and this rule of interpretation applies not only to the validity of plaintiff's copyright but also to his remedies thereunder, for "the right of action, as well as the copyright itself, is wholly statutory, and the means of securing any right of action in plaintiff are only those prescribed by Congress." (*Thompson* v. *Hubbard*, 131 U. S., at page 151.)

In a similar action based upon this Section 4965 of the Revised Statutes this court said:

> "The statute, then, being penal, must be construed with such strictness as to carefully safeguard the rights of the defendant and at the same time preserve the obvious intention of the legislature. If the language be plain, it will be construed as it reads, and the words of the statute given their full meaning; if ambiguous, the court will lean more strongly in favor of the defendant than it would if the statute were remedial. In both cases it will endeavor to effect substantial justice." (*Bolles v. Outing Co.*, 175 U. S., at page 265.)

In these cases there is no question of public policy but only strict statutory rights in quasi-criminal actions.

Plaintiff's contentions below were that copyright in the United States is not primarily a government grant but exists under the common law; that at common law the right of an author or painter in his work was not lost by publication but continued after publication; that compliance with the copyright act does not destroy the owner's common law copyright, and that in the absence of publication, the public does not acquire any right by reason of the compliance with the copyright law; that a copyright is not *per se* a government grant, but is a right of the author in the property created by him; that his rights are not created by the grant of copyright, but from the fact of authorship; that the procuring of the copyright serves merely to continue after publication the author's common law claim; and that the copyright law should be liberally and helpfully construed in favor of plaintiff even when as in this case he seeks a forfeiture and penalty.

It is sufficient to point out that these contentions

arose, probably, by reason of counsel's confusing the real meaning of the term copyright, *i. e.*, the right of multiplication of copies, with the common law right of first publication.

Whatever predilections counsel may have had in favor of these contentions must be dissipated by the decisions of this court to which we have heretofore referred.

From these considerations it is clear that if the right of plaintiff can be sustained it must be sustained under the acts of Congress and under these acts strictly construed. Such probably was the opinion of counsel who framed the declaration as plaintiff's right of recovery is asserted under the statutes and no reference of any kind is made to it as existing at common law. The claim then of the plaintiff must be examined in reference to the statutes under which it is granted and asserted; however inadequate the statutory remedies may be, the courts cannot enlarge them. (*Globe Newspaper Company* v. *Walker, supra.*)

Point II.

PLAINTIFF IN ERROR HAS MISTAKEN HIS REMEDY.

(a) The declaration states an action of debt to recover a *money* penalty under Rev. Stat., Sec. 4965; it contains no allegation that any plate or copy or copies of the infringing picture was or were ever found in defendant's possession.

The plaintiff in error brought an action of debt to recover the money penalty under Section 4965 of the Revised Statutes for alleged infringement of his copyrighted painting. The declaration contains

no allegation and there is no proof that any copy or copies of the infringing picture was or were ever found in defendant's possession, but merely alleges that defendant "did print and publish in the aforesaid newspaper copies of said painting and did knowingly sell great numbers of said newspaper, to-wit, upwards of 1,000 copies thereof, each copy of which newspaper contained an infringing print or reproduction of said copyrighted painting whereby" he claims recovery of the sum of $10,000 "for which sum the defendant is indebted to the plaintiff."

The case went to hearing on this declaration and a plea of *nil debet.*

Plaintiff therefore seeks to recover the money penalty in an action separate from an action for forfeiture of plates and copies, and also he seeks to recover the money penalty in an action of debt. But—

* * * * * * * * *

(b) Section 4965 contemplates only a single action in the nature of replevin for the forfeiture of plates and copies infringing a copyrighted painting and the money penalty for the copies found in defendant's possession or sold by him.

It is settled that Section 4965 contemplates a *single* action for the recovery of plates and copies infringing a copyrighted painting, and for the money penalty for the copies found or sold (*Werckmeister* v. *American Tobacco Co., supra*), and that this action is *in the nature of replevin* for the recovery of the plates and copies and a penalty for copies found or sold (same case, following *Bolles* v. *Outing Co., supra*).

That the rule of *Thompson* v. *Hubbard* (131 U.

S., at page 151) that the right of action as well as the copyright is only such as is prescribed by the statutes, prevails in the present case under Section 4965 is clear from the latest decisions of this court.

In *Globe Newspaper Co.* v. *Walker* (210 U. S., at page 365) this court in passing upon this section said:

> "And we think an inspection of the copyright statute indicates that the purpose of Congress was not only to create the rights granted in the statute, but also to create the specific remedies by which alone such rights may be enforced. The general rule applicable in such cases was stated in *Pollard* v. *Bailey*, 20 Wall., 520:
>
> "'A general liability created by statute, without a remedy, may be enforced by an appropriate common law action, but where the provision for the liability is coupled with the provision for a special remedy that remedy, and that alone, must be employed.'"

In the *Werckmeister-American Tobacco Co.* case, *supra*, the action was brought to recover under Section 4965 the penalty of $10 each for a number of sheets of an infringing publication claimed to have been previously found in defendant's possession and seized under two writs of replevin described in that suit. This court said (page 383):

> "There is nothing in this section which seems to contemplate the method of procedure pursued in this case, namely, a separate action for the money penalty, upon the theory that it arose only in case of actual finding and judgment of condemnation, but the statute contemplates the bringing of the offender into court *in one suit*, in which the plates and sheets shall be seized and forfeited and the penalty recovered."

This court then held that as the trial court was without power to render the second judgment in the separate action for the money penalty, it properly directed the verdict for the defendant.

This *Werckmeister* case is strictly in point because it explicitly holds that this *single* action in the nature of replevin is the only proper action in a case in which the money penalty of $10 per copy is claimed for infringing a *painting;* this court clearly stated (pages 380 and 383) that

> "While the statute provides for the forfeiture of the plates and sheets and for the sum of $10 in case of a painting for every copy *found* in the offending person's possession or sold by him, it is silent as to the kind of action to be brought, and we are left to discover the meaning of the act in this respect from a consideration of the language used, read in the light of the objects and purposes to be effected * * * we think the indication in *Bolles* v. *Outing Co.*, that a single action in the nature of replevin for the recovery of plates and copies and a penalty for copies found is correct (page 383)."

The same objects and purposes are to be effected in the case of a painting as a book, i. e., forfeiture of plates and sheets and a money penalty.

Clearly then the same action must be pursued in the same way in the case of a painting copyright as in the case of a book copyright such as the magazine in the *Bolles-Outing Co.* case, and the only difference is in the amount per sheet recoverable, i. e., $10 per sheet in the painting copyright and $1 in the book copyright. This difference was doubtless provided because a painting may have relatively greater value than a book by reason of some peculiar ar-

tistic merit which would lead the owner to wish to preserve it unique, and the relative ease of duplicating a book would make Congress reluctant to impose such a high penalty on the thousands of pages that would be printed. Whatever reason may attach here, the fact remains that the *procedure* provided in the two instances is the same, for if the Congress had intended to provide any other or different action or procedure in the case of a painting it would have said so. The fact that Section 4965 is not more specific as to the nature and character of the remedy given (*Werckmeister* case, at page 384), is no reason for making it less specific and more obscure by attempting a different remedy for some one of its several classes of cases. And we venture the prediction that this court will not be keen to afford a special remedy to a plaintiff who failed to take advantage of the specific remedy taught by its previous decision.

As the statute affords plaintiff a right of action in the nature of replevin, his "means of securing any right of action are only those (so) prescribed by Congress." (*Thompson* v. *Hubbard*, 131 U. S., at page 151.)

* * * * * * * * *

(c) Plaintiff cannot maintain this separate action to recover the money penalty, and cannot recover it in an action for debt.

From these several considerations it follows that this plaintiff's action for debt is for a mere money recovery, there is no allegation that any copies were found in defendant's possession, this is not a single

action in the nature of replevin for recovery of plates and copies and a penalty for copies found.

Under these circumstances the trial court was without power to render a judgment for the money penalty either in this form of action or in a separate action, and so it properly directed the verdict for defendant.

The decision of this court in this *Werckmeister* case is later than (Dec. 16, 1907) and overrules the *dicta* in the earlier case decided by the Circuit Court of Appeals for the Second Circuit April 4, 1906 (146 Fed. Rep., 377), where it was stated *obiter* that it was sufficient for plaintiff to allege a sale of copies and that he need not show that any were "found" in defendant's possession.

The decision of this court in the *Werckmeister* case is conclusive that in an action on a copyrighted painting the defendant can be brought into court only in one suit in the nature of replevin in which the plates and copies shall be seized and forfeited and the money penalty recovered.

This plaintiff has not complied with this statutory requirement; he seeks recovery of the money penalty only, and by an action unknown to this statute. His action for debt cannot be maintained and the court below was right in directing a verdict for defendant.

* * * * * * * * *

Hence, the Court of Appeals did not err in any of the matters covered by general assignments of error numbered I, II and III.

It did not err as to the matters covered by assignments of error numbered VII and VIII refer-

ring to Instructions 1 and 2 (Rec., p. 35), because even if plaintiff proved all the matters alleged in his declaration the court had no statutory authority to render judgment in his favor in this action of debt; it could only do so in an action in the nature of replevin.

It did not err as to the matter covered by assignment of error numbered IX, referring to Instruction 6 (Rec., p. 36), because even if plaintiff secured "a valid copyright," etc., and such copyright "protects the plaintiff against reproduction," etc., and such reproduction "constitutes an infringement," all these facts give him no right to recover under Section 4965. They might possibly afford injunctional relief by bill in equity, but they state no case under Section 4965; and, if they did, an action of debt is not the proper remedy for the infringement.

It did not err as to the matters covered by assignment of error numbered X, referring to Instruction 10 (Rec., p. 36), because not even the owner of a valid copyright may recover the penalties of Section 4965 in an action of debt.

It did not err as to the matters covered by assignments of error numbered XI and XII, referring to Instructions 13 and 15 (Rec., pages 36-7), because even if plaintiff proved all the matters alleged in his declaration and even if his November copyright were valid, he could not recover the statutory penalty in this action for debt. To obtain a verdict plaintiff must have done more than his instructions recite, *i. e.*, he must have proceeded in an action in the nature of replevin. It was not error that the jury did not determine whether plaintiff "did all these

things," because doing them afforded no ground for the statutory recovery by action for debt.

It did not err as to the matter covered by assignment of error numbered XIII, because it is not for the jury to decide what remedy is proper in this cause, and the question what remedy plaintiff pursues is apparent on the face of his declaration and is not a matter for the jury in any aspect of the case.

Point III.

Plaintiff's action is premature.

The remedy for forfeiture under Section 4965 is appropriate only where the property can be seized upon process; and here when it can be so seized in defendant's hands.

> "Before any penalty can be recovered it is necessary that copies be actually found in defendant's possession." (*Werckmeister* case, 207 U. S., at page 383.)

In the present case the declaration contains no allegation and there is no proof that any plate or copy or copies of the infringing picture was or were ever "found" in defendant's possession, and so there can be no recovery in this case of the statutory money penalty.

Section 4965 provides that if any person shall, without such consent as is recited therein, engrave, copy, etc., any map or other article specifically enumerated by said section, or

> "shall *sell or expose for sale* any copy of such map or other article, as aforesaid, he shall forfeit to the proprietor *all the plates* on which the same shall be copied, and *every sheet* thereof,

> either copied or printed, and shall further forfeit *one dollar* for every sheet of the same *found in his possession*, either printing, printed, copied, published, imported, *or exposed for sale;* and in case of a painting, statue, or statuary, he shall forfeit *ten dollars* for *every copy* of the same *in his possession*, or by him *sold or exposed for sale.*"

The courts have construed the words "found in his possession" and "or exposed for sale" as they first appear in this statute, and the interpretation given them must also apply to the similar words "(found) in his possession or by him sold or exposed for sale" used later in connection with a painting, the word "found" being placed in this context by this court in the *Werckmeister* case.

In *Bolles* v. *Outing Co.*, the action was for recovery of the money penalty under Section 4965 for infringing a copyrighted photograph, and complainant testified to purchasing one copy of the Outing magazine containing a copy of the photograph, and offered to prove the number of copies of the infringement found in defendant's possession. This evidence was excluded and error assigned upon such ruling.

This court said (pages 266-7) the *Bolles* case was clearly controlled by the earlier case of *Backus* v. *Gould* where plaintiff insisted (as Bolles did and as Caliga does up to the statutory limit) that he was entitled to recover for every sheet that had been published or procured to be published by defendant whether the same were proved to have been "found" in defendant's possession or not, and that the rule was laid down correctly in *Backus* v. *Gould* that recovery was limited to sheets "found" in the posses-

sion of the defendant and that an instruction that he was liable for every sheet which he had published or procured to be published was erroneous.

In other words, and placing the broadest permissible construction on these decisions, the recovery of plates, sheets and money being possible only in one suit, there can be no money recovered until plates and sheets are actually found in defendant's possession for the purpose of forfeiture and condemnation (*Falk* v. *Curtis*, 107 Fed. Rep., 126), or as was later said in the *Werckmeister* case (page 383) "*before* the penalty can be recovered it is necessary that the sheets be *actually found* in possession of defendant." There can be no forfeiture of sheets, until some are so found in his possession.

> "The remedy by condemnation and forfeiture is only appropriate in a case where the property can be seized upon process; and where, as here, the forfeiture declared is against the property of the 'offender,' it is only appropriate when it can be seized *in his hands*" (Statement of Court of Appeals in *Bolles* v. *Outing Co.*, 77 Fed. Rep., page 966, quoted and approved by this court in the *Werckmeister* case at pages 382-3.)

Clearly then the remedy must strictly comply with the statute which gives no right of action to recover the money penalty before sheets are found in defendant's possession but limits the remedy to a *single* action for forfeiture of plates and copies actually *found* in defendant's possession and the money penalty. The pecuniary penalty does not accrue until infringing copies have been actually "found" in defendant's possession and seized.

In construing the words "found in his posses-

sion," this court has given them very clear and yet restricted meaning, deeming them the sole means and guide for determining when the penalty may attach: and this, too, notwithstanding the fact that this section provides a penalty to be recovered against any person who "shall sell or expose for sale" or who has "exposed for sale" any copy of the copyrighted article. The vital clause of this section is "found in his possession"; and it really controls the grounds of the action and also the determination of it, because no right of action arises and no penalty attaches until copies are "found" in the actual possession of the defendant for the purpose of forfeiture. This harmonizes with the new copyright law effective July 1, 1909; see Section 25.

These cases in construing the first part of this section of the Revised Statutes make no distinction between the alternative clauses "found in his possession" and "exposed for sale." In other words, this court has held that there can be no penalty for copies "exposed for sale," until they have been "found in his possession."

The same interpretation was given by this court in the *Werckmeister* case to that part of the statute referring to paintings, the court plainly stated that the

> "statute provides for the forfeiture of the plates and sheets and for the sum of $10.00 in case of a painting for every copy found in the offending person's possession or sold by him." (Page 380.) * * * "Before any penalty can be recovered it is necessary that the sheets be actually found in defendant's possession." (Page 383.) * * * "When the offender is brought into court, under this section, he shall

> forfeit the plates * * * and every sheet * * * and in case of a painting $10.00 for every copy in his possession or by him sold or exposed for sale." (Page 383.)

Therefore, even if plaintiff could *in a proper suit* recover the money penalty for copies "by him (defendant) sold or exposed for sale," in addition to those copies "found" in his possession for the purpose of forfeiture and condemnation, no right of action for recovery of the money penalty accrues until the plates and some sheets have been so "found"; the recovery of the money penalty cannot take place until the plates and some sheets are so actually "found," and must be in the same action with the judgment of forfeiture or condemnation of the plates and sheets.

Whatever may be the difference as to the *extent* of the money recovery, the entire section must be taken together and all of its parts considered as *in pari materia* so far as the right of action is concerned or the procedure by which the recovery is to be made. Therefore, the part of the section relating to paintings must be considered as to the right of action in precisely the same way as the preceding part of the section. From this it follows that the alternative clauses in the second part of the section, to-wit: "in his possession or by him sold or exposed for sale," are to be construed on this point in precisely the same manner as the preceding alternative clauses, "found in his possession or exposed for sale." This being true, the money penalty can not be recovered before the plates and sheets are actually "found in his possession" by proper proceedings, and this, of course, must be by replevin.

In the present case no plates or copies have been found; the declaration contains no allegation that any copy or copies were ever "found" in defendant's possession; the proof "traces" a thousand copies at one time, probably the day of publication of its newspaper, in its possession, but this is of no consequence under the *Bolles* decision.

Therefore, plaintiff's action to recover the money penalty in this case is premature and the court was right in directing a verdict for defendant; for the same reasons set forth at length in the last corresponding paragraphs under the preceding point, the assignments of error numbered I, II, III, IX, X, XII and XIII state no grounds for reversal; in addition, there could be no verdict for plaintiff for the money penalty before sheets were found in defendant's possession, and hence assignments of error VII, VIII, and XI are of no avail.

Point IV.

THE COPYRIGHT SUED UPON IS VOID.

(a) But a single valid copyright can be obtained upon the same painting; Caliga's second copyright, dated November 7, 1901, upon which this suit is based, is void in view of his first copyright of October 7, 1901, on the same painting.

After creating the right of copyright by Section 4952 of the Revised Statutes, the Congress then proceeded to say (Section 4956) that "no person shall be entitled to *a* copyright unless he shall, etc., * * * deliver * * * or deposit in the mail * * * a description of the painting, etc., * * * for which he desires *a* copyright; nor unless he shall also * * *

deliver * * * or deposit in the mail * * * in the case of a painting, etc., * * * a photograph of the same."

This section of the statute provides for "*a* copyright," *i. e.*, one copyright.

While the general analogy between patents and copyrights is remote, it exists in some particulars (*Holmes* v. *Hurst*, 174 U. S., at page 89), and here the singleness of protection evidenced by the patent statute is repeated in the copyright statute. The patent statute (Section 4886) provides that any person who has invented "a new and useful machine, etc., * * * may obtain *a* patent therefor."

As repeatedly held by this court, *a* patent means *one* patent, and no rule of patent law is better settled than that a second patent for the same invention as a prior patent is void *although the terms of the claims may differ.* (*Miller* v. *Eagle Manufacturing Co.*, 151 U. S., at page 198; Robinson on Patents, Vol. II, Section 460.)

The right of an author or painter to protection for his work does not materially differ in this respect from that of an individual who has invented a useful and valuable machine; in the production of the latter, the inventor's mind has been as intensely engaged as long, and, perhaps, as usefully to the public, as any distinguished painter in the composition of his painting.

The result of their labors may be equally beneficial to society, and in their respective spheres they may be alike distinguished for mental vigor. The common law gives no perpetual right to the author, and withholds it from the inventor; yet it has never

been pretended that the latter could hold, by the common law, any property in his invention after he shall have sold it publicly. The statute law gives no perpetual right to the author and withholds it from the inventor; yet it is not pretended that the latter can hold the patent or monopoly on his invention for more than the statutory term.

The statutory provisions for *a* patent and *a* copyright couple these monopolies in the same limitation of single protection; if the number of patents or copyrights on the same tangible thing were not limited, the public would never come into the unrestricted enjoyment of the work and there would be no mutuality in the contract which the constitution evidently contemplates between the Government on the one hand and the inventor or author on the other.

In *Mifflin* v. *Dutton*, 112 Fed. Rep., at page 1005, the Circuit Court of Appeals for the First Circuit, speaking by Judge Putnam, said:

> "The presumption, therefore, is that it was a copyright of so much of the Atlantic Monthly as the publishers were entitled to copyright in their own behalf. They could not then copyright 'The Minister's Wooing,' because it had already been copyrighted, and there cannot be two successive copyrights of the same publication. To permit this would render possible an extension of the statutory period through which a copyright runs, which, of course, the law will not allow."

This case was affirmed by this court in 190 U. S., page 265.

Furthermore, in our case there was no question of fact of the identity of the two copyrights to submit

to the jury. Caliga admitted that the two copyrights were upon or for the same painting; it therefore was merely a matter of law for the court to state the legal effect of their identity. Of course had there been any question that the two copyrights were not for the same "tangible thing", it might have been submitted to the jury to determine; just as in case of an alleged anticipation of a patent by an earlier patent or publication the identity of the subject matter at a trial at law would go to the jury, but where the subject matter is admittedly the same and both cover the same "tangible thing," no such question of fact for the jury arises.

* * * * * * * * *

(b) Section 4952 creates the right of copyright; Section 4953 provides a statutory term of 28 years for which the right shall be granted; and Section 4954 provides that "the *same* exclusive right" may be "*continued* for the further term of 14 years" upon complying with certain conditions; there is no provision for re-creating, re-registering, re-issuing or otherwise affecting "the *same* exclusive right" or otherwise extending its term.

The "*same* exclusive right" here means the right to multiply copies of the *same* book or painting; otherwise it is some other right. The statutes indicate the purpose of Congress to protect the owner of a copyright in the sole right of multiplying and vending the copyrighted article for a *limited* term (*Bobbs-Merrill* v. *Straus*, 210 U. S., at pages 350-1), in consonance with the limitation of Art. I, paragraph 8 of the Federal Constitution. The sole right to multiply and vend the same work for a

limited term is the "exclusive right" of Sections 4953 and 4954, and to add a perpetual control or monopoly would give a new right not included in the terms of the statute and prohibited by the Constitution.

There is no other provision in the copyright law for enlarging this statutory term; Section 4954 provides the only way for continuing or extending the term, and anything else done by a copyright owner to extend the term of "the *same* exclusive right," i. e., the right to multiply copies of the *same* work, would be outside these statutes and void. For this reason a second copyright, i. e., a second right to multiply copies of the *same work,* is void.

The copyright of Caliga dated November 7th, 1901, after his copyright on the same painting dated October 7th, 1901, is therefore not a valid copyright. If he could apply for a second copyright within a month after the first, he could so apply within a year or 10 years or 20 years and thereby extend his copyright beyond the statutory term and beyond the term of continuance provided in Section 4954 and for an unlimited term which is clearly unconstitutional. Caliga's "exclusive right," i. e., the right to multiply copies of his painting, under his October copyright could be extended or continued only as provided in Section 4954; his rights in that respect are wholly statutory, and his second or November copyright on the "*same* exclusive right" finds no sanction in law.

The constitutional limitation (Article 1, Section 8) of protection to inventors and authors only for "limited times" couples them in the same general prohibition against indefinite prolongation of their

rights by successive patents or registrations, and makes certain general principles and rules governing the terms and conditions of patent grants or rights analogous in this respect to copyrights.

The analogy is apt with the same situation in regard to two patents for the same invention. The statutory term for a patent is 17 years, and this court has held repeatedly (*Miller* v. *Eagle, supra,* and cases there cited) that this period cannot be extended by the grant of a second patent for the same invention. The grant of the original patent, and similarly the grant of Caliga's original October copyright, exhausted the statutory right on the "tangible thing," i. e., the painting, which alone is protected (*White-Apollo* case, 209 U. S., at page 17), and it cannot be extended by the grant of a second patent or a second copyright on the same thing.

Nor can it be said that in analogy to the right to reissue a patent, an owner of a copyright may reissue his copyright. The right to reissue a patent is statutory; the original patent is surrendered, the reissued patent is limited to endure only "for the unexpired part of the term of the original patent," no new matter may be introduced, and the reissued patent must be for the same invention as the original. (Rev. Stat., Sec. 4916.)

There are no such or even analogous provisions in the copyright law; Caliga cannot do indirectly what he is not directly authorized to do by statute. But if his position in this case be correct he may not only do something not authorized by statute, *i. e.,* obtain a second right to multiply copies of the *same* work, but he may do this without surrendering his

original copyright and without limiting his second to the unexpired part of the term of his first copyright. Such contentions find no support in the law or reported cases.

* * * * * * * * *

(c) Subsequent copyrights are valid only when granted for additions to, emendations of, or improvements in the originally copyrighted work.

> "Copyrights of the editions of a work, other than the original edition, are granted for additions to, emendations of, or improvements in the work, and every copyright should bear date of the day when it was secured." (*Lawrence* v. *Dana*, 15 Fed. Cases, at page 52, by Mr. Justice Clifford.)

In Drone on Copyrights it is said, page 146:

> "Whether an independent copyright will vest in any subsequent edition will depend on the amount of new matter which it contains, or the extent and character of the revision which has been made in the preceding edition. A simple reprint of the original, or other previous edition, will be entitled to no other protection than is given to the preceding edition. In such case, there is nothing new on which to found a valid claim for copyright."

In *Lawrence* v. *Dana*, 15 Fed. Cases, at page 52, Mr. Justice Clifford said:

> "Subsequent editions without alterations or additions should have the same entry, because they find their only protection in the original copyright."

This rule has been substantially written into the law by Section 6 of the new Copyright Act effective July 1, 1909.

In the present case the November entry or copyright was not for anything analogous to a subsequent edition; no changes were made in Caliga's painting between the dates of the October and November copyrights; his changes were not made until 1903. (Rec., p. 29.) Whether the changes in 1903 were sufficient to remove the picture from the protection of the November, 1901, copyright and so relieve defendant from its infringement by copying the altered picture is a serious question, but the fact remains that his October and November copyrights were confessedly upon or for the same painting; his painting is entitled to no other protection than that given to it by his October copyright; there was nothing upon which to found a valid claim for copyright in November. Caliga can find protection only in his original or October copyright.

The facts that he changed the title and amplified the description or notice filed with the Librarian of Congress for his November copyright are not material. In the *White-Apollo Co.* case (209 U. S., at page 17) this court said (italics ours):

> "The statute has not provided for the protection of the intellectual conception apart from the thing produced, however meritorious such conception may be, but has provided for the making and filing of a *tangible thing*, against the publication and duplication *of which* it is the purpose of the statute to protect the composer."

The "tangible thing" in our case is the painting, and this "tangible thing" was not changed between the October and November registrations and remained the same whether termed "Maidenhood" or

"Guardian Angel" and whether described laconically in two lines or prolixly in more.

The object of the notice filed with the Librarian of Congress is to warn the public against the reproduction of Caliga's picture (*Mifflin* v. *Dutton*, 190 U. S., at page 264), and it is difficult to see how a person reading these notices would not understand that they were intended for the protection of the same work. On their face they would seem to be designed for the same purposes, and any person having an intellectual conception described in the terms of the November notice would be put on guard by the terms of the October notice.

An artist inspired with a theme representing an angel guarding maidenhood, upon examination of the records of copyrighted paintings would at once perceive the significance of the notice filed with Caliga's October copyright. It recites that "an angel stands behind a young girl seated at a window"; not only does this suggest the composition and scenario but it suggests the symbolic meaning of divine commission or protection. The dullest mind would appreciate the meaning, and artists are more or less imaginative; indeed, the photograph filed with the October registration left nothing to the imagination.

The first or October description was legally sufficient. The statute (Sec. 4956) merely requires "a description of the painting * * * for which he desires a copyright." Any description fulfills the requirement. The October description fulfilled it; the figures were described, their general arrangement was stated, and the symbol of protection of the innocent by angelic guardianship was suggested by

the words "angel" and "young girl" and their relative standing and sitting positions.

In this connection it is to be observed that the title "Maidenhood" contained in the first or October notice is of no effect or limitation. The statute requires "a printed copy of the *title* of the *book*, map, chart, dramatic or musical composition, engraving, cut, print, photograph or chromo, or a *description* of the *painting*, drawing, statue, etc." (Sec. 4956.) For a painting *no title* is required, only *a description;* hence the title "Maidenhood" was superfluous, the description "a young girl seated beside a window, an angel stands behind her" was all the statute required and constituted a legally sufficient description. Just as the courts have held in cases of copyrights on books that the author did not lose his copyright by reason of publishing his book with a *title* shorter than the title deposited with his entry (*Daly* v. *Webster*, 56 Fed. Rep., 483; *Patterson* v. *Ogilvie*, 119 Fed. Rep., 451), so an artist did not lose or invalidate his first copyright by reason of filing a briefer *description* than he afterwards used or by reason of a change in *title*. The statutory requirement of *description* was fulfilled in the October copyright, and there is no statutory requirement as to *title* in this case.

On this point we also call attention to the fact that the patent law differs radically from the copyright law in respect to the character of the description required; the patent statute (Sec. 4888), requires a description in "full, clear, concise and exact terms" and in case of a machine the patentee "shall explain the principle thereof," and he must "particularly point out and distinctly claim" his invention. The

differences between these patent requirements and the bald requirement in the copyright law of "a description of the painting," are in consonance with the differences in the things protected; a painting is understood from the lines, colors and poses delineated on the canvas.

Similarly as there cannot be two patents for the same invention "*although the terms of the claims may differ*" (*Miller Eagle*, 151 U. S., at page 198), there cannot be two copyrights for the same painting although the terms of the descriptions may differ. The invention and the painting are the respective "*tangible thing* against the duplication of which it is the purpose of the statute to protect" (*Apollo* case, *supra*, at page 17), and this is accomplished by the first patent and by the first copyright irrespective of differences of description, title, claims, etc., etc.

These considerations also dispose of plaintiff's contention that his original notice was defective or insufficient and called for a more complete description or a re-registration under a fuller description or a better title, or that he wished his painting to be known by the *title* Guardian Angel.

* * * * * * * * *

It is plain from these considerations that plaintiff's assignments of error numbered I, II and III are of no avail—the Court of Appeals rightly affirmed the judgment below, and the lower court was right in entering judgment for defendant and so instructing the jury.

It is plain that plaintiff's assignments of error numbered IV, V and VI afford no ground for re-

versal, as clearly plaintiff in October, 1901, "had taken all steps necessary to get a copyright" and the suit was upon the wrong one. He then did all that the statute required; he then did just what plaintiff's Instruction No. 13 (Rec., p. 36) says he afterwards did to obtain a valid copyright in November. This being so his suit was brought under the wrong copyright, and the second copyright of November 7, 1901, is a nullity, and the court was right in directing the verdict for defendant.

Similarly, assignments VII, VIII, IX, XI, XII are of no force, as no verdict could go for plaintiff on a void or invalid copyright, even if he proved all his allegations.

Assignment X, relating to Instruction 10, is clearly of no avail; for the reasons herein pointed out the November copyright was not valid.

Assignment XIII is of no force because the "tangible thing" being admittedly the same in both copyrights, no question of fact on this point arose, and there was nothing of this nature to submit to the jury.

Point V.

THE PAINTING WAS PUBLISHED BEFORE THE NOVEMBER COPYRIGHT WAS REGISTERED.

(a) The October copyright was a publication of the painting so far as the subsequent November copyright is concerned.

The office of the Librarian of Congress is a public office, and its records are open to examination by the public; one object being to afford authors and painters full opportunity to ascertain what books,

paintings, etc., are copyrighted. (*Merrill* v. *Tice*, 104 U. S., at page 561.)

This is clearly recognized in the new law effective July 1, 1909, which states (Sec. 58) that "all works deposited, etc., shall be open to public inspection and that copies may be taken."

Caliga's October copyright thus became a public record and disclosed to the public the "*tangible thing*" before the November copyright was registered. The October copyright made the painting accessible to the public and was a general publication without restriction in so far as any subsequent copyright is concerned. It was made in accordance with statutory requirement and was complete and final as to any subsequent claim on the same picture. The fact that defendant through the October copyright learned of this prior registration of this "tangible thing" exemplifies its sufficiency as a publication.

In precisely the same way as a prior publication invalidates a patent, so here this October publication became a part of the prior art with respect to a subsequent registration of the same work. It contained not only the picture but also a printed text or description of it. It was fairly intended for the public in fulfillment of Caliga's part of the contract to place on record such disclosure as would enable the public to reproduce the picture after his statutory term of copyright expired, and it placed the entire subject matter within their reach. It actually disclosed the "tangible thing" in such manner that anyone who then chooses may avail himself of the information it contains. It exhibited a "substantial representation" (*Seymour* v. *Osbourne*, 11 Wall.,

at page 555) of the November copyright, and would enable other painters to comprehend and reproduce the picture (*Cohn* v. *Corset Co.*, 93 U. S., at page 370); and applying these tests it is clearly a prior publication. (*Downton* v. *Yaeger Co.*, 108 U. S., at page 471.)

That the depositing of the statutory copy in the office of the librarian of Congress published the work is expressly held in *Jewelers' Agency* v. *Jewelers' Publishing Co.*, 155 N. Y., 241.

While depositing a copy may not in itself be such publication as would destroy the copyright to validate which the copy was deposited (*Osgood* v. *Aloe*, 69 Fed. Rep., 691), it is a very different thing to treat such deposit of a copy as a publication with respect to a subsequent copyright on the same thing.

* * * * * * * * *

(b) The evidence fails to show that there was no publication by Curtis & Cameron's sales of their authorized photographs prior to November 7th, 1901.

Curtis & Cameron were authorized by Caliga to sell photographic copies of the painting, and such copies were sold under royalty to Caliga. These photographs were completed in September, 1901, prior to the October copyright, because one of them was deposited with and as a part of that registration; some of the same photographs (Rec., p. 29) were deposited with the November registration, being made from the same negative.

Caliga admits these photographs were sold from 1901 to 1903, but does not know how many were sold.

It was incumbent upon complainant to prove his

copyright and therefore to prove *inter alia* that "on or before the day of publication, in this or any foreign country" (Sec., 4956) he took the statutory steps to obtain his copyright. There is no proof that Curtis & Cameron did not sell these copies before Nov. 7th, 1901, and in the absence of such proof Caliga could not recover in this action, it being incumbent on him to show that his November copyright preceded publication.

* * * * * * * * *

(c) The evidence fails to show that the copies sold by Curtis & Cameron were marked in the statutory manner.

Clearly, these copies sold by Curtis & Cameron were the ones which the law requires marked with the copyright notice, and in the absence of proof of such marking plaintiff cannot prevail under the rule of the *Werckmeister* case. There is no evidence in this record that the *copies* admitted to have been sold by Curtis & Cameron were properly marked. The only proof is that the *painting* was marked, which was not necessary or material (same case). In such a state of facts plaintiff has no standing in court. (Rev. Stat., Sec. 4962, and *Werckmeister* case.)

* * * * * * * * *

This point applies especially to Assignments IX, X, XI, XII.

Assignment IX, relating to Instruction 6 (Rec., page 36), affords no ground for reversal because the copyright does not protect until complainant proves that all copies are properly marked; there

was no proof that Curtis & Cameron's photographs of the painting were marked, and there was no error in refusing Instruction 6, which did not contemplate such marking as a condition precedent to recovery.

Assignment X, relating to Instruction 10, affords no ground for reversal because complainant did not prove that there was no publication by Curtis & Cameron's photographs prior to November 7, 1901, and this is a condition precedent to obtaining a valid copyright, as expressly provided in Section 4956.

Assignment XI, relating to Instruction 13, affords no ground for reversal because even if the facts stated in the instruction were true, no action can be maintained unless complainant proves that all copies were properly marked; there is no proof of this and no action is otherwise maintainable. (Section 4962.)

Similarly, Assignment XII, relating to Instruction 15, is defective because whether the facts stated in this instruction do or do not invalidate a copyright, they certainly prevent any recovery of the statutory penalties, for the reasons stated in connection with Assignment XI under Section 4962.

Also, this Instruction 15 is clearly contrary to the rule laid down by this court in *Mifflin* v. *Dutton* (190 U. S., 265), that the authorized appearance of a work without the statutory notice makes it public property and vitiates the copyright. Clearly, it was not error to refuse such instruction.

Point VI.

The Circuit Court of the United States for the Northern District of Illinois had no jurisdiction over this suit for penalties and forfeiture under Section 4965 of the Revised Statutes, and the court was right in directing a verdict for defendant.

The ninth section of the Judiciary Act of September 24, 1789, Ch. 20; 1 Stat., 76, provided as follows:

> "The District Courts shall have exclusive original cognizance * * * of all suits for penalties and forfeitures incurred under the laws of the United States."

The third clause of Section 563 of the Revised Statutes of the United States, under Title XIII—The Judiciary—Ch. 3, shows that on the 1st day of December, A. D. 1873, the District Courts had jurisdiction as follows:

> "Of all suits for penalties and forfeitures incurred under *any* law of the United States,"

and by the 9th clause of Ch. 7 of the said Title XIII—The Judiciary—on the said 1st day of December, A. D. 1873, the Circuit Courts had original jurisdiction as follows:

> "Of all suits at law or in equity arising under the patent or copyright laws of the United States."

A reference to the statutes of the United States shows that from the earliest history of the government the jurisdiction over actions for the recovery of penalties and forfeitures has been vested in the District Courts, and such jurisdiction has not been

divested, except in certain instances, unless by the Act of March 3, 1875, entitled "An act to determine the jurisdiction of the Circuit Courts of the United States," 18 Stat., Ch. 137, 470, the Circuit Courts were given a concurrent jurisdiction over such actions.

It cannot be denied that in some cases the jurisdiction over matters of penalty and forfeitures has been committed to the Circuit Courts, as, for instance, under Section 629, Cl. 5, of the Revised Statutes of the United States, such courts have jurisdiction

> "of all suits and proceedings for the enforcement of any penalties provided by laws regulating the carriage of passengers in merchant vessels,"

but jurisdiction thus committed has always been by a special act, and it does not thereby otherwise affect the fact that the District Courts have the general jurisdiction over actions for the recovery of penalties and forfeitures.

While by Section 563, cl. 3rd, of the Revised Statutes of the United States, as amended by the Act of February 28th, 1871, the word "exclusive" was omitted from the act giving jurisdiction to the District Court of suits involving the recovery of penalties and forfeitures, the language of the ninth section of the Judiciary Act of 1789, as above recited, was not otherwise materially changed, and the insertion of the word "any," thus broadening the language of the statute as it stands amended today to read "of all suits for penalties and forfeitures incurred under *any* law of the United States," leaves the jurisdiction of the District Courts over such

matters practically, if not exactly, the same as it had exclusively been for more than three-quarters of a century before the Act of 1871.

> "When a statute imposes a penalty and forfeiture, jurisdiction of an action therefor would vest in the District Court, unless it is in *express terms* placed *exclusively* elsewhere." *Lees* v. *U. S.*, 150 U. S., 479.

When Congress amended Section 629 of the Revised Statutes by the Act of March 3rd, 1875, entitled "An Act to determine the jurisdiction of the Circuit Courts of the United States," the only instance in which the Circuit Courts were invested with jurisdiction to try causes for the recovery of penalties is set forth in the fifth clause of said act under the caption, "Suits for the enforcement of penalties," and this clause specifically states that these courts shall have jurisdiction

> "of all suits and proceedings for the enforcement of any *penalties* provided by laws regulating the carriage of passengers in merchant vessels."

Here jurisdiction is committed to the Circuit Courts in express terms, but under the ninth clause of said Section 629 of the Revised Statutes no such jurisdiction involving the recovery of penalties or forfeitures is given. The said section under said clause, the caption of which is "Patent and Copyright Suits," reads:

> "of all suits at law or in equity arising under the patent or copyright laws of the United States."

Had Congress intended that the Circuit Courts should have jurisdiction of suits for the recovery of penalties and forfeitures under the patent and copyright laws, it would unquestionably have inserted such language as would have committed this jurisdiction in express terms as it did in the fifth clause, as above. And it may not be argued that the jurisdiction of the District Courts over such matters up to the time of this act of Congress was repealed by such loose language, for as Mr. Justice Brewer said in *Lees* v. *U. S.*, 479:

> "Repeals by implication are not favored, and the general grant of jurisdiction to the District Courts of suits to recover penalties and forfeitures should not in any case be transferred exclusively to the Circuit Courts by words of doubtful import."

And, furthermore, this is not a suit of a civil nature at common law; it is for the recovery of a penalty and for a forfeiture, and, though civil in form, "is unquestionably criminal in its nature." *Lees* v. *United States*, 150 U. S., 480; *Boyd* v. *United States*, 116 U. S., 616. Hence, the exclusive jurisdiction of the District Court was not divested by the Act of March 3, 1875.

In the case of *United States* v. *Mooney*, 116 U. S., 104, the action was one brought to recover penalties and forfeitures under the customs laws of the United States. The exclusive jurisdiction over such actions had always been invested in the District Court by the terms of the ninth section of the Judiciary Act of 1789, as above set forth, and an effort was made to show that said courts had been divested of such

jurisdiction by the said Act of March 3rd, 1875, by the first section of which it was enacted that

> "the Circuit Courts of the United States shall have original cognizance, concurrent with the courts of the several states, of all suits of a civil nature, at common law or in equity, where the matter in dispute exceeds, exclusive of costs, the sum or value of five hundred dollars, and arising under the Constitution or laws of the United States or in which the United States are plaintiffs or petitioners," etc.

It was argued that this section committed to the Circuit Courts a jurisdiction, concurrent with the District Courts, of all suits for the recovery of penalties and forfeitures under the customs laws, because such suits are of a civil nature at common law and the United States were plaintiffs, and as the amount in controversy was over $500 all the conditions necessary to test such jurisdiction were fulfilled. Considering the plausibility of this argument the court said, page 105, 116 U. S;

> "For more than three-quarters of a century, under the ninth section of the Act of 1789, the exclusive jurisdiction of the District Courts in suits for penalties and forfeitures under the customs laws was unquestioned. In *The Cassius*, 2 Dall., 365, decided in 1796 by the United States Circuit for the District of Pennsylvania, and in *Evans* v. *Bollen*, 4 Dall., 342, decided by this court in 1800, it was held that under the Judiciary Act of 1789 the Circuit Courts had no jurisdiction of suits for penalties and forfeitures under the laws of the United States. These decisions have never been overruled, and the law has remained unchanged, except where jurisdiction of suits for penalties and forfeitures has been given to the Circuit Courts in special cases by statute. This construction of

the ninth section of the Act of 1789 prevailed, notwithstanding the provisions of section eleven of that act, which were as follows: 'The Circuit Courts shall have original cognizance, concurrent with the courts of the several states, of all suits of a civil nature, at common law or in equity, when the matter in dispute exceeds, exclusive of costs, the sum or value of five hundred dollars; and the United States are plaintiffs or petitioners.' 1 Stat., 78. This is substantially the same, in respect of the question before us, as the first section of the Act of 1875, which is relied on to take away the exclusive jurisdiction of the District Courts. But it was never supposed that under the Act of 1789 the provisions of Sec. 11 interfered with the exclusive jurisdiction conferred on the District Courts by Sec. 9 of the same act. It was never held that the words 'all suits of a civil nature, at common law or in equity,' used in Sec. 11, included suits for penalties and forfeitures of which the District Courts had been given exclusive jurisdiction by Sec. 9. How, then, can the substantial re-enactment of Sec. 11 by the Act of March 3, 1875, with modifications immaterial, as far as the question in hand is concerned, have an effect which the original section did not? As said by the Circuit Court in its well-considered opinion in this case, 11 Fed. Rep., 476, 'the restricted meaning attached for eighty-six years to the language of the eleventh section of the Act of 1789 is presumed to attach to the same language in the Act of 1875.' It is not to be supposed that Congress, in using in the Act of 1875 the same language, so far as the present question is concerned, as that employed in the Act of 1789, intended to give it a meaning different from that put upon it by this court, and which had remained unchallenged for three-quarters of a century.

"To sustain the contention of the plaintiffs, we must hold that the purpose of Sec. 1 of the Act

of March 3, 1875, was to repeal by implication and supersede all the laws conferring jurisdiction on the Circuit Courts, and of itself to cover and regulate the whole subject. But this construction would lead to consequences which it is clear Congress did not contemplate. All the laws in force December 1, 1873, prescribing the jurisdiction of the Circuit Courts were reproduced in Rev. Stat., Sec. 629, and the jurisdiction was stated under twenty distinct heads, eighteen of which had reference to the jurisdiction in civil cases. In sixteen of these eighteen heads the jurisdiction is conferred without reference to the amount in controversy. The Act of 1875 confers jurisdiction on the Circuit Courts only in cases where the matter in dispute exceeds $500. If that act is intended to supersede previous acts conferring jurisdiction on the Circuit Courts, then those courts are left without jurisdiction in any of the cases above specified where the amount in controversy does not exceed the sum of $500, and in several classes of cases, for instance, suits arising under the patent or copyright laws, neither the Circuit nor District Court of the United States would have jurisdiction when the amount in controversy is less than $500. But by Rev. Stat., Sec. 711, par. 5, the jurisdiction of the State courts in cases arising under the patent and copyright laws is excluded. Therefore, when the matter in dispute in a case arising under these laws is less than $500, if we yield to the contention of plaintiffs, it would follow that no court whatever has jurisdiction. A construction which involves such results was clearly not contemplated by Congress."

With reference to the purpose of this act the court further says:

"The Act of 1875, it is clear, was not intended to interfere with the prior statutes conferring jurisdiction upon the Circuit or District Courts

in special cases, and over special subjects. (*Third National Bank of St. Louis* v. *Harrison*, 3 McCrary, 162.)

"Its purpose was to give to the Circuit Courts a jurisdiction which the Federal Courts did not then possess, by enlarging their jurisdiction in suits of a civil nature at common law or in equity, and not to take away from the Circuit or District Courts jurisdiction conferred by prior statutes, *or to divide the jurisdiction which had so long a time been vested exclusively in the District Courts.*"

United States v. *Mooney*, 116 U. S., 107.

In view of the construction placed upon these statutes by the Supreme Court of the United States in the able and analytical opinions by Mr. Justice Woods and Mr. Justice Brewer, and by Mr. Justice Gray of the same court, sitting in Circuit Court in Massachusetts, it is manifest that whatever may be the jurisdiction committed to the Circuit Courts by the Act of 1875, with regard to the Patent and Copyright laws, such jurisdiction did not comprise actions for the recovery of penalties and forfeitures under such laws. The jurisdiction over such suits has been and still is in the District Courts, and for more than a century no act of Congress has even divided or shared it with any other court.

We are aware of Judge Dallas' able discussion of this point in *Falk* v. *Curtis* (100 Fed. Rep., 77), but this certainly does not preclude this court from further consideration of the question, and the fact that the Congress has frequently changed the provisions of the statutes relating to jurisdiction concurrently with, and presumably with full knowledge of, the line of cases quoted by Judge Dallas, without

in any case altering the general jurisdiction of the District Courts over suits for penalties and forfeitures is persuasive that the Congress does not share Judge Dallas' view and does not acquiesce in his attempt at judicial legislation.

Being without jurisdiction the Circuit Court had no power to render judgment for plaintiff and so properly directed the verdict for the defendant.

For these several reasons we contend that the assignment of errors contains no ground for reversal and that the judgment of the lower court should be affirmed.

Respectfully submitted.

L. L. COBURN,

JOSIAH MCROBERTS,

Of Counsel for the Tribune Company.

Office Supreme Court, U. S.
FILED.
APR 29 1909
JAMES H. McKENNEY,
Clerk.

IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1908.

ISAAC H. CALIGA,
Plaintiff in Error,
vs.
INTER OCEAN NEWSPAPER COMPANY.

No. 22.

MEMORANDUM FOR PLAINTIFF IN ERROR IN RE BRIEF FOR THE TRIBUNE COMPANY.

OTTO RAYMOND BARNETT,
CLARENCE T. MORSE,
Counsel for Plaintiff in Error.

GUNTHORP-WARREN PRINTING CO., CHICAGO

IN THE

Supreme Court of the United States.

OCTOBER TERM, A. D. 1908.

ISAAC H. CALIGA, *Plaintiff in Error,* vs. INTER OCEAN NEWSPAPER COMPANY.		No. 200.

MEMORANDUM FOR PLAINTIFF IN ERROR

In re BRIEF FOR THE TRIBUNE COMPANY.

MAY IT PLEASE THE COURT:

The brief filed by The Tribune Company as *amicus curiae* discusses one point which has not been previously considered or passed upon in the record, and hence is not discussed in our principal brief, to-wit. that no action for penalties for infringement of a copyright upon a painting will lie unless plates or copies are found in defendant's possession.

Upon this point, we call the attention of the court to the fact that Section 4965 of the statutes clearly differentiates in this respect between copyrights upon photographs, maps, etc., and copyrights upon paint-

ings and statuary. As to the former, the statute specifies a penalty—

> "for every sheet of the same found in his possession * * or exposed for sale,"

but in the latter case, it provides that—

> "he shall forfeit $10 for every copy of the same in his possession, **or by him sold** or exposed for sale."

Except for the *Werckmeister* case, 207 U. S., 375, the decisions referred to on this point were in cases in which the infringement related to some copyrighted article other than a painting or statuary, and hence they have no bearing on the construction of this differently worded part of Section 4965 relating to the penalty for infringement of copyright upon a painting.

In the *Werkmeister* case the only point decided was that

> "The plaintiff in error has exhausted his remedy in the judgment rendered in the first suit" (page 384).

We submit, therefore, that while, as to articles other than paintings and statuary, it may be that Section 4965 provides for a penalty only for every sheet found in defendant's possession or exposed for sale, the same section provides, in the case of a painting, statue or statuary, a penalty for every copy either in the defendant's possession, *or which has been sold by defendant,* or which was exposed for sale by defendant.

Respectfully submitted,

OTTO RAYMOND BARNETT,
CLARENCE T. MORSE,
Counsel for Plaintiff in Error.

Chicago, Illinois, 27 April, 1909.

IN THE

Supreme Court of the United States.

OCTOBER TERM, A. D. 1908.

ISAAC H. CALIGA, *Plaintiff in Error,* *vs.* **INTER-OCEAN NEWSPAPER COMPANY,** *Defendant in Error.*	**No. 200.**

REPLY TO BRIEF OF TRIBUNE COMPANY AS AMICUS CURIAE.

We desire first to reply briefly to the following points made by counsel for Tribune Company as *amicus curiae.*

POINTS II AND III.

Counsel has misread R. S. 4965, which makes a clear distinction between the infringement of a copyright of a painting, statue or statuary, and the

other articles mentioned in this section. The statute provides:

> "And in case of a painting, statue or statuary, he shall forfeit $10 for every copy of the same in his possession, *or by him sold or exposed for sale.*"

It is obvious that the statute contemplates an action for penalties, in the case of the infringement of a painting, statue or statuary, without the seizure of copies or plates. Therefore, an action for debt is the proper remedy when the plaintiff is suing to recover merely for copies sold by the defendant. It would not be reasonable to compel a plaintiff in such case to bring a replevin suit; and it is not understood that such is the effect of *Werckmeister* v. *American Tobacco Co.*, 207 U. S., 375. In that case this court decided merely that the statute does not allow a plaintiff to bring two separate actions, one to seize the copies found in the possession of defendants, and the other to recover penalties for the same. Both remedies may be sought in a single action, but two actions may not be maintained. In the case at bar, the plaintiff elected to bring his action to recover merely for the copies sold by the defendant. Only this one action was brought.

Point V.

(a) It is clear that while the public may have the right to inspect the photographic copies deposited in the Library of Congress, there can be no right to copy such photographs, at least so long as the copyright endures, as such copying would

involve an infringement of copyright. The mere exposure of a painting or photograph of a painting, where the public can see it, does not amount to publication unless there is an intent to dedicate it to the public as evidenced by the existence of an unrestricted right to copy.

This court said in *American Tobacco Co.* v. *Werckmeister*, 207 U. S., 284, 299:

> "It is further contended that the exhibition in the Royal Gallery was such a publication of the painting as prevents the defendant in error from having the benefit of the copyright act. This question has been dealt with in a number of cases, and the result of the authorities establishes, we think, that it is only in cases where what is known as a general publication is shown, as distinguished from a limited publication under conditions which exclude the presumption that it was intended to be dedicated to the public, that the owner of the right of copyright is deprived of the benefit of the statutory provision.
>
> Considering this feature of the case, it is well to remember that the property of the author or painter in his intellectual creation is absolute until he voluntarily parts with the same. One or many persons may be permitted to an examination under circumstances which show no intention to part with the property right, and it will remain unimpaired.
>
> The subject was considered and the cases reviewed in the analogous case of *Werckmeister* v. *The American Lithographic Company*, 134 Fed. Rep., 321, in a full and comprehensive opinion by the late Circuit Judge Townsend, which leaves little to be added to the discussion.
>
> The rule is thus stated in Slater on the Law of Copyright and Trademark (p. 92):
>
> 'It is a fundamental rule that to constitute

publication there must be such a dissemination of the work of art itself among the public, as to justify the belief that it took place with the intention of rendering such work common propetry.'

And that author instances as one of the occasions that does not amount to a general publication the exhibition of a work of art at a public exhibition where there are by-laws against copies, or where it is tacitly understood that no copying shall take place, and the public are admitted to view the painting on the implied understanding that no improper advantage will be taken of the privilege.

We think this doctrine is sound and the result of the best considered cases. In this case it appears that paintings are expressly entered at the gallery with copyrights reserved. There is no permission to copy; on the other hand, officers are present who rigidly enforce the requirements of the society that no copying shall take place."

(b) Counsel contend that the evidence fails to show that there were no sales by Curtis & Cameron of photographs prior to November 7, 1901.

Plaintiff in error testified "that no copies were sold prior to November 7, 1901, for the reason that the negatives were not developed, were not finished" (Rec., 31); and upon re-cross examination testified that between the first and the second copyright there was nothing done in the sale of photographs because he was not satisfied to have them go on the market. (Rec., 35.) Also that none of the photographs were exhibited between October 5th and November 7, 1901. (Rec., 35.) This testimony makes out a *prima facie* case. If the defendant has evidence of

a sale prior to November 7, 1901, that is a matter of defense.

(c) It is also contended that the evidence fails to show that copies sold by Curtis & Cameron were marked in a statutory manner.

Here also the plaintiff in error has clearly made out a *prima facie* case.

He testified (Rec., 26) that the notice of copyright was placed upon the painting and was never changed in any way; and that he never authorized the issue of any copy of the painting without the copyright notice on it.

He further testified (Rec., 31) that the words "Copyright 1901, I. H. Caliga," were put on the painting before October 7, 1901, and that his name and the copyright inscription were on every negative made by Custis & Cameron.

So, *if any photographs were sold,* as to which there is no proof, they must have been properly marked.

Falk v. *Gast Co.,* 48 F. R., 262, holds in effect that where the proprietor of the copyright makes a *prima facie* showing as to marking, the burden is upon the defendant; which decision was affirmed in *Falk* v. *Gast Co.,* 54 F. R., 890 (C. C. A., 2nd Circuit).

In *American Press Association* v. *Daily Co.,* 120 F. R., 766 (C. C. A., 7th Circuit), it was held that the plaintiff's right will not be defeated by failure of his publisher to mark copies in accordance with the statute, provided that the latter was under agreement so to do.

Point V I.

Revised Statutes, sec. 563, provides that the District Court shall have jurisdiction "of all suits for penalties and forfeitures incurred under any law of the United States" *but it does not make that jurisdiction exclusive.*

Revised Statutes, sec. 629, gives jurisdiction to the circuit courts "of all suits at law or in equity arising under the patent *or copyright* laws of the United States."

In *Falk* v. *Curtis Publishing Co.,* 100 F. R., 777, it was decided in a very carefully considered opinion that the Circuit Court had jurisdiction of an action for penalties under R. S., sec. 4965, the court saying:

> "What was the intent of Congress in giving the Circuit Courts jurisdiction of 'all suits * * * arising under the patent or copyright laws'? The use of such broadly inclusive language precluded, I think, the implication of an intention to except from the jurisdiction conferred any suit, provided it be one arising under the patent or copyright laws; and, in my opinion, this suit is such a one. The meaning of the terms of the statute is plain. They do not stand in need of interpretation. The only difficulty is in identifying the subject-matter to which they refer; and, if section 4965 can be identified as one of the 'copyright laws of the United States,' no difficulty will remain. That section is comprised in title 60 of the Revised Statutes, which relates exclusively to 'patents, trade-marks, and copyrights,' and is included in chapter 3 of that title, which contains the provisions especially applicable to 'copyrights';

> and it seems to be reasonable, if, indeed, not necessary, to conclude that Congress, in speaking, as in section 629, of 'the patent or copyright laws of the United States,' must have had in mind the laws which, in the same revision, were so classified and discriminated. Moreover, by an almost immediately following section (4968) it is quite clearly indicated that a case may be one of forfeiture or penalty, and yet be a suit under the copyright laws; for the limitation which that section prescribes is that 'no action shall be maintained in any case of forfeiture or penalty under the copyright laws, unless,' " etc.

The Circuit Courts have exercised jurisdiction of suits for penalties in the following, among other reported cases:

Lithographic Co. v. *Sarony,* 111 U. S., 53, 4 Sup. Ct., 279, 28 L. Ed., 349.

Falk v. *Heffron* (C. C.), 56 Fed., 299.

Lithographing Co. v. *Falk,* 20 U. S. App., 296, 8 C. C. A., 224, 59 ed., 707.

Wheeler v. *Cobbey* (C. C.), 70 Fed., 487.

Bolles v. *Outing Co.,* 45 U. S. App., 449, 23 C. C. A., 594, 77 Fed., 966.

Morrison v. *Pettibone* (C. C.), 87 Fed., 330.

Johnson v. *Klopsch* (C. C.), 88 Fed., 692.

Howell v. *Miller,* 33 C. C. A., 407, 91 Fed., 129.

REPLY TO BRIEF FOR DEFENDANT IN ERROR.

We desire also to reply briefly to the following points made by counsel for defendant in error:

Point II.

The point is made that the proceedings relative to the alleged copyright of October 7th, 1901, amount to a publication which would invalidate the copyright sued upon; and reliance is placed upon a quotation from *Bobbs-Merrill Co.* v. *Straus,* 147 F. R., 15, 21. The language quoted, however, should be considered in connection with the rest of the decision which repeatedly holds that the surrender of the right of restricted publication takes place only when *a general publication is made,*—which is in line with our contention that the statutory right is not perfected, so as to terminate the common law right, by the mere deposit of title and copies with the Librarian of Congress, but only when there shall be a general publication following such deposit. In the Bobbs-Merrill case, the court said (page 18):

> "The owner of the common law right has a perpetual right of property and the exclusive right of first general publication, and *may, prior thereto,* enjoy the benefit of a restricted publication without forfeiture of the right of general publication. Thus, he may communicate the contents of his work under restrictions without forfeiture of the right. This communication of contents under restriction, known as

> a restricted or limited publication, is illustrated by lectures to classes of students, dramatic performances before a select audience, *exhibitions of paintings in private galleries*, private circulation of copies of manuscript, etc. *Werckmeister* v. *American Lithographic Co., supra.*"

On page 19, the court said:

> "On the other hand, the surrender of the perpetual right is a condition precedent to the enjoyment of statutory copyright. *The common law right is lost by the general publication or unrestricted sale* of a single copy."

The word "enjoyment" is significant. Obviously, the owner of a copyright does not begin the "enjoyment" of his statutory right until general publication. The common law gives him every protection so long as the publication is restricted.

Further, on page 19, the court said:

> "Where the owner of the common law copyright elects to substitute the protection of the statute for that of the common law, he, *upon publication*, abandons or surrenders his common law rights."

And on page 22:

> "The fallacy of complainant's argument lies in disregarding the peculiar common law right of literary property, namely, the right of first publication, and the condition precedent to the enjoyment of the statutory right, namely, *the surrender of such common law right by a general publication.*"

It is also contended that by giving Curtis & Cameron the right to publish before November 7th, the copyright of November 7th was invalidated. But, obviously, the right to publish is not synonymous with publication, particularly, where as in this case,

there is an obligation put upon the publisher to copyright and to mark copies copyrighted as provided by the statutes (Rec., 25).

PUBLICATION.

The evidence makes a complete *prima facie* case of non-publication prior to November 7, 1901. Caliga testifies that he put the matter of publishing the picture in the hands of Curtis & Cameron:

> "I told them I wanted first class negatives or would not want them published (page 25) * * * The negatives were not satisfactory for some time and they were taking negatives at different times to try and get a proper negative. There was something about the picture they could not solve in the way of getting the values and giving the quality they were looking for in that work and they tried and tried and tried. I was not wholly satisfied with it and neither were they and they were the whole month working at that so that they took them at different times in order to get good results (pages 28 and 29) * * * There was no copy of this painting sold prior to the copy of November 7, 1901, because the negatives were not developed—were not finished." (Page 31.)

With this context it is clear what the witness meant when he said "that the negatives were not developed—were not finished" because they were working during this entire month to get a finished negative suitable for the making of prints for the market. This testimony is not negatived for any purpose of this case by the mere fact that a print sufficient for copyright registration was made and filed prior to November, 1901.

As to the notice of copyright appearing on the photographs, a sufficient *prima facie* showing is certainly made by the testimony of Caliga that all photographs of his painting bore the notice of copyright which had to be photographed from the notice appearing upon the painting, while, upon the broader doctrine of law, the authorities, as previously noted by us, are ample that the owner's right to a copyright cannot be defeated even though his licensee shall reproduce a copyrighted article without notice of the copyright where the owner is not chargeable with this omission. We submit that this is especially so where the reproduction consists in photographing a painting upon which the owner of the copyright has plainly marked the copyright notice required by the Statute.

Point III.

It is urged that there is no averment in the declaration as to the marking copyrighted of the photographic copies of the painting made by Curtis & Cameron. The declaration avers that the painting itself was marked "Copyrighted 1901, I. H. Caliga." This is believed to be sufficient. The declaration makes no averment as to the publication of photographic copies of the painting, and there is no proof as to such publication. The evidence as to this is negative. A painting is not necessarily published by the sale of photographic copies. The usual method of publication is by the

public exhibition of the original. If photographs are made of it, and sold that is merely incidental. On the other hand a book is always published by the dissemination of printed copies. Therefore, it would seem that while it is necessary, as decided in *Ford* v. *Blaney*, cited by defendant in error, to aver that all the printed copies of a book were marked copyrighted, as to a painting the averment that the painting was so marked is sufficient where there is no averment in the declaration that any photographic or other copies of the same were published. The only testimony in the present case tending to indicate that photographic copies of the painting were made proves that if such copies were made, they must have been marked "copyrighted 1901." In any event, if the declaration of the plaintiff in error is defective in this respect, the defect is one of form and amendable.

It is said that the copyright notice is not legible on the exhibit shown at page 18; and from this it is argued that the copyright notice on photographs sold by Curtis & Cameron was not legible. Aside from the insufficiency of proof of such sales, this is mere surmise, and inference, not proof. The exhibit at page 18 is a reproduction of a photographic copy of the photograph deposited in the Library of Congress. There is no proof of sales of photographs and no inference can be drawn from the condition of that particular copy as to the character of the copyright notice placed on photographs exposed for sale by Curtis & Cameron if any were so offered. The latter were under obligation to protect complainant's copyright by placing the

statutory notice on their photographs, and in view of the unqualified statement of plaintiff in error that no photographs not so marked were sold or offered and in the absence of any proof to the contrary, this contention cannot be sustained.

Point IV.

The point is also made that the retouching of the picture subsequent to the copyright, without the deposit in the Library of Congress of a photographic copy of the retouched picture, defeats the right of plaintiff to recover in this case.

In the first place, compliance with section 4959, Rev. Stat., is not made a condition precedent to a suit for infringement where there is an infringement of the copyright on the original edition. In the second place, the simple retouching of a painting and the change in certain entirely minor and unimportant details, without effecting the general appearance of the painting as a composition, does not come under the statute, which only requires the deposit of a copy of subsequent editions in which "*substantial changes* shall be made"; even if this section, which seems very doubtful, applies at all to a painting. It is certainly putting a forced construction on the words "subsequent edition" to make them include the retouching or repainting of a picture. The court has before it a copy of the original painting and also the infringement. Whether defendant copied from the picture as originally painted or as it was subsequently retouched,

its copy is unquestionably an infringement on the picture as it was registered in the Library of Congress.

Point V.

It is contended that because the record does not show that the defendant made their infringing copy directly from the original painting, that there can be no recovery.

The case of *Champney* v. *Haag* (121 Fed., 944) pronounces absolutely bad law, for it holds that the owner of a work of art is not protected if the pirate can show that he did not photograph the work of art directly but that he copied a photograph which had been made by some other person. The fact that such other person has or has not a valid copyright upon the photograph made by him directly from the work of art has no possible bearing upon the question of law involved. With reference to this case Hamlin on copyrights has the following note (p. 132):

> "The principle involved in the decision in this case seems inconsistent with the provisions of the copyright law. That the photograph was copied from another taken of the original painting makes it is no less a copy of the original. This decision apparently indicates an absolutely safe way to pirate copyrighted paintings. The doctrine of the case is contrary to the principle of the English courts. In *Lucas* v. *Williams* (1892), 2 Q. B., 113, where it appeared that the photograph which was alleged to infringe a painting was directly taken from an engraving which was an exact copy of the

> painting upon which the plaintiff had a copyright, it was held that this was evidence to prove the infringement and that the jury might infer that the photographs sold by the defendant were copies of the original."

Furthermore in the present case there is no evidence that the defendant copied from a photograph.

In *Fishel* v. *Lueckel,* 53 F. R., 499, Judge Townsend held that a photogravure was an infringement of an etching.

> "The defendants deny infringement, because as they claim, the copies were not complete without tint, title and platemark, and, therefore, were not marketable. That being so, they claim that the copies produced by the photogravure copy are not 'copies' in the sense in which the term is used in the copyright law. The evidence shows, that although it is usual to tint and mark such pictures, yet incomplete copies such as were produced by the photogravure company would have some market value. This fact alone would seem to be sufficient to establish the infringement. * * * The object of this law is to protect the results of the creative genius of the composer or designer. The appropriation of part of a work is no less an infringement than the appropriation of the whole, provided 'the alleged infringing part contains any substantial repetitions of any material parts which are original and distinctive.' * * * The question is not whether a copy is marketable, but whether it is piratical."

In *Falk* v. *Donaldson,* 57 F. R., 32, a lithograph was held to be an infringement of a photograph, although lacking in the artistic excellence of the latter. The court said (page 35):

> "The question presented here is whether the

defendants have so far copied the design of complainant as to appropriate his manifestation of his conception, or a substantial part thereof. The lithograph is not strictly a copy of the photograph. It differs from it in various ways. Some forty differences have been suggested by experts introduced by defendants. * * * The lithograph lacks the artistic excellencies of the photograph, but I cannot understand how the fact that an attempted appropriation has been inartistically accomplished can help the infringer. If a painter originates and copyrights a work of art; can a chromo manufacturer copy the design, to advertise the wares of a merchant, and defend against an action on the ground that the mechanic has not caught the spirit of the artist, or mixed the pigments in the same tones of color?"

Point V I.

Finally, it is contended that because plaintiff placed the notice of copyright on his painting before any copyright had been secured, he violated the statute forbidding uncopyrighted articles to be marked copyrighted. Carrying this doctrine to its logical conclusion, a painter would be obliged to ascertain the very moment of arrival of his title and copies at the Library of Congress, and at that moment place the notice on his painting. If he marks the painting before the deposit in the Library of Congress, he violates R. S. 4963. If he waits until after the deposit has been made, the copyright is void, because of failure to place the notice on the original.

The answer to this contention is, obviously, that

the notice of copyright was put upon the painting by plaintiff in error in contemplation of a copyright which was subsequently taken out, and that until the copyright proceedings were taken the picture remained in the possession of the painter. It was not publicly exhibited, as the record shows, until November 9, 1901, which was after the registration of the copyright.

The remaining points made by defendant in error have been sufficiently considered, it is believed, in our principal brief; and we do not wish to here repeat the contentions made therein.

Respectfully sumbitted,

OTTO RAYMOND BARNETT,
CLARENCE T. MORSE,
Counsel for Complainant.

Chicago, September 21, 1909.

Office Supreme Court, U. S.
FILED.
APR 22 1909
JAMES H. McKENNEY,
CLERK.

IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1908.

ISAAC H. CALIGA,
Plaintiff in Error,
vs.
INTER OCEAN NEWSPAPER COMPANY.

No. [redacted] 22.

BRIEF FOR PLAINTIFF IN ERROR.

OTTO RAYMOND BARNETT,
CLARENCE T. MORSE,
Counsel for Plaintiff in Error.

GUNTHORP-WARREN PRINTING CO., CHICAGO

IN THE

Supreme Court of the United States.

OCTOBER TERM, A. D. 1908.

ISAAC H. CALIGA, *Plaintiff in Error,* *vs.* INTER OCEAN NEWSPAPER COMPANY.		No. 200.

BRIEF FOR PLAINTIFF IN ERROR.

MAY IT PLEASE THE COURT:

This is a suit to recover the statutory penalty for the unauthorized publication by defendant of a painting entitled "The Guardian Angel," painted and copyrighted by plaintiff in error. (R. S., 4965.)

The Circuit Court directed a verdict for defendant on the ground that the copyright proceedings alleged in the declaration were invalid, because of previous proceedings taken by plaintiff to copyright said painting. (R., 37.)

The judgment for defendant was affirmed on the merits by the Circuit Court of Appeals of the Seventh Circuit, from which decision the present writ of error is prosecuted.

The assignment of errors is as follows:

I.

The Circuit Court of Appeals erred in affirming the judgment of the Circuit Court.

II.

The Circuit Court of Appeals erred in overruling the assignment of error numbered I made by the plaintiff in error against the decision of the Circuit Court, which said assignment is as follows, to-wit:

I. The court erred in entering judgment in favor of defendant.

III.

The Circuit Court of Appeals erred in overruling the assignment of error numbered II, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

II. The Court erred in instructing the jury to find a verdict for the defendant.

IV.

The Circuit Court of Appeals erred in overruling the assignment of error numbered III, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

III. The Court erred in instructing the jury that in October, 1901, the plaintiff had taken all steps necessary to get a copyright.

V.

The Circuit Court of Appeals erred in overruling the assignment of error numbered IV, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

IV. The Court erred in instructing the jury that the plaintiff brought his suit under the wrong copyright and that the second copyright, being the copyright of November 7, 1901, is a nullity.

VI.

The Circuit Court of Appeals erred in overruling the assignment of error numbered V, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

V. The Court erred in instructing the jury as follows:

> "You will now go through the formality of signing the verdict, because I charge you as a matter of law, that the plaintiff fails because he bases his suit upon the wrong copyright. One of your number will please sign the verdict, finding the defendant not guilty."

VII.

The Circuit Court of Appeals erred in overruling the assignment of error numbered VI, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

VI. The Court erred in not instructing the jury in accordance with instruction No. 1, as requested by the plaintiff, as set forth in full in the bill of exceptions herein.

VIII.

The Circuit Court of Appeals erred in overruling the assignment of errors numbered VII, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

VII. The Court erred in not instructing the jury in accordance with instruction No. 3 requested by plaintiff, as set forth in full in the bill of exceptions herein.

IX.

The Circuit Court of Appeals erred in overruling the assignment of error numbered VIII, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

VIII. The Court erred in not instructing the jury in accordance with instruction No. 6, requested by plaintiff, as set forth in full in the bill of exceptions herein.

X.

The Circuit Court of Appeals erred in overruling the assignment of error numbered IX, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

IX. The Court erred in not instructing the jury in accordance with instruction No. 10, requested by plaintiff, as set forth in full in the bill of exceptions herein.

XI.

The Circuit Court of Appeals erred in overruling the assignment of error numbered X, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

X. The Court erred in not instructing the jury in accordance with instruction No. 13, requested by plaintiff, as set forth in full in the bill of exceptions herein.

XII.

The Circuit Court of Appeals erred in overruling the assignment of error numbered XI, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

XI. The Court erred in not instructing the jury in accordance with instruction No. 15, requested by the plaintiff, as set forth in full in the bill of exceptions herein.

XIII.

The Circuit Court of Appeals erred in overruling the assignment of error numbered XII, which the plaintiff in error made against the decision of the Circuit Court, which said assignment is as follows, to-wit:

XII. The Court erred in refusing to submit said cause to the jury and in determining questions of fact which should have been so submitted to the jury.

BRIEF.

Copyright exists at common law as an incident to ownership. It may be lost by publication. The copyright statutes specify what steps must be taken to avoid such loss upon publication.

Myers v. *Callaghan*, 5 Fed., 726.
Wheaton v. *Peters*, 8 Peters, 591.
Board of Trade v. *Commission Co.*, 103 Fed., 902.
Millar v. *Taylor*, 4 Burr., 2303.
Donaldson v. *Becket*, *Id.*, 2408.

Copyright law is to be construed liberally and beneficially.

Allan v. *Black*, 56 Fed., 754.
Myers v. *Callaghan*, 128 U. S., 617.

Nothing but a general publication or an express surrender of his rights will affect a proprietor's common law copyright property. *Id.*

A general publication is one which gives an express or implied right to copy the thing published.

Ladd v. *Oxnard*, 75 Fed., 730.
Werckmeister v. *American Lithographic Co.*, 134 Fed., 321.

An exhibition of a painting under conditions which do not give to the public a right to copy does not amount to a general publication. *Id.*

A deposit of a photograph in the library of Congress in compliance with the copyright statutes merely serves to identify the thing to be copyrighted and, not

giving any express or implied right to copy, does not amount to a publication.

Under the statute the only condition which will prevent obtaining a copyright is prior publication. (R. S., 4952; R. S., 4956.) A copyright registration may be abandoned by failure to publish within a reasonable time after such registration. In such event the common law right never ceases.

Boucicault v. *Hart,* 1692 Federal Cases.
Carillo v. *Shook,* 2407 Fed. Cas.

If, therefore, a registration may be abandoned by failure to publish within a reasonable time, why may it not be abandoned by a subsequent re-registration in the absence of any intermediate publication?

Osgood v. *Aloe Inst. Co.,* 69 Fed., 291.

Common law copyright and statutory copyright cannot co-exist, the first only terminates upon a general publication, the second only begins upon a general publication. Prior to such publication, common law copyright remains unimpaired notwithstanding any registration which may have been made with the Librarian of Congress for the purpose of obtaining the protection of statutory copyright.

Bobbs-Merrill Co. v. *Straus,* 210 U. S., 339, 347.
Press Publishing Co. v. *Monroe,* 164 U. S., 105.
Boucicault v. *Hart,* Fed. Cas. 1692.
Carillo v. *Shook,* Fed. Cas. 2407.

The title of a copyrighted publication must correspond with the title filed for purpose of copyright with the Librarian of Congress.

Mifflin v. *White,* 190 U. S., 260.

The copyright statute providing a penalty for infringement is in form penal, but is remedial in intent.

Dwight v. *Appleton,* Federal Cases, 4215.

Plaintiff's only legal remedy for copyright infringement is under R. S., 4965, for the penalty there provided.

Walker v. *Globe Newspaper Co.,* 130 Fed., 594.

Publication by a licensee of a copyrighted work without marking such reproduction "copyrighted," etc., does not invalidate the copyright.

American Press Assn. v. *Daily Story Pub. Co.,* 120 Fed., 766.

Any unauthorized reproduction of a copyrighted painting, or of the substance thereof, whether by a newspaper cut or otherwise, is an infringement of the copyright.

Werckmeister v. *P. & B. Mfg. Co.,* 63 Fed., 445, 449.

Schumacher v. *Schroenke,* 30 Fed., 690.

Falk v. *Donaldson,* 57 Fed., 32.

Springer Co. v. *Falk,* 59 Fed., 707.

Sanborn Co. v. *Dakin Co.,* 39 Fed., 266.

The variance between the date of copyright registration pleaded under a *videlicet,* and the dates proven was not fatal, even if the registration of November, 1901, were a nullity.

Greenleaf on Evidence, Sec. 61.

Stephen on Pleading, 292.

Allen v. *Black,* 56 Fed., 754.

Myers v. *Callaghan*, 128 U. S., 617.
Salt Lake City v. *Smith* (C. C. A.), 104 Fed., 467.
Rawles Bouvier, 1195.
1 Chitty Pl., 257-8.
Wheeler v. *Read*, 36 Ill., 85.
Beaver v. *Slanker*, 94 Ill., 175, 185.
Reinback v. *Crabtree*, 77 Ill., 188.
Long v. *Conklin*, 75 Ill., 33.
U. S. v. *Le Baron*, 4 Wall., 648.
Taylor v. *Bank of Alexandria*, 5 Leigh (Court of Appeals, Va.), 512.
Martin v. *Miller*, 3 Mo., 99.
Henry v. *Tilson*, 17 Vt., 479.

STATEMENT.

Although various points have been raised by defendant, there is only one substantial contention about which this case turns. This contention may be readily understood from the following brief statement of the facts:

Plaintiff in error, having painted the picture in question, made arrangements with Curtis & Cameron, of Boston, for the publication of photographic copies of the painting as one of the "Copley" prints, Messrs. Curtis & Cameron being under obligation to copyright the painting and the photographs before publication. It was first intended to publish these pictures under the title "Maidenhood" and, with that in view, Messrs. Curtis & Cameron, on October 7, 1901, filed with the Librarian of Congress a photograph of the painting together with the following description of the same:

> "Maidenhood; a young girl seated beside a window; an angel stands behind her."

Thereafter, *and prior to any publication of the painting or photographs,* the artist and publishers decided that it would be better to publish the painting as "The Guardian Angel" and, in view of the fact and to the end that the copyright records in the Office of the Librarian of Congress and the title of the painting as about to be published should correspond, and in view also of the meager description of the painting contained in the registration of October 7, 1901, Messrs. Curtis & Cameron on November 7, 1901, filed another photograph of the painting with the following description:

"The Guardian Angel. Portrait of a young girl sitting, hair arranged smoothly over the ears, hair parted in the middle. Her guardian angel stands behind her, one hand resting on her left shoulder, the other on her right arm."

After this second registration, the painting, with the statutory copyright notice appearing on its face, was exhibited in Chicago and, some controversy arising regarding the painting, the defendant, in disregard of the copyright, published the painting and an article regarding it in the Chicago Inter Ocean, whereupon the present action was brought.

The painting as copyrighted is shown on page 17 of the record. Subsequently slight changes in detail were made in the painting. (R., 33.)

Defendant's infringement involved the unauthorized reproduction of the painting in both forms. (R., 21.)

ARGUMENT.

Taking the copyright law as an entirety, it is clear that it was never the intention of the law that the copyright proceedings in the Librarian's office prior to an actual publication of the painting should, in themselves, constitute a publication. They merely constitute an identification of the subject-matter as to which protection is claimed, but as to which no statutory protection is needed or effective until there is an actual general publication of such subject-matter.

Thus if the preliminary steps are not followed by publication of the work and filing of copies of the work as published, the proceedings lapse and are of no effect. The Courts have held that for copyright protection two things are essential, first, the filing with the Librarian of Congress of the documents specified by statute and, second, a publication of the thing copyrighted, and so, where the proceedings in the Librarian's office have not been followed by publication within a reasonable time, the Courts have held that no statutory copyright protection existed, but that the proprietor was still entitled to his common law protection as proprietor of an unpublished work.

Boucicault v. *Hart,* Fed. Cas., 1692.
Carillo v. *Shook,* Fed. Cas., 2407.

The courts have also held that after statutory registration, but before publication, the common law right remains in force and the statutory right has not begun,

and any cause of action arising must be based on the common law right.

Press Publishing Co. v. *Monroe,* 164 U. S., 105.

Boucicault v. *Hart, supra.*

If these decisions be sound, it follows that the proprietor of an unpublished work may, from time to time, take the necessary steps in the Office of the Librarian of Congress to secure copyright protection and, so long as there has been no general publication of the work, he may, upon publication within a reasonable time thereafter, rely upon the latest of these proceedings as the date from which his copyright protection shall run.

There are sound reasons for this view of the law.

The copyright law is a law intended for the encouragement of the authors of copyrightable works and is, therefore, to be broadly, liberally and beneficially construed. It is no box of tricks which an author is to solve at his peril, with the loss of the proper rewards of his labor as the penalty in case he does not guess correctly. The spirit of it is that the owner of such a work may have, after publication and for a limited period, the exclusive control which he possessed before publication, if he will fairly notify the public, in the manner prescribed by statute, of the fact that he elects to reserve such control. If there is any ambiguity in the notice which he thus files of record with the Librarian of Congress or if there is any variation between the notice so recorded with the Librarian and the title or description of the work as it is about to be published, the spirit of the law not only permits

him, but, in fact, requires him, to file a new notice with the Librarian of Congress which shall remove all such ambiguity and which shall correspond with the description and title of the work as it is to be published.

If he has not published the work between the dates of the filing of these successive notices, no rights have accrued to the public, the public is not prejudiced in any manner and, on the other hand, by the second and corrected notice filed with the Librarian, to which the public is referred by the copyright notice on the work when published, the public is enabled to identify the work as published with the work referred to in such notice and to verify the proprietor's claim that he has, by due proceedings in the Librarian's office, preserved his exclusive right to reproduce the work in question.

As said by the Supreme Court in *Mifflin* v. *White* (190 U. S., 260),

> "The object of the notice being to warn the public against the republication of a certain book by a certain author or proprietor, it is difficult to see how a person reading these notices would understand that they were intended for the protection of the same work."

When Caliga filed his description with the Librarian on October 7, 1901, describing his painting under the title "Maidenhood," can it be reasonably contended that there is anything within either the letter or the spirit of the law compelling him to publish his work under that title, merely because the product of his brain happened to be a painting instead of a book? If it were a book, he clearly would be at liberty to decide before publication upon another title and to fully

protect himself under the copyright laws by re-registering the work before publication under the title which he finally decided to use. Is it the intention of the law that the writer of a book shall have greater freedom in this regard than the artist who produces a meritorious painting? Must the artist be tied down to the title which he first selects, although subsequently, and prior to publication, he may conclude that the use of a different title will be much to his advantage?

On the other hand, if Caliga had published his work as "The Guardian Angel," relying on his registration of October 7, 1901, under the title "Maidenhood," to protect him, would not the Courts have said that this variation was misleading to the public, was not in compliance with the law and, therefore, forfeited the copyright protection sought?

In the "Four-in-hand" case, *Bennett* v. *Carr*, 96 Fed., 213, the Court held that the word "Four-in-hand" was not a sufficient description to secure copyright protection of a painting, the distinguishing feature of which was a Four-in-hand coach and horses. In view of that decision, to the effect that a copyright may be invalid because the description of the painting is not a sufficiently complete description, notwithstanding the filing of a photographic copy of the painting, could Caliga safely rely on his registration of October 7, 1901, in which the painting was described in the following very general terms:

> "Maidenhood; a young girl seated beside a window; an angel stands behind her."

Could any lawyer safely advise him that beyond question the Courts would hold that that description was a sufficient description of the painting within the

meaning of the copyright law and the decisions of the Courts, to insure protection?

Since the sufficiency of the registration of October 7, 1901, was a matter of doubt, was it not Caliga's duty, in order to avoid any possible doubt in this regard, to re-register his painting, not only under the title which was to be used in the publication of the picture, but with a description of the painting which should, without doubt, be sufficient to identfy it as called for by the Statute? Having thus twice registered the title, do the Courts require that, in order to be sure of his remedy against infringers afforded him by Statute, he must bring simultaneously two suits, one relying on the first registration and the other relying on the second registration, so that, if, on the one hand, the Courts shall hold that the first registration was insufficient, because the description was incomplete and the title registered did not correspond with the title of the work as published, then he would prevail in the second suit, or, on the other hand, if the Courts should hold that the first registration was in all respects sufficient, then he would prevail on the first suit and would fail on the second, both suits in that case being necessary, because, in the ordinary procedure of the Courts, the statute of limitations would run before either suit could be finally disposed of?

We most earnestly submit to the Court that the copyright law is no such tricky, intricate and technical maze set as a trap to trick authors out of the protection which the law proposes to give them.

The public has no right to reproduce the work of an author or artist without his consent until he im-

pliedly gives them such a right by a general publication of the work. If, prior to such publication, he shall place of record in the Office of the Librarian of Congress the statutory notice that his publication of the work does not dedicate it to the public, and if, upon publication, he shall place upon the work the statutory notice that he has made such a record in the Librarian's Office, then he will retain all his proprietary rights for the period provided by statute.

If there is any uncertainty, ambiguity, variance or doubt with regard to the notice which he has filed with the Librarian, it is not only his unquestioned right, but his duty, to correct his notice in this regard, but the statute does not provide any procedure for amending or correcting any copyright proceedings, as it does in the case of applications for patents, so that the only alternative is for the proprietor to start his copyright proceedings anew, and, when he has done this, he has the right to rely upon the latest of such proceedings taken by him in compliance with the statute prior to the publication of his work, and the statutory period of copyright protection will run from the date of those proceedings.

In the present case Caliga was the proprietor of a painting. To secure copyright protection, he took certain steps on November 7, 1901, in the Office of the Librarian of Congress, in exact compliance with the statute and prior to a publication of the painting.

Upon the exhibition of the painting thereafter, the painting itself bore the statutory copyright notice and no copy of the painting has been published without this notice. (R., 26, 31.)

We submit, therefore, that we have in all respects complied with the statute, that, by the very terms of the copyright statute, the only matters which could affect the copyright protection which we claim by virtue of the proceedings of November 7, 1901, are, first, a publication of the work prior to that date, or, second, a publication of the work thereafter by plaintiff without the copyright notice. In the absence of either of these facts, our copyright protection under the proceedings of November 7, 1901, is absolute.

The rule that forfeitures are not favored by the Courts, that statutes providing for the recovery of forfeitures and penalties must be strictly construed and that the right to such recovery must be strictly proven, relates at best solely to the proceedings and proofs *as to the alleged acts for which the recovery of the penalty is sought,* not as to the title which has been invaded.

Copyright Statute providing a penalty for infringement is in form, penal, but is remedial in intent. (*Dwight* v. *Appleton,* Fed. Cases, 4215.)

The lower courts however, held adversely to Plaintiff in error upon the claimed analogy to double patenting and the authority of *Miller* v. *Eagle,* 151 U. S., 186, 197.

It will be noted, however:

1. A patent applicant may amend, cancel, abandon or renew his application at any time prior to accepting the patent.

2. When a patent is granted it is immediately published to the world by the Government.

3. A copyright notice deposited with the Librarian

of Congress, is, prior to publication of the work sought to be copyrighted, of no more effect to exhaust the registrant's rights, than is the filing of a patent application effective to exhaust the patent applicant's rights. Prior to the actual grant of the patent, the applicant may withdraw or abandon his application without losing any rights thereby. In like manner the copyright registrant may withhold his work from publication and thereby in effect, withdraw his registration. The statute no-where negatives such right.

While the lower Court decided the case on *Miller* v. *Eagle,* that case is not an authority on the proposition that double patenting is not allowed, for the statute is clear in that regard. *Miller* v. *Eagle* only determined as to when the subject matter of two separate patents was so substantially the same as not to constitute separable, patentable inventions. Hence *Miller* v. *Eagle* sheds no light on the present case. Clearly Caliga's proceedings of November, 1901, were invalid if his proceedings of October, 1901, divested him of his common law rights and brought into existence his statutory rights. Whether or not that was so is the principal question for decision in this case.

In considering the question of copyright property, we should, at the outset, recognize that there is only a superficial analogy between literary property which is the subject of copyright, and inventive property which is the subject of patent protection.

With reference to the latter class of property, no monopoly exists except by virtue of the patent laws.

As to literary and artistic property, on the contrary there not only was but there still is a distinctly recog-

nized property which entitles the owner to to exclusive right of reproduction in the absence of any express statutory enactment.

Thus, the author of a book, a play, a musical composition, or a painting possesses, at common law, the exclusive right of reproduction so long as he has not done that which amounts to a publication.

Drone on Copyright says (1st Ed., p. 116):

> "At common law, the ownership of literary property is not lost by any publication of the work. * * * A work of art may be publicly exhibited, without prejudice to the owner's rights or the remedies for the protection of those rights. The rights and the remedies are the same after as before publication. When these rights are lost by publication, it is not by force of the common law, but by operation of the statute, as it has been judicially construed. This principle is put beyond doubt by the judgment pronounced by the House of Lords in 1774 in *Donaldson* v. *Becket*. Before this decision was rendered, the courts of chancery had uniformly recognized and protected common-law copyright in printed books; * * * The law, as declared by the House of Lords in that case, was followed with approval by the Supreme Court in *Wheaton* v. *Peters*, and it has been followed in every English and American decision which affirms the doctrine, that there can be no copyright after publication, except under the statute. *Hence the doctrine may be regarded as well grounded, both in England and the United States, that, when an author loses his rights by publishing his work, it is by the operation of the statute, and not of the common law.* This principle * * * will serve to make the law clear in some cases whose adjudication might otherwise be attended with doubt and difficulty, and perhaps injustice."

Again on page 119 we read:

> "no English or American statute regulating

> copyright in a literary composition takes effect *until the composition is published* in print, or by the public circulation of copies. *Until such publication* takes places, the common-law rights continue in full force. Hence, the owner of a literary composition which has not been published in print or the circulation of copies, may read it or permit it to be read in public, without any prejudice to his common-law rights therein."

The above excerpts will suffice to illustrate our proposition that there is no fair analogy between patent rights and copyright rights. In the absence of statute the inventor of a patentable thing has no protection, but, in the absence of a statute the owner of an intellectual production already possesses such right.

And, after the enactment of statutes, the owner of an intellectual production may, within certain lines, freely show it and circulate it for an indefinite period without depriving himself of the right to copyright, whereas the owner of a patented invention may by similar conduct absolutely bar himself from the right to a patent.

Continuing, this author analyzes the law as to statutory copyright of a literary production

> "Publication, therefore, is made an essential prerequisite to securing copyright; and hence *there can be no statutory copyright in an unpublished work*"

and reasoning by analogy he says (p. 287):

> "It may be maintained with reason that, to give the public the benefit of the production is as essential to copyright in the case of any work of art as in that of a literary composition; and, hence, that copyright will not vest in a painting or work of sculpture *unless it has been published.*"

Thus, in *Boucicault* v. *Hart* (13 Blatch., 47), the Court said:

> "There is little doubt that the work must be published within a reasonable time after the filing of the title"

and in that case the Court held that there was no statutory copyright because the work had not been published until about four months after the time when the title was recorded.

The significance of these propositions of law, as bearing on the present question, is this:

First, the owner of an intellectual production possessed at common law a copyright therein, which copyright was not destroyed at common law by publication. Where copyright Statutes have been enacted, however, a publication of the work serves to destroy the common law copyright because the proprietor, after publication, is made to depend upon the Statutory right which has been substituted for the common law copyright after publication. Consequently, so long as the proprietor shall not publish his work, although he may privately circulate it, or may exhibit it with proper restriction, he still possesses his common law copyright. If he shall take steps to obtain a Statutory copyright, such Statutory copyright becomes effective and serves to protect him only after publication, *and only in case of publication* and, indeed, under the doctrine of *Boucicault* v. *Hart,* it will be of no effect whatever in case there is not actual publication within a reasonable time after taking other steps to secure the copyright. Consequently, if one shall take the statutory steps to obtain a copyright upon an intellectual production,

which is never published, the mere fact of taking such steps, does not, *per se,* serve to dedicate the work to the public at the expiration of twenty-eight years, or at any other time, for, on the one hand, since the work has never been published, the owner will never have lost his common law copyright, and since his Statutory copyright only affects the owner's rights after publication, the Statutory copyright will never have gone into effect, and, on the other hand, under the doctrine of *Boucicault* v. *Hart,* the preliminary steps to secure Statutory copyright will have failed upon the failure of the proprietor to publish his work within a reasonable time after taking the other steps to secure such copyright.

In other words, the rights which accrue to the public do not accrue by virtue of the Statutory copyright, but accrue *by virtue of publication* and the effect of the Statute is merely this: that, *if the owner shall publish his intellectual product* and if, prior to publication, he shall comply with certain Statutory requirements, then, *if he shall publish within a reasonable time,* his exclusive rights shall date back to the date of deposit of the description or title and shall continue for a period of twenty-eight years from that time.

It follows logically, therefore, that the mere registration for copyright purposes, in the absence of publication, does not dedicate the work to the public and, consequently, is no bar to a subsequent registration for a copyright prior to publication.

Take, for example, the Boucicault case: In that case the plaintiff registered the title of a play, but

did not publish the play for four months thereafter, and, because of his failure to publish the play within a reasonable time after the registration of the title, the Court very properly held that registration to be of no effect, not that it became invalidated, but that the publication within a reasonable time was one necessary step for the completion of the copyright, and that step not having been taken, no valid statutory copyright had been obtained.

Can it be questioned for a moment that if, because of such delay, the plaintiff had failed to develop his registration into a valid copyright, he might immediately before publication have re-registered his title and have secured a valid copyright by publication within a reasonable time after such second registration?

The whole question as to the right to obtain a copyright turns on the question of publication.

As Drone says, there can be no Statutory copyright, in an unpublished work, nor, on the other hand, can there be a valid Statutory copyright on a published work unless publication follows registration within a reasonable time. (*Boucicault* v. *Hart*, *supra*.)

Press Pub. Co. v. *Monroe*, 164 U. S., 105, was a writ of error to the Circuit Court of Appeals for the Second Circuit.

The case was a suit for infringement of the author's common law copyright. It appeared that the plaintiff, who was the author of a lyrical ode, *had deposited a copy of its title with the Librarian of Congress in May*, 1892, *and on October* 22, 1892, *deposited with the Librarian of Congress two copies of the ode;* that prior

to any publication by the plaintiff the defendant, in its newspaper of September 25, 1892, published said ode.

The defendant contended "that the Statutes and constitution of the United States have taken away the common law right (of copyright) and all remedies except under the Statutes of the United States. At Circuit, the Court instructed the jury as to common law copyright and statutory copyright and said, "if the statutory formalities have been complied with, the right becomes complete *upon the publication of the book.*"

The Supreme Court held upon these facts that the action was purely one for the violation of the common law right. In the same case, in the Circuit Court of Appeals for the Second Circuit (73 Fed. Rep., 196), Judge Lacombe said that, *until publication*, the common law copyright continued and that the common law copyright, *prior to publication*, had not been abrogated by our copyright Statutes.

As to What Constitutes the Publication of a Painting:

That a mere deposit of a photograph in the librarian's office for copyright purposes does not constitute a publication would seem to be clear.

Thus, it has been held that it is not necessary that the two copies of a book deposited with the Librarian of Congress be marked with notice of the copyright because such deposit does not constitute a publication. If it did constitute a publication the Statute is clear

that such books must be marked with a notice of copyright because the Statute requires that every copy published shall be so marked. (*Osgood* v. *Aloe Inst. Co.*, 69 Fed., 291, 294.)

The Court said:

> "I have examined fully the elaborate briefs of counsel on the question whether the books deposited by the person seeking copyright must themselves contain copyright notice. * * * I should not hold, under the authorities shown, or under the language of the Act of Congress itself, in relation to copyright, that the depositing of the two books in question for the purpose of securing the copyright, was in itself, such a publication of the book as would destroy the copyright if there were no proper notice of copyright in them."

In *Falk* v. *Gast Lithograph & Engraving Co.* (54 Fed., 890), the Court of Appeals held that the sending out of an exhibition card containing copies in very reduced sizes of photographs from which dealers were requested to take their orders did not constitute a publication. In that case Judge Shipman said:

> "This card or sheet or miniature copy of photographs for the inspection of dealers is not one of the published editions of the photographs which it contained within the meaning of this section. The Statute refers to a published edition, which is an edition offered to the public for sale or circulation."
>
> "To constitute publication, it is necessary that the work shall be exposed for sale or offered gratuitously to the general public, so that any person may have an opportunity of enjoying that for which the copyright is intended to be secured."
>
> *Ladd* v. *Oxnard*, 75 Fed., 730.

Certainly the photograph deposited with the Librarian of Congress is not offered to the public for sale, for copying or for circulation.

And in the Werckmeister case the Court also said as to an exhibition of the painting in the Paris Salon that:

> "It would seem that such an exhibition would not be a publication unless the general public was permitted to make copies at pleasure. *In the absence of direct evidence such permission will not be assumed.*"

In the leading case of *Werckmeister* v. *American Lithographic Co.* (134 Fed., 321), the Court of Appeals for the Second Circuit very fully and instructively reviewed this subject of publication of a painting.

The court there said (page 323):

> "A copyright is an incorporeal right to print and publish. *Trustee* v. *Greenough*, 105 U. S., 527, 530, 26 L. Ed., 1157. It is a property in notion, without corporeal, tangible substance. *Millar* v. *Taylor*, 4 Burr., 2303. This property is a different and independent right, detached from the corporeal property out of which it arises. *Stephens* v. *Cady*, 14 How., 528. * * * Blackstone considers this exclusive right of property as grounded on labor and invention, 405. *The protection of the result may be considered as due to original acquisition.* * * *
>
> To pursue the foregoing analogies, the common law protection continues only so long as the captives or creations are kept in confinement or controlled. The Statute *permits them to go free* and releases the restraint, *provided the owner has stamped them with his brand.* In either case the property of the owner is protected against appropriation without his consent. The common law protected copyright before publication. The

> Statute supersedes the common law right, and subject to certain condition, *extends* its protection after publication. The author of a work of art has at common law a property therein until it is published with his consent. * * * But, as the Statute was enacted for his protection, the mode of publication or the question as to what amounts to publication must correspond to the nature of the right secured."

To be sure in *Jewelry Mercantile Agency* v. *Jewelry Pub. Co.* (155 New York, 241), in the Court of Appeals of the State of New York three of the seven judges held that a deposit of copies with the Librarian of Congress constituted a publication. The significant point in that case, however, was this: plaintiff had deposited with the Librarian of Congress the title to his book and had deposited with the Librarian two copies, but brought suit *under his common law right*, claiming that he had never published the work and that, therefore, his common law right had not been divested. The two lower courts sustained his contention and, while the Court of Appeals reversed the lower courts, the reversal *was not on the ground that his common law right had been determined by recording the title and two copies of the book in the Librarian's office*, although such was the contention of three of the seven judges, but on the ground that plaintiff's circulation of his book had been such *as to constitute a publication thereby perfecting his statutory copyright and depriving the State Court of jurisdiction.* All seven judges appeared to agree that if such deposit did not amount to a publication, and if *there had been no publication* the mere deposit of the title of the work and of two copies of the work with the librarian

would not have divested the common law right, but, while four of the judges held that the manner in which plaintiff had circulated his work constituted a publication, which result was arrived at only after a careful examination by the authorities, the other three judged contended that the mere deposit of two copies of the work with the Librarian of Congress for copyright purposes did *per se* constitute a publication.

This minority conclusion, it will be noted is contrary to the decision of Judge Adams in the Osgood case, *supra,* previously noted and was evidently contrary to the judgment of the special term and the general term in the Jewelry Mercantile Agency case.

Again it is significant that in the case of *Ladd* v. *Oxnard* (75 Fed. Rep., 703), the defendant contended that because complainant had not published he had not perfected his copyright and, therefore, the Federal Courts had no jurisdiction. Whereupon Judge Putnam very carefully considered the question as to whether or not there had been any publication and decided adversely to the defendant on the ground that plaintiff had circulated his work in such a manner as to constitute publication thereof.

This brings us back to our former proposition that so long as there has been no publication of the work, the common law right is not divested and that so long as the common law right continues the owner thereof may, from time to time, register his work for purposes of statutory protection to take effect after publication.

On this subject, we have a very instructive decision in the pronouncement of the Court of Appeals

of the Second Circuit in November, 1904, in the case of *Werckmeister* v. *American Lithographing Company* (134 Fed. Rep., 321).

In that case the painting in question was copyrighted on April 16, 1894. The defendant filed a plea stating that the painting was publicly exhibited, by the author and proprietor thereof, at the exhibition of the Royal Academy of Arts in London, England, from May to August, 1894, without any notice of the copyright inscribed upon some visible portion of the painting. The complainant took issue on the plea and introduced testimony to prove *inter alia* that the following rule of the Academy was strictly enforced that

> "no permission to copy works during the term of the exhibition shall, on any account, be granted, and also, that it was not the custom of artists, who exhibited pictures at the exhibition of the Academy, to place any notice of copyright thereon or on the frame."

The Court said (page 324):

> "Publication of a subject of copyright is effected by its communication or dedication to the public. * * * A limited publication of a subject of copyright is one which communicates a knowledge of its contents under conditions expressly or impliedly precluding its dedication to the public. * * * Thus, in a case of a book. * * * The exhibition or private circulation of the original or of printed copies is not a publication, unless it amounts to a general offer to the public."

The Court then notes that a public representation of a dramatic composition is not a general publication, saying:

> "By admission to such exhibition the general

public acquire no right to reproduce the composition, either by taking notes or by the exercise of the memory. * * *

The result of an examination of the authorities seems to show that the following propositions are established: A general publication consists in such a disclosure, communication, circulation, exhibition, or distribution of the subject of copyright, tendered or given to one or more members of the general public, *as implies an abandonment of the right of copyright or its dedication to the public.* * * * The exhibition of a work of art for the purpose of securing a purchaser or an offer to sell does not adversely affect the right of copyright; and from the fact that the right protected by statute in a work of art is that of copying and not of exhibiting is derived the general rule that the mere exhibition thereof is not a general publication."

In conclusion the Court says (page 330),

"It must be conceded that the author of a work of art does not lose his common-law copyright by exhibition in his studio for purposes of sale, and that the same rule would be applied to an association of artists exhibiting their work in a common gallery solely for this purpose. In the case at bar, both of the restrictions of class and purpose considered above were imposed upon those who were admitted to the Royal Academy. * * * The extent of the publication to such members of the public as chose to pay the fee was a permission to view the exhibition, but a prohibition to make any copies of the paintings therein. * * * We conclude, therefore, that such exhibition did not amount to a general publication."

The reasoning of this decision would appear to be that there is no publication of a work of art except where it is exhibited under such circumstances, that

the public are expressly or impliedly given an opportunity to copy it.

Consequently, even if it were true that the deposit of two copies of a book with the Librarian of Congress, where such books are immediately accessible to the public and may be copied, subject only to the copyright limitation, amounts to a publication, it by no means follows that the deposit with the Librarian of Congress of a photograph of a painting amounts to a publication of that painting for, as amply appears from the deposition here in evidence, the public has no general access to such deposited photograph and is not permitted to copy the same but copies thereof are only permitted under particular and carefully guarded conditions. (R., 24.)

If defendants' contentions be sound then, when an author registers his work by a given title he thereby exhausts his copyright privileges under the statute and if, subsequently, and before publication, he concludes that it would be wiser for commercial reasons, or for reasons of accuracy, or for other reasons, to change the title of his work, he cannot thereafter, and before publication, again register his work under such new and better name because, having once registered it under one name, then, according to defendants' contentions, his rights have been exhausted so that his second registration is not valid, and, on the other hand, having subsequently published the work under the second title registered his first registration becomes of no avail and his copyright fails. Such a construction of the statutes would serve no useful purposes and would merely serve to set a trap for the author.

Infringement.

In a copyright procedure, the decisions of the Courts point to this peculiar situation:

Where the infringement has been of such a character that there is no prospect of its continuance, the owner of a copyright has no right of action in equity, because jurisdiction in equity depends primarily upon his right to enjoin future infringement, the right to an accounting being purely incidental to this right to an injunction. (*Root* v. *Ry. Co.*) The injured proprietor of the copyright is, therefore, left solely to his remedy at law but, say the Courts, the only remedy at law provided by the statute is a suit, not to recover actual damages, but a suit to recover the statutory penalties and, therefore, the Courts will not entertain any action by the owner of an infringed copyright against an infringer whose acts will not prospectively continue, except a *qui tam* action, like the present one, to recover statutory penalties.

Inasmuch, therefore, as the present proceeding is the only remedy afforded plaintiff in error by the statutes, this proceeding ought not to come within the rigorous doctrine ordinarily applying in *qui tam* actions.

Walker v. *Globe Newspaper Co.*, 130 Fed., 594; same case, 210 U. S., 356, 366.

Be that as it may, it appears, by stipulation in the record, that the infringing publication did appear in the Chicago Inter Ocean of October 25, 1903, that the defendant was the publisher of that paper and that the edition of October 25, 1903, of the Chicago Inter

Ocean exceeded 1,000 copies. (R., 19, 27.) It further appears clearly that the publication was without the consent of the owner of the copyright, so that, as to the only matters to which the rigorous doctrine of strict construction and strict scrutiny is applicable in the present case, the facts are proven beyond question and the defendant is compelled to destroy the copyright itself, in order to defeat the action. (R., 27.)

Various minor issues have been raised in the record by defendant as to whether or not there had been any publication of the work prior to the copyright registration of November 7, 1901, as to whether or not there had been any subsequent publication without the copyright notice, etc., but, aside from the fact that these are matters where the burden of proof is upon the defendant, the record is clear beyond any question that there was neither a publication prior to the copyright proceedings relied upon nor was there any subsequent publication of the work without the statutory copyright notice.

So, also, there was considerable discussion in the lower Court as to whether or not the allegation under a *videlicet* of the copyright proceedings of November 7, 1901, would not be sufficient to sustain the action in any event, because, if the view of the lower Court that the registration of November 7, 1901, was a nullity is correct, then the allegation under a *videlicet* of such proceedings in November was sufficiently sustained by the proof in the record of the proceedings had in October, 1901. (R., 35.)

We still rely upon these contentions and believe they are well founded, but have purposely avoided an ex-

tensive discussion of any of these minor questions in order to emphasize our main contention which, so far as the decisions of this Court are concerned, involves an important question of copyright law which has never been previously raised or decided and which, if our contentions are sustained, is conclusive of the entire case.

Exactly the same question was involved in the case of *Allen* v. *Black*, 56 Fed., 754, although that question is not noted either in the Digests or in the syllabus of that case. The facts there, however, were as follows:

That was a suit by the proprietor of the copyright upon the 23rd volume of the Encyclopaedia Britannica. One Walker was the author of a book on the Political Geography and Statistics of the United States and he entered into an agreement with Scribner's Sons whereby this book should be published as a part of Volume 23 of the Encyclopaedia Britannica. *On December* 31, 1887, Scribner's Sons deposited in the office of the Librarian of Congress a title which the Court says "was intended to cover the same works as those in question in these suits."

Here we have a deposit of title analogous to Caliga's October deposit. The court said that it well might be that the statutory copyright might perhaps be limited to 28 years from December 31, 1887. Plaintiff sued pleading his later registration of February, 1888, but the court held that it did not matter so long as it appeared that plaintiffs had complied with the statute upon some date prior to publication and prior to bringing suit.

On February 13, *1888*, the said Walker delivered at

the office of the Librarian of Congress a printed copy of the title to his work and also within ten days from publication delivered to the Librarian of Congress two complete printed copies of said book of the best edition issued; and in the several copies of every edition published, on the title page were the words "Copyrighted 1888 by Francis A. Walker." We quote from the decision as follows, page 769:

> "Defendant's counsel argued that, if the copyright in this case is held valid, it dates from the filing of the second title, on February 13, 1888, and would, therefore, extend the term of the copyright to more than 28 years, and that, therefore any copyright claimed under this filing of the second title must be void. Complainant's counsel insists that, even if the authors at first contemplated copyrighting their productions as a single volume, they might change their minds, and pursue the course which they did. No decisive authority is cited, sustaining either claim. It is easily seen that an author may find it to his advantage to change the title of his work between the time of his taking his first step toward obtaining a copyright and the actual publication of the book. I do not think that the courts should hold that such change of title renders a copyright invalid, unless compelled to do so, and I do not think they are so compelled. It may be that the copyright, as completed by the deposit of the published work, does not extend more than 28 years from the filing of the original title, but that does not affect the present case. Furthermore if it were necessary, in order to sustain complainants' copyright, there would be much ground for claiming that the published title of the articles in question, and the articles themselves, sufficiently identify them, as against these defendants, with the title filed on December 31, 1887, to bring the case within the doctrine of *Carte* v. *Evans,* 27 Fed. Rep., 861. * * *

In *Callaghan* v. *Myers* (128 U. S., 657), the Supreme Court said:

> "The title was deposited January 28, 1867, and the notice printed in the volume purports to show that the copyright was entered in 1866. The statute required that each copy of the book should have inserted in it a statement of the year the copyright was entered. *It is sufficient to say that the variance must be regarded as immaterial.*"

The various provisions of law in relation to copyright should have a liberal construction in order to give effect to what may be considered the inherent right of the author to his own work. (*Myers* v. *Callaghan*, 5th Fed. Rep., 726.)

> "There is what may be called the original right of the author. It is the object of the Act of Congress to 'SECURE' the right *which thus primarily exists*. Indeed Statutes of copyright seem to imply the existence of a natural right of the author to the product of his brain. They are passed in order to make that right *after publication*, in the language of the constitution, 'exclusive.'
>
> *Myers* v. *Callaghan*, 5 Fed. Rep., 726.

Statutory Construction.

While the statute which provides a penalty of $10 for the sale of each unauthorized copy of a copyrighted work of art is generally construed as a penal statute, there are not wanting authorities of weight to the effect that the statute, while penal in form, is remedial in character and should be construed accordingly.

Dwight v. *Appleton*, 4215 Fed. Cases.

Since no action at law lies to recover for the damage caused by infringement of a copyright this statute is essentially remedial.

Walker v. *Globe Newspaper Co.*, 130 Fed., 594; same case, 210 U. S., 356, 366.

And since, in the present case, there is no ground for an injunction, equity has no jurisdiction, plaintiff has no remedy except by the present action.

Root v. *Ry. Co.*, 105 U. S., 189.

So far as the precise facts upon which we claim the statutory penalty are concerned, to-wit, the defendant's unauthorized publication, the number of copies published, etc., it may, perhaps, be true that the law is to be construed strictly, but with that we have no concern in the present case, because we have a stipulation in which the defendant admits on the record that it is the publisher of the publication complained of, that it did publish said publication on the date alleged in the declaration, that the copy thereof introduced in evidence showing reproductions of plaintiff's painting is a true copy; and that upwards of one thousand (1000) copies of that issue were sold by the defendant.

The correct view of this case, it is believed, is that the statutory copyright is not brought into existence by the record of the description (although the period of protection runs from that date) nor at the time of the deposit of the photograph. The statutory copyright has no existence and can form no basis of a suit until there has been a general publication. This seems to be implied in the adoption by this Court in *Bobbs-*

Merrill v. *Straus*, 210 U. S., 339, of the language quoted in that decision from Drone on Copyright, page 100. The language quoted is as follows:

> "'As the law is now expounded, there are important differences between the statutory and the common law right. *The former exists only in works which have been published within the meaning of the statute*, and the latter only in works which have not been so published. In the former case, the ownership is limited to a term of years; in the latter it is perpetual. The rights do not co-exist in the same composition; *when the statutory* right begins the common law right ends."

In *Bobbs-Merrill* v. *Straus*, 147 Fed., 15, page 19, the Circuit Court of Appeals said:

> "Where the owner of a common law copyright elects to *substitute* the protection of the statute for that of the common law, he, *upon publication*, abandons or surrenders his common law rights, including said right of limited publication, in exchange for the statutory right."

Conclusion.

The authorities cited lead inevitably to the following logical resolution of this case:

Prior to publication common law copyright exists as an incident of ownership.

Statutory copyright begins only when common law copyright terminates, they do not co-ex

Hence statutory copyright becomes effective only upon publication, whereby common law copyright is terminated.

Therefore, a second registration for purposes of copyright of an *unpublished* work does not constitute

a double copyrighting. Such second registration prior to publication supersedes any previous registration made for purposes of compliance with the copyright statutes. In this manner only does the law permit a proprietor to correct errors, change the title of the thing to be published, enlarge the description and otherwise make definite and certain his registration in any respect regarding which doubt may have arisen.

It follows, therefore, that Caliga's registration of November 7, 1901, was not a double copyrighting and that this case should be reversed and remanded.

Respectfully submitted,

OTTO RAYMOND BARNETT,
CLARENCE T. MORSE,
Counsel for Plaintiff in Error.

Chicago, Illinois, April 20, 1909.

Office Supreme Court, U. S.
FILED.
APR 5 1909
JAMES H. McKENNEY,
CLERK.

IN THE SUPREME COURT OF THE UNITED STATES,

October Term, 1908.

Isaac H. Caliga,
Plaintiff in Error,
vs.
Inter Ocean Newspaper Company.
} No. 22

MEMORANDUM IN OPPOSITION TO MOTION BY THE TRIBUNE COMPANY.

MAY IT PLEASE THE COURT:

This is a motion by a stranger to the record, based upon an *ex parte*, unverified statement of insufficient matters, outside of the record in this case, for leave to file a brief herein as "*amicus curiae.*"

It is opposed on the following grounds:

That it does not appear who The Tribune Company is.

That The Tribune Company is not a party to this litigation.

That upon its own *ex parte*, unverified showing of alleged facts *dehors* the record herein, it seeks to participate in this hearing, to the end that it may have the benefit of a decision adverse to the plaintiff in error, but may not be bound by any decision favorable to plaintiff in error.

That from the face of its own showing, any interests which it may have in the premises are now the subject-matter of pending litigation to be determined in court in the usual, due and orderly procedure.

That identity of issues, facts and considerations in the two cases does not appear from any sufficient showing of record.

That there is an utter failure of any sufficient showing as to why this stranger to the record should be allowed to participate in the hearing of this cause.

However, if it be true, as stated in the motion of The Tribune Company, that "the same issues and considerations are present in both cases," then The Tribune Company should be willing to abide the result of this suit in all respects and, if The Tribune Company will submit to an order in this court to that effect, we will consent to the granting of the motion, but we submit that it would be manifestly unjust to permit The Tribune Company to intervene in these proceedings in such a manner as not to be bound thereby in case plaintiff in error should prevail.

Respectfully submitted,

OTTO RAYMOND BARNETT,
CLARENCE T. MORSE,
Counsel for Plaintiff in Error.

Chicago, Illinois, April 2d, 1909.

Office Supreme Court, U. S.
FILED.
APR 8 1909
JAMES H. McKENNEY,
Clerk.

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, A. D. 1908.

ISAAC H. CALIGA,
Plaintiff in Error,
vs.
INTER OCEAN NEWSPAPER COMPANY.
No. 22

MOTION.

L. L. COBURN,
JOSIAH McROBERTS,
Of Counsel for The Tribune Company.

Geo. Kornemann Co., Printers, Chicago.

IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1908.

ISAAC H. CALIGA,
Plaintiff in Error,
vs.
INTER OCEAN NEWSPAPER COMPANY.
No. 200.

MOTION.

And now comes The Tribune Company, by Lewis L. Coburn and Josiah McRoberts, its counsel, and moves that leave be granted to it to file at the hearing of the above entitled cause a brief as *amicus curiae*.

SUGGESTIONS.

This motion is based upon the facts that there is now a suit pending in the Circuit Court of the United States for the Northern District of Illinois wherein Isaac H. Caliga, plaintiff in error in this suit, is plaintiff, and The Tribune Company is defendant, which suit was brought by said Caliga against The Tribune Company for the recovery of the statutory penalties provided by Section 4965 of the Revised Statutes of the United States for infringement of an alleged copyright registered by said Caliga Novem-

ber 7, 1901, upon a painting owned by him and described in the declaration in said suit as follows:

> "'The Guardian Angel.' Portrait of a young girl sitting, hair arranged smoothly over the ears, hair parted in the middle. Her guardian angel stands behind her, one hand resting on her left shoulder, the other on her right arm,"

which said copyright is the same copyright upon which the present suit is based, and that the said suit against The Tribune Company has been stayed by order of court to abide the result of the present suit in case of affirmance by the following stipulation:

"IN THE CIRCUIT COURT OF THE UNITED STATES
For the Northern District of Illinois,
Eastern Division.

"Isaac H. Caliga
vs.
The Tribune Company. } No. 27,837.

"STIPULATION.

"IT IS HEREBY STIPULATED AND AGREED by and between the attorneys for the parties of the above-entitled cause, that said cause shall abide the result of the co-pending suit of *Isaac H. Caliga* v. *The Inter Ocean Newspaper Company*, now pending in this court, No. 27,838, to this extent, to-wit:

"That if the ultimate determination of said cause of *Caliga* v. *The Inter Ocean Newspaper Company* on writ of error in the highest court to which said cause shall be carried shall be adverse to plaintiff's right of action therein, the above-entitled cause of *Isaac H. Caliga* v. *The*

Tribune Company shall be dismissed at plaintiff's cost, but if such ultimate determination of said cause of *Isaac H. Caliga* v. *The Inter Ocean Newspaper Company* shall be favorable to plaintiff, then the above-entitled cause of *Isaac H. Caliga* v. *The Tribune Company* shall be thereafter called for trial in due course.

"And it is Further Agreed that pursuant to the above stipulation the proceedings in the above-entitled cause shall be stayed until the further order of the court.

"Otto R. Barnett,
"Clarence T. Morse,
"*Attorneys for Plaintiff.*
"Coburn & McRoberts,
"*Attorneys for Defendant.*

"Chicago, Ill., January 14, 1907."

The granting of this motion will be in accordance with the general practice of this court, as we understand it, of allowing interested parties to participate in the proceedings, at least to the extent of filing a brief to present their views, the same issues and considerations being present in both cases.

Respectfully submitted.

L. L. Coburn,
Josiah McRoberts,
Of Counsel for The Tribune Company.

Dated at Chicago, Illinois,
March 30, A. D. 1909.

SUPREME COURT OF THE UNITED STATES,
October Term, 1908.
No. 200.

Isaac H. Caliga, *Plaintiff in Error,*
vs.
Inter Ocean Newspaper Company.

NOTICE OF MOTION.

To Otto R. Barnett, Esq.,
Counsel for Plaintiff in Error,
Chicago, Illinois.

To Messrs. Knight, Barbour & Adams,
Counsel for Defendant,
Chicago, Illinois.

Sirs:—

Please take notice that on Monday, April 5th, 1909, upon the opening of court, or as soon thereafter as counsel can be heard, we shall present to the Honorable Chief Justice and Justices of the Supreme Court of the United States, the foregoing motion and suggestions on behalf of The Tribune Company, and ask for an order in conformity with the same; at which time and place you may be present if you see fit.

JOSIAH MCROBERTS,
Of Counsel for The Tribune Company.

Service of the above notice, motion and suggestions by copy thereof acknowledged this 31st day of March, 1909.

OTTO R. BARNETT,
Counsel for Plaintiff in Error.
CLARENCE A. KNIGHT and
JAMES J. BARBOUR,
Counsel for Defendant.

Office Supreme Court, U. S.
FILED.
APR 28 1908
JAMES H. McKENNEY,
Clerk.

No. [redacted]22.

IN THE

Supreme Court of the United States.

OCTOBER TERM, A. D. 1908.

ISAAC H. CALIGA,
Plaintiff in Error,

vs.

INTER OCEAN NEWSPAPER COMPANY,
Defendant in Error.

ERROR TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

Brief and Argument for Defendant in Error.

CLARENCE A. KNIGHT,
JAMES J. BARBOUR,
ATTORNEYS FOR DEFENDANT IN ERROR.

BARNARD & MILLER PRINT, CHICAGO.

IN THE

Supreme Court of the United States,

OCTOBER TERM, A. D. 1908.

No. 200.

ISAAC H. CALIGA,

Plaintiff in Error,

vs.

INTER OCEAN NEWSPAPER COMPANY,

Defendant in Error.

ERROR TO THE UNITED STATES CIRCUIT COURT OF APPEALS, FOR THE SEVENTH CIRCUIT.

Brief and Argument for Defendant in Error.

STATEMENT.

The plaintiff, Isaac Caliga, finished the painting in question in the fall of 1901. In September he entered into an agreement with Curtis and Cameron by which "the picture was given into their hands." (Rec., 25-28.) They were to "publish the picture." (Rec., 25.) Authority was given them to secure copyrights. (Rec., 28.) This authority was never revoked. (Rec., 28.) Under the agreement Mr. Caliga was to have a royalty on the photographs

sold. (Rec., 28.) Curtis and Cameron undertook to photograph the painting; "they were the whole month working at that," "in order to get good results." (Rec., 29.) The photograph finally adopted was finished prior to October 7, 1901, on which date a copyright was secured in the name of I. H. Caliga upon the painting in question with the following description:

> "Maidenhood; a young girl seated beside a window; an angel stands behind her." (Rec., 29, 30, 35.)

We shall hereafter refer to this as the first copyright.

November 1, 1901, Curtis and Cameron secured a copyright on a *photograph* of the painting under the title of "Guardian Angel." (Rec., 30.)

In 1901 the painting was shipped by Mr. Caliga to the Carnegie Exposition at Pittsburg.

> "The painting was in transit about the time that I applied for the *second* copyright." (Rec., 31.)

This copyright was secured November 7, 1901, and is the copyright upon which this suit is based. We shall hereafter refer to it as the *second* copyright. The description was as follows:

> "The Guardian Angel. Portrait of a young girl sitting, hair arranged smoothly over the shoulders, hair parted in the middle. Her Guardian Angel stands behind her, one hand resting on her left shoulder, the other on her right arm."

The photograph deposited with the Librarian of Congress to secure the copyright of November 7th was the same as the photograph deposited October

7th (Rec., 29), and bore the notice of the prior copyright secured by Curtis and Cameron as follows: Copyright 1901 by Curtis & Cameron. (Rec., 17.) It also shows, although not legibly, the notice of Mr. Caliga's copyright. This notice appears in the lower right hand corner of the photograph by reason of the fact that the photograph reproduces the face of the painting and some slight trace of the notice which was placed upon the painting before the photograph was taken, was necessarily communicated to the photograph. No other notice of Mr. Caliga's copyright than such as appears upon this photograph was inscribed upon any of the photographs sold by Curtis and Cameron. (Rec., 31.) Photograps of the painting were on sale by Curtis and Cameron until 1903. (Rec., 31.) Between the dates of October 7th and November 7, 1901, no alterations or changes were made in the picture. (Rec., 29.) In 1903 Mr. Caliga repainted the picture. (Rec., 17, 26, 29, 30 and 33.)

"After repainting the picture" in 1903, the plaintiff made no effort to comply with the requirements of the statute providing for the deposit of a copy of subsequent editions with the Librarian of Congress. (Rec., 30.)

The notice "Copyright, 1901, I. H. Caliga" was placed upon the painting prior to October 7, 1901, and prior to the time the painting was photographed by Curtis and Cameron (Rec., 17, 26 and 31) and this notice has never been changed. (Rec., 26, 31.)

BRIEF.

I.

WHERE TWO COPYRIGHTS OF THE SAME PAINTING ARE PROCURED BY THE PAINTER THEREOF, THE SECOND COPYRIGHT IS VOID.

Mifflen v. *Dutton*, 112 Fed., 1004.

Lawrence v. *Dana*, 15 Fed. Cas., 8136.

Black v. *Murray*, 9 Sc. Sess. Cas., 3d Ser., 341.

Thomas v. *Turner*, 33 Ch. Div., 292.

Scrutton Law of Copyright, page 119.

Drone on Copyright, page 146.

Macgillivray on the Law of Copyrights, p. 27.

A. A PATENTEE CANNOT HAVE TWO PATENTS FOR THE SAME INVENTION.

22 Am. & Eng. Ency. of Law, 314, and cases there cited.

Miller v. *Eagel Mfg. Co.*, 151 U. S., 186.

Suffolk Co. v. *Hayden*, 3 Wall., 315.

James v. *Campbell*, 104 U. S., 356.

Mosler Safe Co. v. *Mosler*, 127 U. S., 354.

McCreary v. *Pa. Canal Co.*, 141 U. S., 459.

Underwood v. *Gerber*, 149 U. S., 224.

THE REASONS ARE

THAT THE POWER TO CREATE A MONOPOLY IS EXHAUSTED BY THE FIRST GRANT.

THAT A NEW PATENT FOR THE SAME INVENTION WOULD OPERATE TO EXTEND THE MONOPOLY BEYOND THE PERIOD ALLOWED BY LAW.

Odiorne v. *Amesbury Nail Factory*, 2 Mason, 28.

Miller v. *Eagle Mfg. Co.*, 151 U. S., 186.

B. WHATEVER RIGHTS ARE POSSESSED BY THE PROPRIETOR OF A COYRIGHT ARE DERIVED FROM THE COPYRIGHT ACT AND NOT FROM THE COMMON LAW.

White Smith Music Co. v. *Apollo Co.*, 209 U. S., 1.

S. C., 147 Fed., 226.

Bobbs-Merrill Co. v. *Straus*, 210 U. S., 339.

S. C., 147 Fed., 15.

Globe Newspaper Co. v. *Walker*, 210 U. S., 356.

Wheaton v. *Peters*, 8 Pet., 591.

Stevens v. *Glading*, 17 How., 447.

Banks v. *Manchester*, 128 U. S., 244.

Thomas v. *Hubbard*, 131 U. S., 123.

Holmes v. *Hurst*, 174 U. S., 82.

Palmer v. *DeWitt*, 47 N. Y., 532.

II.

THE PAINTING WAS PUBLISHED PRIOR TO THE DATE OF THE APPLICATION FOR THE COPYRIGHT OF NOVEMBER 7TH.

1. THE PROCUREMENT OF A COPYRIGHT IS A PUBLICATION WITHIN THE MEANING OF THE STATUTE, AND VITIATES A LATER COPYRIGHT.

Jewelers' Mer. Agency v. *Jewelers Pub. Co.*, 155 N. Y., 241.

Bobbs-Merrill Co. v. *Straus*, 147 Fed., 15.

2. THE SELLING OR OFFERING FOR SALE PHOTOGRAPHS OF A PAINTING IS A PUBLICATION OF THE PAINTING.

Am. Tobacco Co. v. *Werckmeister*, 146 Fed., 375.

III.

COMPLIANCE WITH THE STATUTORY REQUIREMENT THAT THE NOTICE OF COPYRIGHT SHALL BE PLACED UPON ALL COPIES SOLD MUST BE PLEADED AND PROVED AS A PREREQUISITE TO AN ACTION FOR RECOVERY OF PENALTIES FOR AN INFRINGEMENT OF THE COPYRIGHT.

Ford v. *Blaney Amusement Co.*, 148 Fed., 642.

Falk v. *Gast Lith. & Eng. Co.*, 40 Fed., 168.

Mifflen v. *Dutton*, 190 U. S., 265.

Higgins v. *Keuffel*, 140 U. S., 428.

Thompson v. *Hubbard*, 131 U. S., 123.

IV.

WHERE A PAINTER BY REPAINTING A COPYRIGHTED PICTURE EFFECTS A SUBSTANTIAL CHANGE, THE ORIGINAL COPYRIGHT DOES NOT PROTECT THE PICTURE AS REPAINTED.

Sec. 4959, Fed. Stat. Ann.
Lawrence v. *Dana*, 15 Fed. Cas., 8136.
Drone on the Law of Copyrights, p. 146.
9 Cyc., 924.

V.

IN AN ACTION TO RECOVER FOR AN INFRINGEMENT OF A COPYRIGHT IT MUST BE SHOWN THAT THE PUBLICATION COMPLAINED OF IS A COPY OF OR COPIED FROM THE COPYRIGHTED PAINTING.

REPRODUCTION OF A COPYRIGHTED PHOTOGRAPH OF A PAINTING IS NOT AN INFRINGEMENT OF THE COPYRIGHT ON THE PAINTING.

Champney v. *Haag*, 121 Fed., 944.

VI.

THE INSERTION OR IMPRESSION OF A COPYRIGHT NOTICE UPON A PAINTING BEFORE APPLYING FOR A COPYRIGHT IS PROHIBITED.

Sec. 4963, Fed. Stat. Ann.

VII.

A VARIANCE CAN ONLY BE WHERE THERE IS A CLEAR DISCREPANCY BETWEEN AVERMENT AND PROOF.

29 Am. & Eng. Ency., 580.

Walford v. *Anthony*, 21 E. C. L., 75.

VIII.

VALIDITY OF COPYRIGHT OF OCTOBER 7, 1901.

ARGUMENT.

I.

WHERE TWO COPYRIGHTS OF THE SAME PAINTING ARE PROCURED BY THE PAINTER THEREOF, THE SECOND COPYRIGHT IS VOID.

In *Mifflin* v. *Dutton*, 112 Fed. Rep., 1004, it is said, at page 1005:

> "The notice given by the publishers of the Atlantic Monthly was clearly a notice of a supposed copyright secured by themselves, and it contained to indicate that it was a notice of one taken out by Mrs. Stone. The presumption, therefore, is that it was a notice of a copyright of so much of the Atlantic Monthly as the publishers were entitled to copyright in their own behalf.
>
> "They could not, then, copyright 'The Minister's Wooing,' because it had already been copyrighted, and there cannot be two successive copyrights of the same publication. To permit this would render possible an extension of the statutory period through which a copyright runs, which, of course, the law will not allow."

In *Black* v. *Murray*, 9 Sc. Sess. Cas., 3d Ser., 341, Lord ARDMILLAN said:

> "A new edition is not necessarily a subject of copyright, but it may be so. There must be some originality in it; it may be in new thought, or in new illustration, or in new explanatory and illustrative annotation, or even, in some peculiar instances, in simply new arrangement, if in any of these respects there is independent

mental effort, then, in the result of that mental effort there may be copyright."

In the case of *Lawrence* v. *Dana*, 15 Fed. Cas., 8136, it is said (page 52):

> "Subsequent editions without alterations or additions * * * find their only protection in the original copyright."

In Scrutton on the Law of Copyright, it is said (page 119):

> "In *Thomas* v. *Turner* the remarks of COTTON, L. J., show that a new edition without substantial alterations is not an original work, and therefore not a book in which there is copyright, or which can be registered. The copyright and the registration are of the preceding edition."

In *Thomas* v. *Turner*, 33 Ch. D., 292, COTTON, L. J., expressed the reason for not allowing successive copyrights of the same edition to be that

> "by means of successive editions, the copyright in the original work might be made to run on forever."

In Drone on Copyrights it is said (page 146):

> "Whether an independent copyright will vest in any subsequent edition will depend on the amount of new matter which it contains, or the extent and character of the revision which has been made in the preceding edition. A simple reprint of the original, or other previous edition, will be entitled to no other protection than is given to the preceding edition. In such case, there is nothing new on which to found a valid claim for copyright."

In Macgillivray on the Law of Copyright (1902) it is said (page 27):

> "If a new edition is a mere reprint of what has been published in 'book' form before, it is

obvious that no new or independent copyright can be claimed in it."

A. Patents.

In the case of patents it has long been held the law that:

> "a prior patent is, of course, an anticipation of and renders void a subsequent patent for substantially the same thing."
>
> 22 Am. & Eng. Enc. of Law, page 314.

From the great number of cases there cited, we have selected the following merely to show the application of a well recognized rule.

In the case of *Miller* v. *Eagle Mfg. Co.*, 151 U. S., 186, it is said (page 196):

> "The drawings in each of the patents are identical, and the specification in each is substantially the same. Under these circumstances can it be held that the second patent has any validity or must it be treated as having been anticipated by the grant of the 1879 patent? If, upon a proper construction of the two patents—which presents a question of law to be determined by the court (*Heald* v. *Rice*, 104 U. S., 737, 749), and which does not seem to have been passed upon and decided by the court below—they should be considered as covering the same invention, then the later must be declared void, under the well settled rule that two valid patents for the same invention cannot be granted either to the same or to a different party."

The court then refers with approval to the foregoing cases:

Suffolk Co. v. *Hayden*, 3 Wall., 315.

James v. *Campbell*, 104 U. S., 356.

Mosler Safe Co. v. *Mosler*, 127 U. S., 354.
McCreary v. *Pa. Canal Co.*, 141 U. S., 459.
Underwood v. *Gerber*, 149 U. S., 224.

And then concludes, on page 198:

"In *Odiorne* v. *Amesbury Nail Factory*, 2 Mason, 28, the reason for the rule since established by the above cited cases was stated to be that the power to create a monopoly is exhausted by the first patent; and for the further reason that a new and later patent for the same invention would operate to extend or prolong the monopoly beyond the period allowed by law.

The result of the foregoing and other authorities is that no patent can issue for an invention actually covered by a former patent, especially to the same patentee, although the terms of the claims may differ; that the second patent, although containing a broader claim, more generical in its character than the specific claims contained in the prior patent, is also void."

The reasons advanced as the basis of the decisions that a second patent is void are the same that have been considered sufficient to invalidate a second copyright whenever this question has been under consideration. That a second grant would operate to prolong the monopoly beyond the period allowed by law in the case of copyrights as well as patents is so obvious that we believe the statement of the proposition must foreclose all argument upon this point.

Counsel have cited the case of *Black* v. *Allen*, 56 Fed., 764, as sustaining their position. We think, however, that it looks the contrary way. In that case Charles Scribner & Sons, acting for General Walker, deposited in the office of the Librarian of Congress the title to a work of which General Walker

was the author. On February 13, 1888, General Walker again recorded the title in a slightly different form. On April 6, 1888, Scribners, acting for General Walker, deposited the two copies of his book.

This case goes no further than to hold that the author, after depositing his title and before perfecting his copyright by depositing the two copies required by statute, may change the title of his work without rendering the copyright invalid.

It is said on page 769:

> "It may be that the copyright as completed by the deposit of the published work does not extend more than twenty-eight years from the filing of the original title, but this does not affect the present case."

This case really favors our contention, for it was there tacitly recognized that if the first registration of title has been perfected by the filing of copies a second copyright would have been invalid, in that the protection would then have extended beyond the period of twenty-eight years.

B. THE RIGHT OF A PAINTER TO A MONOPOLY IN THE PUBLICATION OF HIS PAINTING WAS CREATED AND IS MEASURED BY THE COPYRIGHT ACT AND NOT BY THE COMMON LAW.

Plaintiff has taken the position that at common law the right of an author in his works was not lost by publication, but continued after publication; that compliance with the copyright act does not destroy the owner's common law copyright, and that in the absence of publication the public does not acquire any right by reason of the compliance with the copy-

right law; that a copyright is not *per se* a government grant, but is a right of the author in the property created by him; that his rights are not created by the grant of copyright, but from the fact of authorship; that the procuring of the copyright serves merely to continue the author's claim after publication, and that the copyright law should be liberally construed.

It is but natural from such promises that counsel should argue that the author may copyright his works once or twice or a dozen times prior to the general publication, as he may choose, and that each registration secures to him a valid copyright.

We believe that plaintiff's contentions have already been shown to be erroneous; that his premises are incorrect will appear from the most casual examination of adjudications of unquestioned authority.

There are no principles of law better settled than that at common law the rights of the author in his work were lost by publication; that the law of copyrights enforces rights which did not exist at common law, and is not declaratory thereof; that it divests a party of his common law right, and, finally, that whatever rights are secured to an author after publication are created by statute.

As is said in *White-Smith Music Co.* v. *Apollo Co.*, 209 U. S., 1 (15):

> "In the last analysis this case turns upon the construction of a statute, for it is perfectly well settled that the protection given to copyrights in this country is wholly statutory."

And in *Globe Newspaper Co.* v. *Walker*, 210 U. S., 356 (367):

> "We think these (copyright) statutes, taken together, indicate the purpose of Congress to provide a system of remedies to enforce the rights which have been granted to those who shall avail themselves of the statutes of the United States and, in accordance therewith, become the owners of the exclusive right for a limited term to publish and multiply the copyright work. * * *
>
> It thus appears that Congress has prescribed the remedies it intends to give. This being true, however inadequate, as Lord KENYON said in *Bekford* v. *Hood*, 7 T. R., 620, no others can be resorted to."

Bobbs-Merrill Co. v. *Straus*, 210 U. S., 339 (346-347):

> "Recent cases in this court have affirmed the proposition that copyright property under the federal law is wholly statutory, and depends upon the right created under the acts of Congress passed in pursuance of the authority conferred under Article I, Section 8, of the Constitution. * * *"

At common law an author had a property in his manuscript and might have redress against any one who undertook to realize a profit from its publication without authority of the author.

Wheaton v. *Peters*, 8 Pet., 591, 659.

In Drone on Copyright that author says (page 100):

> "As the law is now expounded, there are important differences between the statutory and the common law right. The former exists only in works which have been published within the meaning of the statute, and the latter only in

works which have not been so published. In the former case ownership is limited to a term of years; in the latter it is perpetual. The rights do not co-exist in the same composition; when the statutory right begins the common law right ends. Both may be defeated by publication. Thus, when a work is published in print the owner's common law rights are lost, and unless the publication be in accordance with the requirements of the statute the statutory right is not secured."

In the case of *White-Smith Music Pub. Co.* v. *Apollo Co.*, 147 Fed., 226, it is said (page 227):

"But in view of the fact that the law of copyright is a creature of statute, and is not declaratory of the common law, and that it confers distinct and limited rights, which did not exist at the common law, we are constrained to hold that it must be strictly construed, and that we are not at liberty to extend its provisions, either by resort to equitable considerations or to a strained interpretation of the terms of the statute."

The case of *Bobbs-Merrill Co.* v. *Straus*, 147 Fed., 15, was in the Circuit Court of Appeals, Second Circuit. The opinion is by Judge Townsend. It is said (page 18):

"The argument of complainant rests upon an assumed identity of common law rights and statutory copyright. But in this view we think it is in error. 'The two rights do not co-exist in the same composition; when the statutory right begins, the common law right ends.' * * *"

Page 19:

"The right to copyright, which exists at common law, has been superseded by statute. *Holmes* v. *Hurst*, 174 U. S., 82; 19 Sup. Ct., 606; 43 L. Ed., 904. Where the owner of the common

law copyright elects to substitute the protection of the statute for that of the common law he, upon publication, abandons or surrenders his common law rights, including said right of limited publication, in exchange for the statutory right, the exclusive right to multiply copies. He 'cannot have at the same time the benefit of the copyright statute and also retain (his) common law right. No proposition is better settled than that a statutory copyright operates to divest a party of the common law right.' *Jewelers' Mercantile Agency* v. *Jewelers' Publishing Co.*, 155 N. Y., 241, 247; 49 N. E., 872; 41 L. A., 846; 63 Am. St. Rep., 666. * * *

Copyright may be defined as the sole and exclusive liberty of multiplying copies of an original work of composition. Coppinger, Law Copyrights (3d Ed.), 1. This right was not reserved by the common law. *Wheaton and Donaldson* v. *Peters and Grigg*, 8 Pet., 591. * * *"

Page 21:

"The argument of complainant is stated as follows:

'These references to the controversy as to the common law rights of authors after publication are sufficient to show that the copyright statutes have not created new and extraordinary rights of property which did not previously exist, but are rather declaratory of the common law, in a sense derogatory of the common law, since the statutes give the right only a limited duration.'

That this view is inaccurate is sufficiently shown by many decisions. Thus in *Wheaton and Donaldson* v. *Peters and Grigg*, 8 Pet., 591; 9 L. Ed., 1055, the court says: 'Congress, then, by this act, instead of sanctioning an existing right, as contended for, created it.'

In *Stevens* v. *Gladding*, 17 How., 447, 15 L. Ed., 155, the court says:

'There being no common law of copyright in this country, whatever rights are possessed by

the proprietor of the copyright must be derived from some grant thereof in some act of Congress, either *nominatim* or by satisfactory implication.'" * * *

Page 22:

"The fallacy of complainant's argument lies in disregarding the peculiar common law right of literary property, namely, the right of first publication, and the right to restricted publication, and the condition precedent to the enjoyment of the statutory right, namely, the surrender of such common law right by a general publication."

Page 23:

"It is further argued that the copyright statutes should receive a liberal and not a strict construction because they are merely declaratory of the common law, and that the provision in this case is for the protection of the author. We have already seen, however, that the statute is in derogation of the common law right, and, therefore, is to be strictly construed."

In the case of *Banks* v. *Manchester*, 128 U. S., 244, it is said (page 252):

"A copyright cannot be sustained as a right existing at common law; but, as it exists in the United States, it depends wholly on the legislation of Congress. *Wheaton* v. *Peters*, 8 Pet., 591, 662, 663."

In the case of *Thompson* v. *Hubbard*, 131 U. S., 123, it is said (page 151):

"This right of action, as well as the copyright itself, is wholly statutory, and the means of securing any right of action in Hubbard are only those prescribed by Congress. *Wheaton* v. *Peters*, 8 Pet., 591, 662, 663; *Banks* v. *Manchester*, 128 U. S., 244, 252."

It has been argued by plaintiff that a painter may take out a copyright on a painting, and at any subsequent date prior to a general publication, he may again secure a copyright which will protect his painting for twenty-eight years from the later date, and that this will not prejudice the public in the slightest degree.

In *Odiorne* v. *Armstrong Nail Factory, supra,* in referring to the same contention as to a patent, the court said that this would completely destroy the whole consideration derived by the public for the grant, which in this case is the right to copy the painting at the expiration of twenty-eight years. Neither can it be said that the author would be entitled to secure successive copyrights even though it could be held that all the copyrights expired at the date of the limitation of the first copyright. The public have a right to know the date on which they are entitled to copy the painting. To secure this right, the statute requires a notice of the date on which the copyright is procured to be placed upon all copies.

The copyright act protects the public against deception, by requiring the date to be inscribed upon some visible portion of each copy, and the purpose of this was to inform the public of the date on which it would have the right to copy the work. The author gets his monopoly under the law, and he agrees in consideration of that monopoly, that at the expiration of twenty-eight years the monopoly shall cease.

Suppose the first copyright was taken out in 1901, it must expire in 1929, if however, another copy-

right could be taken out in 1911, then the notice of this copyright would be placed upon the copies and the public would be mislead into the belief that the date of the expiration of the copyright was 1939.

The Constitution provides that Congress shall have power "to promote the progress of science and useful arts by securing for *limited times* to authors and inventors the exclusive right to their respective writings and discoveries."

If the statute is to be construed as granting perpetual copyright by means of successive registration, then it would seem to be unconstitutional, because if it can be said that a painter may prolong his copyright indefinitely by successive compliances with the law, then he has secured the benefit of the Copyright Act for an *unlimited* time.

II.

THERE WAS A PUBLICATION PRIOR TO THE DATE OF THE APPLICATION FOR THE COPYRIGHT OF NOVEMBER 7TH.

1. COPYRIGHT IS PUBLICATION.

It devolves upon the plaintiff to show that the title of his painting was deposited "on or before the day of publication in this or any foreign country."

"The burden of showing a literal compliance with each and every statutory requirement in the nature of a condition precedent to the acquisition of a valid copyright is upon the plaintiff."

9 Cyc., 968.

If it should be considered that successive copyrights are within the protection of the act, still in this case the copyright of November 7th is invalid because of publication prior to that date.

First, there was a publication on October 7th, 1901, by reason of the procurement of a copyright upon the same painting;

Second, the evidence fails to show that there was no publication by reason of the sale of photographs prior to November 7, 1901.

The plaintiff on October 7, 1901, deposited in the Library of Congress a photograph of his painting. This was as complete and formal a dedication of his work as it was possible to make.

In fact, he could have adopted no better way to dedicate his painting to the public than by depositing a copy in the great public library of the United States, where it will remain for all time to come, open to the free and unrestricted inspection of the public.

With reference to the Library of Congress, it is said in 14 Ency. Brit., p. 535:

> "In 1870 the registry of copyrights was transferred to it under the charge of the Librarian of Congress. As two copies of every publication which claims copyright are required to be deposited in the library the receipts under this head are nearly 25,000 articles per annum. * * *
>
> "There is an alphabetical card catalogue kept constantly up to date and a printed catalogue of subject matters. The library is open every day in the year except on four legal holidays, from 9 A. M. to 4 P. M., and admission is granted to all persons over 16 years of age, without formality or introduction, but books are only lent to members of the official classes."

In the case of *Merrill* v. *Tice*, 104 U. S. Rep., page 557, it is said (page 561):

> "The Librarian's office is a public one; the copyright books deposited with him are quasi-records, kept in his custody for public examination,—one object no doubt being to enable other authors to inspect them in order to ascertain precisely what was the subject of copyright."

It has been said that the deposit of the copies required by the statute in the office of the Librarian of Congress is a publication even though no copyright is secured.

Jeweler's Mer. Agency v. *Jewelers' Pub. Co.*, 155 N. Y., 241, was a suit to enforce an author's common law rights. The defendant claimed that the plaintiff had lost its common law right by securing a federal copyright. Plaintiff answered that it had not perfected its copyright.

It was held that there had been a publication. Three judges concurred upon the special ground as follows:

> "We concur in the result upon the ground that the plaintiff, by depositing two copies of its reference book in the office of the librarian of Congress, published the same, even if it obtained no copyright."

Whether or not the mere deposit of copies is a publication it is evident that the procurement of a copyright operates as a publication within the meaning of the statute. The Act of 1870 provided that one applying for a copyright should "*within* 10 *days from the publication thereof*, deliver at the office of the Librarian of Congress," two copies, etc.

Under this act it was held in *Boucicault* v. *Hart*,

13 Blatch., 47 (cited by appellant) that where an author registered the title of his work, he was required to publish within a reasonable time and deposit his copies, and a failure to do so was an abandonment of the registration. The act was amended in 1891. As amended it requires the deposit of copies "*not later than the day of the publication thereof.*"

From a consideration of the act as amended it is apparent that the deposit of the copies is the only publication required to perfect the copyright.

Sec. 4956 of the Rev. Stat., which provides for the deposit of copies. "Not later than the day of the publication thereof," is entitled "Deposit of title and *published* copies."

Sec. 4960 of the Revised Stat. provides that:

> "For every failure on the part of the proprietor of any copyright to deliver or deposit in the mail either of the *published* copies or description or photograph required by Sec. 4956," etc.

In the case of *Bobbs-Merrill Co.* v. *Straus et al.*, 147 Fed., page 15, it is said (page 21):

> "*We think, in view of the foregoing considerations, that there was an unqualified and absolute publication and a surrender of the right of restricted publication when the owner of the book complied with the statutory requirements, and thus acquired the right to notify the public of its exclusive right to the multiplication of copies.*" (Italics ours.)

The language of the act clearly indicates, that when an author deposits his book or the painter his work of art, and asks for a copyright, he in effect

says, "I have now published my work, and I desire a copyright." In fact there can be no copyright, until there has been publication. Congress did not intend to allow an author to obtain a copyright and then withhold the book or work of art secretly for a long period of time, and thus deprive the public of the use of his creation, so that he might thereafter obtain another copyright. He makes his election when he obtains his right in the first instance, and election once made cannot be recalled.

In the case of *Osgood* v. *Aloe Inst. Co.*, 69 Fed., 291, cited by appellant it was held that the depositing of two books for the purpose of securing a copyright "was not in itself such a publication of a book as would destroy the copyright if there were no proper notice of copyright in them."

We do not consider that the language here used warrants the inference that the District Judge intended to hold that the deposit of two copies was not such a publication as is required by the statute to validate the copyright.

2. THERE WAS A PUBLICATION BY THE SALE OF PHOTOGRAPHS PRIOR TO NOVEMBER 7, 1901.

In September, 1901, Curtis and Cameron procured the taking of photographs of the painting of several sizes, and Mr. Caliga agreed that they should have charge of the publication of the painting. The picture was given into their hands with the right to sell copies, upon which Mr. Caliga was to have a royalty.

The photographs were completed some time prior to October 7, 1901, on which date one of them was

deposited with the Librarian at Washington. Between that date and November 7, 1901, Curtis and Cameron had the photographs. They had the right to publish the picture. It is obvious there was such a publication of the painting, as would invalidate the copyright of November 7th, because there was given to Curtis & Cameron not only the right to sell, but the right to publish. There can be no such thing as the right to sell without a right to publish.

In the statement of facts in the case of *American Tobacco Co.* v. *Werckmeister*, 146 Fed., 375, it was said:

> "On April 16, 1894, plaintiff took out a copyright in this country, and began the publication of the painting in this country and in foreign countries by the sale of photographic or photogravure copies thereof."

The giving of unlimited authority to Curtis and Cameron to sell the photographs was a publication, and if not a publication, still it devolved upon the plaintiff to show by competent evidence that no photographs or other copies of the painting were published by Curtis and Cameron between October 7th and November 7th, 1901. There is no evidence upon this point sufficient to warrant an inference that they did not publish the painting or sell the photographs as they were empowered to do under their agreement.

Mr. Caliga testifies that he had

> "Never seen one sold on the market." (Rec., 28.)
>
> "I could not say what pictures were sold from 1901 and 1903. I know they sold very few.
>
> I was not present when they made the sales

> and do not know what they sold. I do not know where the pictures were sold or where they went to. They were not all sold in Boston." (Rec., 31.)

He further testified:

> "There was no copy of the painting sold prior to the copyright of November 7, 1901, *because the negatives were not developed, were not finished.*" (Rec., 31.)

The only evidence tending to show that Curtis & Cameron did not exercise their right to exhibit and sell the photographs of the painting between the date on which they were taken and November 7, is based upon Mr. Caliga's testimony, and the only means he had of knowing or claimed to have of knowing that no photographs were sold was "because the negatives were not developed."

It is apparent that he was mistaken upon this point, because the evidence clearly shows that the photographs were finished prior to October 7, and that on October 7 one copy was deposited with the Librarian, and that the photographs deposited on November 7, 1901, were made from the same negative.

It devolved upon the plaintiff to prove that there was no publication prior to November 7, 1901, and failing in this he could not recover in this action.

III.

COMPLIANCE WITH THE STATUTORY REQUISITE THAT NOTICE BE PLACED UPON COPIES SOLD WAS NOT PLEADED OR PROVED.

The sale of photographs, without the statutory notice, after the date on which a copyright is secured vitiates the copyright.

The plaintiff was required to allege in his declaration that a notice of his copyright had been placed upon each copy issued after the date of the procurement of the copyright.

Ford v. *Blaney Amusement Co.*, 148 Fed., 642.

Appellant's brief, page 15.

There is no averment in the declaration from which it may be inferred that "after publication every published copy contained the required statutory notice of such registration." Moreover there is no evidence in the record sufficient even to make out a *prima facie* case as to the notice of Mr. Caliga's copyright being placed upon the copies sold by Curtis and Cameron under their agreement with Mr. Caliga.

It is obvious that some proof should be offered as to the acts of those having the sale of the photographs in charge.

From 1901 to 1903, Curtis and Cameron had on sale throughout the United States photographs of Mr. Caliga's painting.

Mr. Caliga was not present when the sales were

made, and did not know "what they sold." No notice of his copyright was placed upon the photographs published and no notice appeared thereon save the illegible and almost indistinguishable marks which appeared by reason of the fact that the negative of the photograph reproduced a notice that had been placed on the painting by Mr. Caliga. (Rec., 31.)

In the first place, the notice is not legible. (Rec., 17.)

In the second place it was not placed upon the photograph, but upon the painting, and it was placed there *at a time* when the painter had no right to give such notice. A mere reproduction of the evidence of an illegal act is not such a compliance with the statute as the law requires of one who is seeking to enforce a penalty for an alleged invasion of his legal rights.

In the case of *Falk* v. *Gast Lith. & Eng. Co.*, 40 Fed. Rep., page 168, it is said (page 169):

> "LACOMBE, J. The statute provides (section 4962, Rev. St.) that no person shall maintain an action for the infringement of his copyright unless he shall give notice thereof (in the case of a photograph) by inscribing upon some portion of the face or front of the several copies published, or on the face of the substance upon which they are mounted, the words, 'Entered according to act of Congress,' etc. Compliance with this requirement must be pleaded and proved as a pre-requisite to the maintenance of complainant's action; but it would lay an unreasonable burden upon him to require separate, distinct, and specific proof as to each one of the copies—in some cases, perhaps, thousands in number—which he may have published.

General testimony is sufficient to establish a *prima facie* case. Complainant has presented the affidavits of those of his employes who have had charge of the preparation of all the copies he has published, and their testimony shows compliance with the statute."

In *Mifflin* v. *Dutton*, 190 U. S., 265, it was held: (Syl.)

"That under the copyright act of 1831 the authorized appearance of an author's work in a magazine without the statutory notice of copyright specially applicable thereto makes it public property and vitiates the copyright previously taken out by the author: and that the copyright of the magazine under its own title by the publisher is not a compliance, so far as the authors are concerned, with the statutory requirements as to notice of copyright in the several copies of each and every edition published."

IV.

PLAINTIFF'S COPYRIGHT AFFORDED NO PROTECTION TO HIS PICTURE AS REPAINTED.

Sec. 4959, Rev. Stat., provides:

"The proprietor of every copyright book or any other article, shall deliver at the office of the Librarian of Congress, or deposit in the mail addressed to the Librarian of Congress at Washington, District of Columbia, a copy of every subsequent edition wherein any substantial changes shall be made."

Aside from the foregoing statutory provision with which the plaintiff failed to comply, it has always been considered where alterations are made in any work which has been copyrighted, that in

order to protect the work as altered, a new copyright must be secured. In books and works wherein the part not changed is clearly distinguishable from the new matter, the original copyright will serve to protect that which was not altered; but where a picture has been repainted, it is a new painting since from its very nature it is impossible to separate and preserve the copyright upon that which was in existence prior to the repainting. It requires but a casual glance at the photographs on pages 17 and 33, to show not only that the picture copyrighted was substantially changed, but that the painting introduced in evidence was not the painting upon which the copyright, either of October 7th or November 7th, was secured.

> "New editions containing material alterations and additions to be protected must be copyrighted, and a notice of the new copyright inserted therein." 9 Cyc., 924.

In the case of *Lawrence* v. *Dana*, 15 Fed. Cas., 8136, it was said (page 52):

> "Second or subsequent editions with notes or other improvements, are new books within the meaning of a Copyright Act, and the authors or proprietors of the same are required to 'deposit a printed copy of such book' and 'give information of copyright being secured'; as if no prior edition of the work had ever been published." * * *
>
> "Copyrights like letters patent, afford no protection to what was not in existence at the time they were granted." * * *
>
> "Protection is afforded by virtue of a copyright of a book, if duly granted, to all the matter which the book contained when the printed copy of the same was deposited in the office of the clerk of the District Court as required by

> Sec. 4 of the Copyright Act, but new matter made or composed afterwards requires a new copyright, and if none is taken out, the matter becomes public property, just as the original book would have become if a copyright for it had never been secured."

In Drone on Copyright, it is said (page 146):

> "Another copyright, however, may be obtained for any edition which is substantially different from the preceding ones. Such edition is regarded by the law as a new and original work."

In *Black* v. *Murray, supra*, it was said that the substitution of a single word in a poem created a new edition, and that in the poem as thus changed, a new copyright might be secured.

V.

THERE IS NO EVIDENCE WHICH SHOWS OR TENDS TO SHOW THAT DEFENDANT'S PUBLICATION WAS A COPY OF PLAINTIFF'S PAINTING.

This being a suit for an infringement, it was necessary to show that the defendant availed itself of plaintiff's production. There is not a scintilla of evidence in the record which tends to show that the publication complained of was a copy of plaintiff's painting. Any argument based upon similarity is sufficiently answered by the evidence that Curtis & Cameron, under their agreement with plaintiff procured a copyright in their own name upon a photograph of the painting in question. The copies of the painting sold by Curtis & Cameron furnished the defendant with means to reproduce the pictures without any invasion of the rights of Mr. Caliga.

In the case of *Champney* v. *Haag*, 121 Fed., 944, it is said:

> "Upon more careful examination and consideration than was possible at the trial, I am satisfied that the evidence shows beyond question that the illustrations published by the defendant were reproductions of the photograph that had been copyrighted by Curtis & Cameron, and were not reproductions of the plaintiff's painting by any other hand or by any other process. If the photograph was copyrightable by reason of possessing artistic value that had been contributed to it by the photographers, the right of action for the publication complained of would belong to them, and not to the painter. No attempt was made at the trial of this suit to attack the photographers' copyright, and it was therefore necessary to regard it as at least *prima facie* valid * * * For these reasons, it seems to me that the verdict, which rests necessarily upon the finding that the illustrations in question were not copied from the photograph, has no foundation in the testimony, and that the plaintiff's case entirely failed of support."

It would seem that a crude cut published in a newspaper could not in any sense constitute a "copy" of a painting within the meaning of the statute, but if this court should adopt a contrary view, then we maintain there is an entire failure of evidence to show that the pictures printed in defendant's paper were a copy of, or were copied from, plaintiff's painting.

VI.

ILLEGAL INSERTION OF COPYRIGHT NOTICE.

Sec. 4963, Rev. Stat., provides:

> "That every person who shall insert or impress such (copyright) notice or words of the same purport in or upon any * * * photograph or other article, whether such article be subject to copyright or otherwise, for which he has not obtained a copyright * * * shall be liable to a penalty of One Hundred Dollars," etc.

Mr. Caliga testified that he placed a notice of the copyright upon his painting before any copyright had been secured, and it otherwise appears, that the notice was placed upon the painting before it was photographed by Curtis & Cameron. The photograph deposited November 7th shows this notice, and this photograph was from the same negative as the one deposited on October 7th. (Rec., 29.)

In November, 1901, he shipped the painting to Pittsburg for public exhibition; about the time it was in transit he applied for the copyright upon which this suit is based. Whether the painting was actually exhibited before the date the copyright was secured, cannot be definitely ascertained from the evidence, because of the lack of certainty in the proof as to the date of the opening of the exhibition. (Rec., 31.)

It is clear, however, that the painter intended to make sure of protection even though it became necessary to violate the statute which would secure it

to him. He does not come into court with clean hands, and while this is not an equitable proceeding, still a party seeking to enforce a penalty which may be unintentionally incurred, and which is greatly in excess of the injury done, ought not to be permitted to maintain his action where it appears that he has violated the very statute upon which he relies to enforce it.

The words "Copyright, 1901, I. H. Caliga," were placed upon the picture *before* October 7, 1901 (Rec., 31), and therefore he had clearly violated the act when he applied for the supposed copyright of November 7, 1901. Under this language, we might say that the words were placed there in January, 1901, and he might then have exhibited the work from January to November and had the protection of the law without a compliance therewith. If the words were placed there before the day he deposited in the postoffice his application for a copyright, then the whole proceedings were void under the law, and he has no legal copyright in any phase of the case.

VII.

VARIANCE.

The declaration alleges that the plaintiff, on or about the 5th of November, 1901, took certain steps to procure a copyright on his painting described as follows:

> "The Guardian Angel. Portrait of a young girl sitting hair arranged smoothly over the ears, hair parted in the middle. Her guardian angel stands behind her, one hand resting on her left shoulder, the other on her right arm."

that said painting had not been published prior to November 5, 1901; that a copyright was granted securing the plaintiff the protection afforded by copyright, for a term of twenty-eight years, from and after, to wit: November 7, 1901.

Evidence was introduced by the plaintiff tending to prove the foregoing facts as alleged. It appeared on the trial that a copyright had been taken out upon a photograph of this painting on November 1, 1901, under the title of "Guardian Angel," in the name of Curtis & Cameron, and that the plaintiff had secured a copyright of the painting in question with the following description:

> "Maidenhood; a young girl seated beside a window; an angel stands behind her."

on October 7, 1901.

We come now to the argument of the question, raised by plaintiff under the title of variance. In the examination of this subject we will readily concede what has never been denied and what has taken so much of plaintiff's argument to prove, namely, that if a date be immaterial, it need not be proved as alleged, but there is no such question to be disposed of in this case, "a variance can only be where there is a clear discrepancy between averment and proof." The plaintiff proved the facts as to the date precisely as alleged in the declaration, he also proved the deposit of his photograph *with a description as alleged,* and under instructions offered by him, claimed a recovery upon the second copyright.

In this court he has attempted to shift his position, and now for the first time claims that he is entitled to recovery upon the copyright entered un-

der the title of "Maidenhood," etc., on October 7, 1901.

To say that a party may bring a suit upon a copyright issued upon a certain date, under a *particular title* alleged in the declaration, go to trial upon the issue which he has made, prove the allegations of his declaration as to the description filed, and the date on which the copyright was secured, ask instructions predicated upon his claim to recover for an infringement of this copyright, and failing to recover in the court below to rely on appeal upon the case made in his declaration in an appellate court then assign errors based upon the theory of the validity of the copyright declared upon present for the first time an alternative claim based upon a copyright of a prior date which was entered under a different description, and ask—in the event that the copyright described in the declaration and proved in the court below is held void—that he have a recovery under a copyright of a prior date, which was in no way referred to in the declaration, and appeared only incidentally in the proof, is to assert a proposition which merits nothing more than a mere denial. On the trial below the court, in the instruction to the jury, said:

> "It has appeared in evidence before you that the suit on trial here was based on a copyright of November 7, 1901."

We have deemed it a work of supererogation on our part to present authorities on this question, which appears to possess more of novelty than correctness. It is discredited by every analogous decision, and in so far as judicial opinions are con-

cerned, if no authority can be found in opposition to it, it is only because it is too extravagant ever to have come into judgment. We might suggest, however, that inasmuch as a very great number of suits brought for an infringement of a patent have been defeated by the showing of a prior patent, it must be considered, either that this point has eluded the viligance of lawyers and judges for a great many years, or that it is wholly without merit. We note, however, that it is said in the case of *Miller* v. *Eagle Mfg. Co.*, 151 U. S., at page 198:

> "In *Underwood* v. *Gerber*, 149 U. S., 224, it was ruled that where a patentee obtained two patents on the same day, upon applications filed on the same day, they could not be treated as one patent with two claims, and that the complainant in suing upon the second, or the one having the latest number, could not use the first, or the one with the earlier number, to help sustained the action."

VIII.

DESCRIPTION OF THE FIRST COPYRIGHT.

The suggestion that the first copyright was invalid because of an insufficient description has been prudently insinuated rather than openly pressed. It is, however, intimated by counsel that the judgment should be reversed to permit the jury to pass upon it as a question of fact, although the question is one of law rather than of fact. See the case of *Miller* v. *Mfg. Co.*, 151 U. S., 196. The defendant admits its validity; the plaintiff himself was impressed with the fact that he had on October 7th secured a copyright. His counsel have devoted con-

siderable of their brief of the argument that it is of sufficient validity to base a suit for infringement upon it.

It would seem therefore that until the validity is in question, the copyright ought to be considered *prima facie* valid. If, however, the sufficiency of the description could be called into question in this case, we believe it can hardly be necessary to resort to any course of reasoning or to the citations of authorities to prove that a party will not be permitted to raise a question of this character for the first time in an Appellate tribunal.

Respectfully submitted,

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